

ESTTA Tracking number: **ESTTA490306**

Filing date: **08/21/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85041968
Applicant	Eagle Marine Services, Ltd.
Applied for Mark	EAGLE MARINE SERVICES
Correspondence Address	ANTHONY J MALUTTA KILPATRICK TOWNSEND AND STOCKTON LLP 2 EMBARCADERO CTR , FL 8 SAN FRANCISCO, CA 94111-3833 UNITED STATES amalutta@kilpatricktownsend.com, aschlette@kilpatricktownsend.com
Submission	Supplemental Brief
Attachments	Eagle Marine Appeal Brief.pdf ( 15 pages )(210364 bytes )
Filer's Name	Anthony J. Malutta
Filer's e-mail	amalutta@kilpatricktownsend.com, aschlette@kilpatricktownsend.com
Signature	/Anthony Malutta/
Date	08/21/2012



The question of likelihood of confusion turns “not [on] the *nature* of the mark, but [on] its *effect* when applied to the goods of the applicant.” In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1360 (C.C.P.A. 1973) (emphasis in original) (holding RALLY for polishing and cleaning agent not likely to be confused with RALLY for all-purpose detergent). “The words ‘when applied’ do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark” in the marketplace. *Id.* at 1361. Thus, in addition to the factors enumerated in Du Pont, other probative factors, such as the absence of predatory intent, may be considered.

The relevant circumstances surrounding Applicant’s Mark in the marketplace include (1) the differences between the Applicant’s Mark and the Cited Mark, in their entirety; (2) The weakness of the Cited Mark; (3) the substantial differences between Applicant’s goods and services, and those of the Cited Mark, and the differing channels of trade used by each; (4) the sophistication of the consumers of services offered under Applicant’s Mark and the Cited Mark; (5) the absence of any evidence of actual confusion, despite 23 years of co-existence; and (6) the absence of any intent on the part of Applicant to trade upon the cited Registrant’s goodwill. An evaluation of these factors confirms no likelihood of confusion exists between Applicant’s Mark and the Cited Mark.

**II. THE CAREFUL CONDITIONS UNDER WHICH SALES ARE MADE BY APPLICANT, AND THE CONCERN AND SOPHISTICATION OF BUYERS TO WHOM SALES ARE MADE, MAKE CONFUSION UNLIKELY**

“[T]here is always less likelihood of confusion when goods are purchased after careful consideration.” Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1206 (1st Cir. 1983). The Court of Customs and Patent Appeals has stated: “other things being equal, confusion is less likely where goods are expensive and are purchased after careful

consideration than where they are purchased casually.” 2 McCarthy, *supra* § 23:96 (4th ed. 2003).

Confusion between Applicant's mark and the Cited Mark is unlikely because consumers of Applicant's services purchase with caution and consideration. The services that Applicant offers to its clients are highly specialized, and customers purchase them only after careful consideration. Shipping companies arranging for stevedoring and port facility services take great care in their contracting decisions. Applicant's customers are well aware of whom they entrust the loading and unloading of their massive container and cargo ships, and it is almost beyond imagination that they would be confused about this.

Additionally, Applicant's services are extremely expensive and usually only engaged for multi-year terms after careful negotiation. Consequently, the generally applicable reasonably prudent person standard is elevated to the standard of the “discriminating purchaser.” *Id.* See, e.g., McGregor-Doniger, Inc. v. Drizzle, Inc., 599 F.2d 1126, 1137-38, 202 U.S.P.Q. 81, 92-93 (2d Cir. 1979) (consumers exercise care in connection with purchases of coats in the \$100 - \$900 range) (DRIZZLER for jackets not likely to be confused with DRIZZLE for coats); Magniflux Corp. v. Sonoflux Corp., 231 F.2d 669, 671, 109 U.S.P.Q. 313, 315 (C.C.P.A. 1956) (“confusion is less likely where goods are expensive and purchased after careful consideration”) (SONIZON not likely to be confused with SONOFLUX, both for testing apparatus). In light of the Applicant's and Registrant's different services here, confusion on the part of “reasonably prudent persons” is unlikely, and confusion by “discriminating purchasers” is, as a practical matter, unthinkable.

Applicant respectfully submits that the Examiner did not give adequate weight to Applicant's “Sophistication of Purchasers.” The Examiner states: “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* Denial of Request for Reconsideration, p. 3. Yet neither Du Pont nor any other case requires that consumers be “sophisticated or knowledgeable” about the deeply complex legal arena of trademarks, or “immune” from confusion. Applicant believes that by requiring Applicant to reach these two thresholds, the Examiner has set an unrealistically high bar unsupported by precedent.

Du Pont simply instructs that “in testing for likelihood of confusion under Sec. 2(d),” the 13 enumerated factors, “when of record, must be considered.” Du Pont, 476 F. 2d at 1361. The fourth factor to be considered is “The conditions under which, and buyers to whom, sales are made, *i.e.* ‘impulse’ vs. careful, sophisticated purchasing.” *Id.*

The services offered by Applicant and Registrant are too complex and expensive for a consumer to risk an “impulse” purchase. These services require careful and sophisticated buying decisions. Purchasing confusion is simply unlikely.

### **III. APPLICANT’S GOODS AND SERVICES ARE DIFFERENT FROM THE GOODS AND SERVICES OFFERED UNDER THE CITED MARK, AND THE TRADE CHANNELS ARE DISSIMILAR**

A comparison of Applicant’s specifications to those of the Cited Mark, and a review of business reports and other documents, reveals that the goods offered under the Cited Mark, and the established channels of trade, are quite different from Applicant’s services and channels of trade. It is readily apparent that the parties’ services so “differ in ways that may be deemed material to consumers” that confusion is unlikely. *See* Buitoni Foods Corp. v. Gio. Buton & C.S.p.A., 680 F.2d 290, 292 (2d Cir. 1982); *see also* Vitarroz Corp. v. Borden,

Inc., 644 F.2d 960, 968 (2d Cir. 1981) (no likelihood of confusion between BRAVOS for crackers and BRAVOS for chips because “the products differ in non-trivial respects and share only some areas of competing use, and the trier has found no significant risk of injury to the senior user”).

Applicant is a company that is in the business of physical port operations on the West Coast. Its Class 35 specification states that it is engaged in “Operation of port facilities for others; booking and scheduling cargo transportation for others.” Its Class 39 specification states that it engaged in “Stevedoring services; cargo handling; storage of goods for others.” Applicant moves containerized shipments, such as bulk and over-sized cargo shipments as well as hazardous materials, in the ports of Los Angeles, Oakland and Seattle. See, <http://www.eaglemarineservices.com/wps/portal/ems>.

The owner of the Cited Mark is based in Stamford, Connecticut. Its business is principally the arrangement of maritime shipping for cargo. As its specifications explain, Registrant engages in such business activities as arranging for vessel insurance and obtaining legal and medical services for crew members.

In short, Applicant’s core business is the *actual, physical* unloading and loading of cargo, while the Registrant is in the business of providing “ship agent services” (per its Class 35 specification). Notwithstanding the claim in its Class 39 specification that it performs “cargo handling,” the website for the Cited Mark (<http://www.eagleocean.com>) makes no mention of such a service. Instead, the website states that Eagle Ocean Transport Inc. (<http://www.eagleocean.com>) “provides services in chartering, sale & purchase, P&I and insurance, shipping finance and conducts industry and competitive analyses.” Indeed, its business is clearly in the nature of a shipping agent (i.e. arranging for shipment of cargo); not,

the actual *physical* movement of the goods. Indeed, the first words in the Registrant's Class 35 specification are "ship agent," and the Website for the Cited Mark prominently proclaims the company to be "GENERAL AGENTS."

Moreover, the website for the Cited Mark makes no claim that Eagle Ocean Transport Inc. provides services in the ports of Los Angeles, Oakland and Seattle, where the Applicant does business. There appears to be little or no overlap in the channels of trade used by the Applicant and the Cited Mark's company. Nor does there appear to be overlap in the two companies' marketing efforts. "[I]f the goods or services in question are *not related or marketed in such a way* that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, *even if the marks are identical*, confusion is not likely." T.M.E.P. § 1207.01(a)(i) *citing* Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (emphasis added) (cooking classes and kitchen textiles not related); H. D. T. Co. Factors, Inc. v. Sinclair, 288 F.2d 947, 949, 129 U.S.P.Q. 283, 285 (C.C.P.A. 1961) (CORAL for soap not confusingly similar to BLUE CORAL for cleaner and wax; despite obvious relationship, "the products used for these two distinct purposes are so different in composition and preparation for using that the products in and of themselves can be judged dissimilar").

Here, the services in question are not related or marketed in such a way that the same persons would encounter them in situations that would create the incorrect assumption that they originate from the same source. Therefore, confusion is not likely.

The services are only peripherally related. As stated above, Applicant is engaged in the *actual* maritime shipping of cargo, while the Cited Mark is for a company that arranges services associated with cargo shipping, such as insurance and legal services.

Applicant respectfully submits the Examiner erroneously concludes that because Applicant and the owner of the Cited Mark both conduct business in the broad field of shipping, their functions are presumptively so related as to be confusing. As stated previously, Applicant is in the business of moving actual, physical cargo, while the owner of the Cited Mark provides maritime cargo-related services. The Examiner's conclusion falsely assumes the existence of a single, monolithic "shipping industry" in which all activity is somehow related. The Examiner could point to only two "identical" services provided by Registrant and Applicant – cargo handling and stevedoring. Yet as stated above, Registrant's website gives no indication it actually offers "cargo handling," and a review of business records yields no evidence it does so. It is not clear to Applicant why the Examiner asserts that the owner of the Cited Mark engages in stevedoring. The word appears neither in the Cited Mark's registration, in its initial application, nor on the Registrant's website. Stevedoring is the very heart of Applicant's business; there is scant evidence Registrant offers this service. This illustrates that while Applicant and Registrant are, at most, in the same broad field, they should not be lumped together as automatically providing identical or even related services. While the "category" of goods/services may be the same, "use in the same broad field is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion." Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp., 954 F.2d 713, 716, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (EDS for power supplies not confusingly similar to EDS for computer programming services). Applicant's services and the goods in the Cited Mark – and the channels of trade and other features – are fundamentally different, and "not complementary or companion items." In re British Bulldog, Ltd., 224 U.S.P.Q. 854,

856 (T.T.A.B. 1984) (no likelihood of confusion between PLAYERS for shoes and PLAYERS for men's underwear).

The Examiner points to several websites of maritime shipping companies to support the proposition that those encountering maritime/port services offered under highly similar names, therefore, are likely to assume a common source. Applicant respectfully disagrees with the assertion that because some maritime shipping companies “may” offer a variety of services, consumers of maritime port services will probably assume a common source where two of these companies share part of a name. In Applicant’s view, the fact that some companies “may” offer a variety of services has no bearing on the consumer’s likelihood of confusion among providers of these services, even where two providers share a name.

Moreover, the services provided by the Applicant and the Registrant are marketed differently. Thus, even when marks are identical and the goods (or services) are in the same category, sales to different groups of purchasers through different channels of trade “are sufficient to raise a doubt as to likelihood of confusion, mistake or deception.” In re Radiant Color Co., 156 U.S.P.Q. 703, 704 (T.T.A.B. 1968) (RADIANT for coated paper not confusingly similar to RADIANT for loose paper). Accord Paul Sachs Originals Co. v. Sachs, 325 F.2d 212, 139 U.S.P.Q. 414 (9th Cir. 1963) (use of marks with identical “SACHS” name on different-sized dresses sold in different stores not likely to cause confusion).

Applicant's services and the services in the Cited Mark are marketed differently because the services are fundamentally different. The website for the Cited Mark prominently proclaims the company as “GENERAL AGENTS.” By contrast, the Applicant’s website makes plain that its overriding mission is stevedoring – the loading and unloading of

ship cargo. The first words on the Applicant's website ([www.eaglemarineservices.com](http://www.eaglemarineservices.com)) read:

"Leading with seamless stevedoring and terminal services." The first full paragraph states:

"When it comes to stevedoring, nobody delivers like Eagle Marine Services. We're always breaking new ground, finding innovative ways to streamline the movement of cargo across our terminals – to ensure our solutions are always tailored to suit your transportation needs."

What is more, the Applicant plainly markets to customers who use the ports of Los Angeles, Oakland and Seattle, while the Registrant's Website makes no mention of these ports. Registrant's website states:

Since 2003 EOTI [Eagle Ocean Transport, Inc.] has assisted in negotiating new building orders for one Very Large Crude Carrier (VLCC) at Hyundai Heavy Industries (HHI) in South Korea, two Aframax tankers at Sumitomo Shipyard in Japan, four Very Large Gas Carriers (VLGC) and three Aframax tankers (LR2) all at HHI.

The Registrant's website also states that Registrant is a member of these geographic industry associations: The Connecticut Maritime Association; the Greek Shipping Corporation Committee; and the Baltic Exchange.

The Applicant and the company with the Cited Mark provide different services, in differing channels of trade, marketed differently. It is difficult to conceive that the same persons would incorrectly assume that services provided by Applicant and Registrant originated from the same source. For these reasons, Applicant respectfully submits that confusion is unlikely.

Even if one were to accept the Examiner's view that the two companies' services "are highly related," the Trademark Trial and Appeal Board has recognized that in many cases registration must be allowed even when virtually identical marks are used on "undeniably

related goods.” In re Sears, Roebuck & Co., 2 U.S.P.Q.2d 1312, 1314 (T.T.A.B. 1987)

(CROSS-OVER for bras not confusingly similar to CROSSOVER for ladies’ sportswear).

#### **IV. WHEN PROPERLY VIEWED IN THEIR ENTIRETIES, APPLICANT’S MARK AND THE CITED MARK ARE NOT LIKELY TO BE CONFUSED**

“That marks must be considered in their entirety in determining whether there is a likelihood of confusion or mistake is a basic rule in comparison of marks.” Massey Junior College, Inc. v. Fashion Inst. of Tech., 492 F.2d 1399, 1402 (C.C.P.A. 1974). As the Supreme Court has noted, “[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.” Estate of P.D. Beckwith, Inc. v. Comm’r of Patents, 252 U.S. 538, 545-46 (1920); *see also* In re Hearst Corp., 982 F.2d 493, 494 (Fed. Cir. 1992) (“Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight”). The Trademark Trial and Appeal Board has further explained that “it is the entire mark which is perceived by the purchasing public, and, therefore, it is the entire mark that must be compared to any other mark. It is the impression created by the involved marks, each considered as a whole, that is important.” Genesco Inc. v. Martz, 66 U.S.P.Q.2d 1260, 1269 (T.T.A.B. 2003); *accord* Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007 (C.C.P.A. 1981) (MM design not confusingly similar to FM design); New England Fish Co. v. Hervin Co., 511 F.2d 562, 563 (C.C.P.A. 1975) (BLUE MOUNTAIN KITTY O’s for cat food not confusingly similar to KITTY for same).

Even slight differences in the appearance, sound, connotation, and commercial impression conveyed by different marks can be sufficient to dispel confusion. “[T]he use of an identical word, *even a dominant word*, does not automatically mean that two marks are similar.” Freedom Savs. & Loan Ass’n v. Way, 757 F.2d 1176, 1183 (11th Cir. 1985) (emphasis added) (FREEDOM REALTY

not confusingly similar to FREEDOM SAVINGS AND LOAN); *see also* In re Bed & Breakfast Registry, 791 F.2d 157 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others not likely to be confused with BED & BREAKFAST INTERNATIONAL for room-booking services).

The Examining Attorney states that “one feature of a mark may be more significant in creating a commercial impression.” *See* Denial of Request for Reconsideration, p. 2. Because the Cited Mark disclaimed “OCEAN,” and the Applicant disclaimed “MARINE SERVICES,” the Examining Attorney concluded that “EAGLE” is “the dominant feature of each mark. The marks, therefore, are highly similar.” *Id.*

However, when considered in their entireties, Applicant’s EAGLE MARINE SERVICES and the Cited Mark EAGLE OCEAN are sufficiently different to avoid any likelihood of confusion.

The two marks are visually, phonetically and connotatively different. The Cited Mark is significantly shorter than the Applicant’s Mark, a distinction apparent to the eye and the ear. The Cited Mark merely pairs two words – “Eagle” and “Ocean” – imparting virtually nothing about the Registrant’s goods and services. By contrast, the phrase “Eagle Marine Services” conjures the business of serving the shipping industry. Despite the shared term, it creates a commercial impression that is significantly and sufficiently distinct from the Cited Mark to avoid any likelihood of confusion. *See, e.g.,* Sec. Ctr., Ltd. v. First Nat’l Sec. Ctr., 750 F.2d 1295, 1302 (5th Cir. 1985) (words “First National” sufficient to differentiate FIRST NATIONAL SECURITY CENTER from SECURITY CENTER).

The Examining Attorney asserts that “EAGLE” is “the dominant feature of each mark. The marks, therefore, are highly similar.” But courts have consistently rejected the notion that the very existence of common, dominant words equates with similarity. As the Eighth Circuit explained:

The use of identical, even dominant, words in common does not automatically mean that two marks are similar. Rather, in analyzing the similarities of sight, sound, and meaning between two marks, a court must look to the overall impression created by the marks and not merely to compare individual features.

General Mills, Inc. v. Kellogg Co., 824 F.2d 622, 627, 3 U.S.P.Q. 2d 1442, 1445 (8th Cir. 1987) (OATMEAL RAISIN CRISP and APPLE RAISIN CRISP for breakfast cereals not likely to be confused). *See also* Borden, Inc. v. Kerr-McGee Chemical Corp., 179 U.S.P.Q. 316, 317 (T.T.A.B. 1973) (BLUE RIBBON for fertilizers “differs sufficiently in sound, appearance, and significance” from GREEN RIBBON for fertilizers).

It is “well-established” that “the addition of other matter to a highly suggestive or descriptive designation, whether such matter be equally suggestive or even descriptive, or possibly nothing more than a variant of the term, may be sufficient to distinguish them so as to avoid confusion in trade.” In re Hunke & Jochheim, 185 U.S.P.Q. 188, 189 (T.T.A.B. 1975) (RIG DURABLE for stationery articles, including folders, binders and paper, not confusingly similar to DURABUL for record books). Courts have repeatedly held that a common element in two marks is insufficient to cause consumer confusion, even when the marks are used on virtually identical goods or services. *See, e.g.*, Nutri/system, Inc. v. Con-Stan Indus., Inc., 809 F.2d 601, 605, 1 U.S.P.Q.2d 1809, 1812 (9th Cir. 1987) (NUTRI/SYSTEM not likely to be confused with NUTRI-TRIM, both for dietary products); Jack Poust & Co., Inc. v. John Gross & Co., 460 F.2d 1076, 1078, 174 U.S.P.Q. 149, 150 (C.C.P.A. 1972) (CHERRY JUBILEE not likely to be confused with CHERRY JULEP, both for food products).

**V. THE ABSENCE OF ANY EVIDENCE OF ACTUAL CONFUSION DESPITE 23 YEARS OF CONCURRENT USE CONFIRMS THAT CONFUSION BETWEEN THE MARKS IS UNLIKELY**

The concurrent use of marks without actual consumer confusion is evidence that future confusion is unlikely. *See, e.g. Du Pont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. *See generally* Restatement (Third) of Unfair Competition, § 23, comment d (Tent. Draft No.2, 1990) (“the absence of evidence of actual confusion may indicate that significant confusion is unlikely”).

Applicant has been offering services since 1978 under the mark EAGLE MARINE SERVICES, while the Cited Mark has been registered since 2006, claiming a date of first use of 1988. Hence, the Applicant and Registrant have been using their respective marks for 23 years. Applicant is not aware of a single incident of actual or possible confusion during this 23-year period of concurrent use. This substantial period of co-existence between Applicant’s Mark and the Cited Mark, without any evidence of actual confusion, confirms that confusion is unlikely. *See, e.g., Oreck Corp. v. U.S. Floor Sys., Inc.*, 803 F.2d 166, 231 U.S.P.Q. 634 (5th Cir. 1986), *cert. denied*, 481 U.S. 1069 (1987) (STEAMEX DELUXE 15 XL for carpet cleaning machine not confusingly similar to XL or ORECK XL for rug shampoos) (concurrent use for 17 months with no evidence of actual confusion is “highly significant” evidence that confusion is unlikely); *Lever Bros. Co. v. American Bakeries Co.*, 693 F.2d 251, 257, 216 U.S.P.Q. 177, 182 (2d Cir. 1982) (AUTUMN GRAIN for bread not confusingly similar to AUTUMN for margarine) (“substantial sales of both products over several years, without a single example of actual confusion, becomes significant”); *In re Palm Beach, Inc.*, 225 U.S.P.Q. 785, 788 (T.T.A.B. 1985) (ADLER for pants not confusingly

similar to ADLER for knitted socks) (“The fact that the parties have used their marks contemporaneously for more than forty-five years without any known instances of confusion is strong evidence that confusion is not likely to occur”).

**VI. OTHER PROBATIVE EVIDENCE SUPPORTS THE CONCLUSION THAT CONFUSION BETWEEN APPLICANT’S MARK AND THE CITED MARK IS UNLIKELY**

“[C]ourts regularly include intent as one of the factors to be assessed in evaluating likelihood of confusion.” Restatement (Third) of Unfair Competition § 22 rptr. note to cmt. b, at 246 (1995). In this instance, Applicant had no intent to trade upon anyone’s reputation by applying to register its mark. It is self-evident that Applicant could not have tried to trade on Registrant’s mark, since Applicant had already been using EAGLE MARINE SERVICES for 10 years when Registrant claimed first use. Thus, this factor also supports the registration of Applicant’s Mark.

**VII. CONCLUSION**

When determining whether an applicant’s mark creates a likelihood of confusion with a mark covered by a cited registration or application, “[a] showing of mere possibility of confusion is not enough; a substantial likelihood that the public will be confused must be shown.” Omaha Nat’l Bank v. Citibank (S.D.), N.A., 633 F. Supp. 231, 234 (D. Neb. 1986). Applicant submits that the relevant factors discussed above clearly support registration of Applicant’s mark and do not raise a substantial likelihood of confusion. Under these circumstances, and absent “substantial doubt,” In re Mars, 741 F.2d at 396 (Fed. Cir. 1984) (finding CANYON for candy bar not likely to be confused with CANYON for fruit),

Applicant respectfully requests that the Board reverse the Examining Attorney's rejection and allow the application to proceed to publication.