

From: Snapp, Tina

Sent: 5/31/2013 12:46:09 PM

To: TTAB E Filing

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85462512 - BLUE STAR POWER SYSTEMS INC. -
T56974US00 - EXAMINER BRIEF

Attachment Information:

Count: 3

Files: Inc-1.jpg, Inc-2.jpg, 85462512.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85462512

MARK: BLUE STAR POWER SYSTEMS INC.



CORRESPONDENT ADDRESS:

EDMUND J SEASE

MCKEE VOORHEES & SEASE PLC

801 GRAND AVENUE SUITE 3200

DES MOINES, IA 50309-2721

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Blue Star Power Systems, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

T56974US00

CORRESPONDENT E-MAIL ADDRESS:

patatty@ipmvs.com

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BLUE STAR POWER SYSTEMS, INC. : BEFORE THE

Trademark: BLUE STAR POWER SYSTEMS INC. : TRADEMARK TRIAL

Serial No.: 85462512 : AND

Attorney: EDMUND J. SEASE, ESQUIRE : APPEAL BOARD

Address: EDMUND J. SEASE, ESQUIRE : ON APPEAL

MCKEE, VOORHEES & SEASE, P.L.C.

801 GRAND AVENUE, SUITE 3200

DES MOINES, IOWA 50309

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

The applicant Blue Star Power Systems, Inc. has appealed the Trademark Examining Attorney's final refusal to register the trademark BLUE STAR POWER SYSTEMS INC. and design for "emergency automatic standby electric generator sets of at least 20 kWe sold through distributors for standby power in industrial and commercial buildings" in International Class 7 on the grounds of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), with the mark BLUE STAR, used in connection with electric generators. Also on appeal before the Trademark Trial and Appeal Board is the Examining Attorney's final requirement for a disclaimer of the descriptive lettering "INC." apart from the mark as shown.

FACTS

The applicant applied for registration on the Principal Register for the trademark BLUE STAR POWER SYSTEMS INC. and a stylized star design for “electric generators and related equipment, namely, automatic standby electric generator sets” classified in International Class 7 on November 2, 2011. The examining attorney issued an initial Office Action on February 17, 2012 refusing registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), because of the likelihood of confusion with U.S. Registration No. 1662304 (“BLUE STAR” for an “electric generator for welding or power” in International Class 9). The Office Action also required a disclaimer of the descriptive wording “POWER SYSTEMS INC.” apart from the mark as shown.

In the response received on June 27, 2012, the applicant argued against the Section 2(d) refusal and entered a disclaimer of the descriptive wording “POWER SYSTEMS”. The applicant also amended the description of the goods to read as “emergency automatic standby electric generator sets of at least 20 kWe sold through distributors for standby power in industrial and commercial buildings.”

A final refusal to register the applicant’s mark was issued on July 19, 2012 based upon the mark in U.S. Registration No. 1662304 (“BLUE STAR”) and the requirement for an acceptable amended disclaimer that includes the lettering “INC.” The amended identification of goods was found to be acceptable.

The applicant filed a notice of appeal to the Trademark Trial and Appeal Board on January 15, 2013 and a request to remand the application to the examining attorney on February 12, 2013. The application was remanded to the examining attorney on February 25, 2013, and the request for reconsideration was denied on March 21, 2013.

The applicant filed its appeal brief on March 28, 2013. The application was then forwarded to the examining attorney by the Trademark Trial and Appeal Board for the examiner’s appeal brief.

ISSUES

The two issues on appeal are 1) Whether a likelihood of confusion exists under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), between the applied-for mark BLUE STAR POWER SYSTEMS INC. and the registered mark BLUE STAR when each mark is used in connection with electric generators,

and 2) Whether a disclaimer of the entity designation "INC." is required under Section 6(a) of the Trademark Act.

ARGUMENTS

I. LIKELIHOOD OF CONFUSION

THE MARKS OF THE APPLICANT AND THE REGISTRANT ARE VERY SIMILAR AND THE GOODS ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT, 15 U.S.C. SECTION 1052(d).

The examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 1662304 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.*

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. Not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP §1207.01.

A. THE PARTIES' GOODS ARE IDENTICAL AND THEIR TRADE CHANNELS ARE CLOSELY RELATED

The applicant is using its mark on emergency, automatic, standby electric generator sets of at least 20 kWe sold through distributors for standby power in industrial and commercial buildings. The registrant is using its mark on an electric generator for use in welding or the provision of electric power. The applicant's emergency automatic standby electric generator sets are identical to the registrant's electric generators in that they both produce electrical power. Furthermore, the broad scope of the registrant's goods identified as an "electric generator for . . . power" encompasses the applicant's more narrowly identified electric generator sets. The applicant asserts that the parties' goods are distinguishable because their respective generators are of different sizes and have different types of use. However, an Internet search conducted by the examining attorney on July 19, 2012 clearly indicates that various types and sizes of generators can come from a single source. Attached to the July 19, 2012 Final Office action are several web pages from websites featuring various types of generators from Electric Generators Direct, Northern Tool + Equipment, Generac, Cummins Onan, Kohler, and Baldor. Each entity makes different sizes of generators for different uses. Based upon this common practice in the relevant trade and/or industry, namely, entities offering generators of various sizes and capabilities for purchase, purchasers could reasonably believe that all generators (both domestic and commercial) featuring the Blue Star mark come from a common source.

The goods 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). Rather, the respective goods 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 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).

Where the goods of an applicant and registrant are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

B. THE MARKS ARE VERY SIMILAR

In a likelihood of confusion determination, marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

In this case, the applicant's mark BLUE STAR POWER SYSTEMS INC. and design creates a commercial impression that is highly similar to that of the registered mark BLUE STAR. The parties' marks are similar in appearance, sound, connotation, and overall common commercial impression in that they both contain the wording "BLUE STAR." 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 *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). Furthermore the design feature in the applicant's mark consists of a blue star, which reinforces the average purchaser's impression of the applicant's trademark and enhances the likelihood that purchasers will call for the applicant's goods by the wording "blue star". The addition of the blue star design in the applicant's mark does not alter the overall commercial impression of the wording in the mark. Rather the blue star design feature strengthens the likelihood of confusion between the parties' marks.

The additional wording "POWER SYSTEMS INC." in the applicant's mark has little or no significance in distinguishing the marks since it consists of (1) a generic indicator for the applicant's goods and (2) an entity designation which does not function to indicate the source of the goods. Specifically, the applicant's goods consist of "emergency automatic standby electric generator sets of at least 20 kWe sold through distributors for standby power in industrial and commercial buildings." "Generators" are "any device for converting mechanical energy into electrical energy by electromagnetic induction." COLLINS ENGLISH DICTIONARY. A copy of this definition is attached to the February 17, 2012 Office action. Furthermore, as seen from the web pages attached to the February 17, 2012 Office action, "power systems" can be comprised of generators. Lastly, business entity designations such as "Corporation," "Inc.," "Company," and "Ltd." must be disclaimed because they merely indicate an applicant's entity type and do not function to indicate the source of goods. See TMEP §1213.03(d). Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP

§1207.01(b)(viii), (c)(ii). Matter lacking source indicating significance, such as generic terminology, is typically less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii).

In the specimen of use submitted by the applicant on November 2, 2011, the wording **BLUE STAR** appears above the term "Power Systems Inc." in a large bold print with the blue star design in place of the "A" in the word "STAR". The registrant's specimens of use received by this Office on November 26, 2007 and February 11, 2011 respectively depict standby generators bearing the wording "**Blue Star 180E** CONSTANT CURRENT DC WELDER 4000W GENERATOR" and "**Blue Star 185** CC DC Welder 6,000 Watt Generator". The terms "Blue Star 180E" and "Blue Star 185" appear in a large bold print above the additional wording in each instance. In their respective marks, both parties clearly highlight the use of the wording "BLUE STAR" on their goods.

When comparing marks, the test 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 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). In this case, the examining attorney maintains that the average purchaser is substantially likely to call for the parties' goods by the dominate feature in each mark, namely, the wording "BLUE STAR".

The applicant has also submitted printouts of third-party registrations for marks containing the wording "blue" and "star" to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar goods*. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ

989, 992 (TTAB 1982). Furthermore, the goods listed in the third-party registrations submitted by applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the goods at issue.

The applicant asserts that its mark and the registrant's mark have co-existed in the marketplace without any known instances of confusion. However, it is unnecessary to show actual confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); *e.g.*, *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

The evidence in the record clearly shows that the goods of the parties are sufficiently related under Section 2(d) of the Trademark Act such that purchasers would confuse the source of those goods.

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. TMEP §1207.01(d)(vii); *see, e.g.*, *Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). When the relevant consumer includes both professionals and the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004); *see In re Shell Oil Co.*, 992 F.2d 1204, 1208-09, 26 USPQ2d 1687, 1690-91 (Fed. Cir. 1990).

II. REQUIREMENT FOR DISCLAIMER OF “INC.”

Pursuant to the Trademark Manual of Examining Procedure Section 1213.01(b), registration of the applicant’s mark may be refused if the applicant does not comply with a requirement for a disclaimer made by the examining attorney. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006); *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005); *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (C.C.P.A. 1975); *In re Nat’l Presto Indus., Inc.*, 197 USPQ 188 (TTAB 1977); *In re Pendleton Tool Indus., Inc.*, 157 USPQ 114 (TTAB 1968).

In this case, the examining attorney required that the applicant disclaim “INC.” as part of the descriptive phrase “POWER SYSTEMS INC.” because business entity designations merely indicate an entity type and do not function to indicate the source of goods. The term “Inc.” is defined as “Incorporated: used in the U.S. after the name of a large company, or a group of companies working together under one name.” MACMILLAN DICTIONARY. A copy of this definition is attached. The Trademark Manual of Examining Procedure Section 1213.03(d) states:

Words or abbreviations in a trade name designating the legal character of an entity (e.g., Corporation, Corp., Co., Inc., Ltd., etc.) or the familial business structure of an entity (e.g., “& Sons” or “Bros.”) must be disclaimed because an entity designation has no source-indicating capacity. *See In re Piano Factory Grp., Inc.*, 85 USPQ2d 1522 (TTAB 2006) (holding VOSE & SONS primarily merely a surname); *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1215 (TTAB 2000) (finding “PRESS,” as applied to a printing or publishing establishment, “is in the nature of a generic entity designation which is incapable of serving a source-indicating function”); *In re The Paint Prods. Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) (“PAINT PRODUCTS CO.’ is no more registrable for goods emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by such a company”); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984) (“the element ‘INC.’ [in PACKAGING SPECIALISTS, INC.] being recognized, in trademark evaluation, to have no source indication or distinguishing capacity” (citing *In re E.I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984))).

Although the applicant entered a disclaimer of the descriptive wording “POWER SYSTEMS,” the applicant failed to disclaim the entity designation “INC.” Therefore, the requirement for a disclaimer of the term “INC.” was made final.

CONCLUSIONS

The examining attorney has demonstrated that the parties are both using the wording "BLUE STAR" on generators used to produce electrical power. Furthermore, the examining attorney has shown that generators of various sizes and for both commercial and domestic use come from common sources and are marketed in the same channels of trade. When consumers encounter such identical goods bearing demonstratedly similar marks, confusion as to source is likely. For the foregoing reasons, the examining attorney respectfully requests that the refusal to register the Applicant's mark under Section 2(d) of the Trademark Act be affirmed. Furthermore, the examining attorney has established that the entity designation "INC." must be disclaimed apart from the mark as shown. The examining attorney respectfully requests that the refusal to register the applicant's mark based upon the disclaimer requirement made pursuant to Section 6(a) of the Trademark Act be affirmed.

Respectfully submitted,

/Tina L. Snapp/

Tina L. Snapp

Examining Attorney

Law Office 116

571-272-9224


(tina.snapp@uspto.gov for informal e-mails only)

Michael W. Baird

Managing Attorney

Law Office 116


BRAIN TRAINING GAMES

Memory Focus Spatial Reasoning
Attention Speed Problem Solving  [Play Games](#)

[Search](#)

[Dictionary](#) [Thesaurus](#)





1x
points on other purchases

[Learn More](#)

Inc. - definition [Show less](#)

ABBREVIATION

[View thesaurus entry for Inc.](#)

[What are red words?](#)

[Using the thesaurus](#)


Incorporated; used in the U.S. after the name of a large company, or a group of companies working together under one name

Principal Financial Group, Inc.

 [Thesaurus entry for this meaning of Inc.](#)

This is the American English definition of Inc. [View British English definition of Inc.](#)
[Change your default dictionary and thesaurus to British English.](#)
[View the pronunciation for Inc.](#)

Game changer.



[Learn About it](#)

Share this definition of Inc.



Did you know?
Click any word in a definition or example to find the entry for that word



of digital expertise at the heart of the ELT classroom



of digital expertise at the heart of the ELT classroom



BuzzWord

lomography

a creative, experimental form of photography using film and an analogue camera

[BuzzWord Article](#)

More BuzzWords

4-D plothole yarn bombing
movieoke hate-watching reverse graffiti
Automavision photobombing nature deficit disorder

[BuzzWord archive](#)

Open Dictionary

brick

to make a device ... useless by installing or changing a programme on it

[add a word](#)

More submissions

advertainment kemosabe begrumped muscovado
nunchaku bloatware conlang frangible
inn KPI technophile show a bit of ankle

[view entries](#)

Word of the Day

straggly

growing in an untidy way

Blog

A must for anyone with an interest in the changing face of language. The Macmillan Dictionary blog explores English as it is spoken around the world today.

[global English and language change from our blog](#)

American definition of Inc. from the online English dictionary from Macmillan Publishers Limited.