

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: December 19, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Timber Products Co. Limited Partnership*  
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Serial Nos. 86773720 and 86781046  
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David P. Cooper of Kolisch Hartwell PC,  
for Timber Products Co. Limited Partnership.

Mayur Vaghani, Trademark Examining Attorney, Law Office 124,  
Lydia Belzer, Managing Attorney.

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Before Mermelstein, Shaw and Pologeorgis,  
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

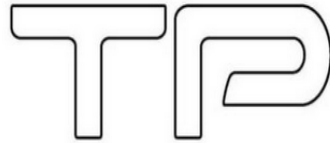
Timber Products Co. Limited Partnership (“Applicant”) seeks registration on the Principal Register of the marks TP, in standard characters,<sup>1</sup> and TP, in a stylized font as displayed below,<sup>2</sup> for, respectively, “trucking services, namely, hauling of lumber,

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<sup>1</sup> Application Serial No. 86773720, filed on September 30, 2015, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming March 30, 2013 as both the date of first use and the date of first use in commerce.


<sup>2</sup> Application Serial No. 86781046, filed on October 7, 2015, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming March 30, 2013 as both the date of first use and the date of first use in commerce.

wood products and freight” and “trucking services, namely, hauling of lumber, wood products and freight transport by truck,” both in International Class 39.



The Trademark Examining Attorney has refused registration of both of Applicant’s marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that each of Applicant’s marks so resembles the two registered marks, as illustrated below and owned by the same Registrant, that use of Applicant’s marks in connection with Applicant’s services is likely to cause confusion or mistake or deceive:

1.  for “Trucking services, namely, hauling of heavy equipment, freight relocation, namely, freight transportation by truck; warehouse storage; storage of goods,” in International Class 39;<sup>3</sup>

2.  (The wording TRANSIT PROS and NATIONAL HEAVY TRUCK & EQUIPMENT SPECIALIST” are disclaimed) for “Arranging and coordinating the movement of equipment from pick-up to delivery for auctions, insurance companies, trucking companies, and leasing companies,” in International Class 39.<sup>4</sup>

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<sup>3</sup> Registration No. 4208780, issued on September 18, 2012.

<sup>4</sup> Registration No. 4216270, issued on October 2, 2012.

After the Trademark Examining Attorney made the refusals final, Applicant appealed and requested reconsideration. After the Trademark Examining Attorney denied the requests for reconsideration, the appeals resumed. Applicant and the Examining Attorney have filed briefs. We affirm the refusals to register each mark.

These appeals involve common questions of law and fact and the records are substantially similar. Accordingly, we consolidate and decide both appeals in this single decision.<sup>5</sup> See *In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009); TBMP § 1214 (June 2017).

In this case, we shall base our Section 2(d) likelihood of confusion findings and decision on only one of the cited registrations, i.e., on Registration No. 4208780, which

is of the mark  for Class 39 services identified in the registration as “trucking services, namely, hauling of heavy equipment, freight relocation, namely, freight transportation by truck; warehouse storage; storage of goods.” A finding of likelihood of confusion between Applicant's marks and this previously-registered mark suffices by itself to bar registration of Applicant's mark under Section 2(d); we need not find likelihood of confusion as to both of the cited registrations. See *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1201 (TTAB 2009).

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<sup>5</sup> Unless otherwise specified, all TTABVUE and Trademark Status and Document Retrieval (“TSDR”) citations reference the docket and electronic file database for Application Serial No. 86773720. All citations to the TSDR database are to the PDF version of the documents.



## **I. Applicable Law**



Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the services. *See 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 [services] and differences in the marks.”).

### **A. *The similarity or dissimilarity of the marks.***

We first address the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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) (quotation omitted).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, 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.”). On the other hand, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat'l Data*, 224 USPQ at 751.

Applicant’s marks are TP (in standard characters) and . Registrant’s mark is . Visually, the involved marks are similar insofar as they are all comprised in their entirety of the letter “T” followed by the letter “P.” Moreover, one of Applicant’s TP marks is in standard characters. A mark in standard characters may be displayed in any lettering style, including a style identical to Registrant’s; the rights reside in the wording or other literal element and not in any particular display or rendition. Thus, a mark presented in standard characters such as Applicant’s generally will not avoid likelihood of confusion with a mark that is stylized because the marks could be presented in the same manner of display. *See, e.g., In re Viterra Inc.*, 671 F.3d 1358, 1010 USPQ2d 1905, 1909 (Fed. Cir. 2012); *SquirtCo v. Tomy*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (“[T]he argument concerning a difference in type style

is not viable where one party asserts rights in no particular display.”); *see also Anheuser Busch, LLC v. Innvopak Sys. Pty. Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015) (a standard character mark “could be used in any typeface, color, or size, including the same stylization actually used . . . [in Registrant’s mark], or one that minimizes the differences or emphasizes the similarities between the marks.”). Furthermore, when comparing Applicant’s stylized  mark with Registrant’s stylized  mark, we do not find that either stylization is so distinctive so as to avoid confusion, particularly since the marks are phonetically identical and because it is the word portion of the marks which is most likely to be impressed upon a customer’s memory as it is used by prospective purchasers when asking for Applicant’s and Registrant’s services. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Dakin’s Miniatures Inc.*, 59 UPSQ2d 1593, 1596 (TTAB 2001); *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). We further find that, in light of the visual and phonetic similarities between the marks, the involved marks are also similar in connotation and overall commercial impressions.

Overall, and considering the marks as a whole, we find that the similarities in sound, appearance, connotation and commercial impression between Applicant’s marks and the cited mark clearly outweigh any differences.

The first *du Pont* factor thus supports a finding that confusion is likely.

**B. *Relatedness of the Services.***

Turning next to the services, which are nearly identical in the applications, we must determine whether their degree of relatedness to the services in cited Registration No. 4208780 rises to such a level that consumers would mistakenly believe the services emanate from the same source. The comparison must be based on the identifications in the applications and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Here, Applicant's services are identified essentially as "trucking services, namely, hauling of lumber, wood products and freight." The services in cited Registration No. 4208780 are "trucking services, namely, hauling of heavy equipment, freight relocation, namely, freight transportation by truck; warehouse storage; storage of goods." Applicant argues that there are "sufficient, cumulative differences" between the services because Applicant's services include hauling lumber and wood products.<sup>6</sup> Applicant's argument is not persuasive. Although Applicant's services specifically include the hauling of lumber and wood products, both of those items would appear to be included in the term "freight," and thus within the scope of Registrant's "freight transportation by truck." In any event, both Applicant's identified services and Registrant's services in cited Registration No. 4208780 encompass the transport of freight via truck. As such, the services are identical in part. Registration must be

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<sup>6</sup> Applicant's Appeal Brief, p. 3; 7 TTABVue 4.

refused if confusion would be likely as to *any* service recited in the application. See *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

In view thereof, the *du Pont* factor relating to the similarity of the services weighs in favor of likely confusion.

**C. Similarities of Trade Channels and Classes of Purchasers.**

Because Applicant's services are identical in part to the services in cited Registration No. 4208780, it is presumed that Applicant's services and Registrant's services are offered in the same channels of trade and to the same class of purchasers normal for those services. See *In re Viterra Inc.*, 101 USPQ2d at 1908 (the Board may rely on this legal presumption in determining likelihood of confusion). See also *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers."). Thus, this *du Pont* factor also favors a finding of likelihood of confusion.

**D. Consistency of Examination, Prior Use and Family of Marks.**

Applicant maintains that it is the owner of a family of TP marks.<sup>7</sup> Applicant further contends that it controls use of the registered mark TP TRUCKING (in

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<sup>7</sup> *Id.*

standard characters; TRUCKING disclaimed) for “freight transportation by truck and ship,” which is the subject of Registration No. 2246321, because the registrant is a wholly-owned subsidiary of Applicant.<sup>8</sup> In light of its alleged ownership of a family of TP marks and asserted control of use of a mark subject to a prior registration owned by its wholly-owned subsidiary, Applicant argues, apparently pursuant to the thirteenth *du Pont* factor, which permits the Office to consider other information relevant to likelihood of confusion, *see In re E. I. du Pont*, 177 USPQ at 567, that since its wholly-owned subsidiary over which it exercises control already owns a registration for a mark that is similar to its applied-for marks, that identifies identical services as those identified in its applications, and because it has priority of use over the cited registration, it would be inequitable to not allow its applied-for marks to register, particularly since Applicant’s wholly-owned subsidiary’s prior registration has coexisted with the cited registration since at least 2010.<sup>9</sup>

Whether refusing to register the marks now before us may be considered inconsistent with the issuance of the earlier registration for a different mark owned by Applicant’s wholly-owned subsidiary, we do not consider the issuance of the earlier registration to be a dispositive factor against a finding of likelihood of confusion. As discussed above, the Examining Attorney’s refusals are justified on the record in this consolidated case. The existence of a prior registration owned by Applicant’s wholly-owned subsidiary over which Applicant allegedly maintains control does not outweigh

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<sup>8</sup> *Id.*

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

the other *du Pont* factors. To hold otherwise would give preclusive effect to the decisions of the Examining Attorneys in granting the prior registration, and the Board is not bound by the decisions of Examining Attorneys. To the contrary, “the [US]PTO must decide each application on its own merits, and decisions regarding other registrations do not bind either the [USPTO] or [the reviewing] court.” *See In re Boulevard Entm’t*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003). The issuance of the prior registration does not compel the issuance of a second or third registration if it would otherwise be improper to do so. *Cf. In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009).

In that regard, Applicant was not without a remedy against the refusals of registration in this consolidated appeal. Applicant could have sought a suspension of the prosecution of its involved applications after receiving the Section 2(d) refusals to pursue, in conjunction with its wholly-owned subsidiary, (1) a cancellation proceeding against the cited registration, or (2) possibly a consent agreement with the Registrant. The record demonstrates, however, that Applicant pursued neither of these alternatives.

Furthermore, we find unavailing Applicant’s argument that, based on the prior registration issued to its wholly-owned subsidiary and alleged ownership of a family of TP marks, it has priority of use over the cited registration. It is well established that an applicant’s assertion of priority of use may be given no consideration in an *ex parte* proceeding when registration has been refused under Section 2(d) of the Act in view of a subsisting registration. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ


278, 280 (CCPA 1971) (“As the board correctly pointed out, ‘the question of priority of use is not germane to applicant’s right to register’ in this *ex parte* proceeding.”); *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373, 1375 n.3 (TTAB 2001). The rationale behind these decisions is that the portion of Section 2(d) which proscribes registration of a mark likely to be confused with a mark registered in the Patent and Trademark Office does not speak of priority but of a “mark registered”; and that an applicant’s assertion of priority of use in such a case constitutes a collateral attack upon the cited registration, which attack cannot be entertained in an *ex parte* proceeding. *In re Calgon*, 168 USPQ at 280. As discussed above, Applicant’s possible priority of use gave Applicant a remedy by way of a petition to cancel the cited registration, but overall, this is not a case in which the existence of Applicant’s wholly-owned subsidiary’s earlier registration outweighs the impact of the other *du Pont* factors on the issue of a likelihood of confusion.

Finally, Applicant’s family of TP marks argument is without merit. In an *ex parte* appeal, the focus of the likelihood-of-confusion analysis must be the mark applicant seeks to register. In other words, a family-of-marks argument is not available to an applicant seeking to overcome a likelihood of confusion refusal. *In re Lar Mor Int’l, Inc.*, 221 USPQ 180, 183 (TTAB 1983) (“In reaching the conclusion of no likelihood of confusion, we have given no weight to applicant’s argument ... that it owns a family of French-word marks all beginning with the word ‘TRES’...”); *In re Ald, Inc.*, 148 USPQ 520, 521 (TTAB 1965) (“Likewise, in view of the specific prohibition of Section 2(d) of the Statute, the fact that applicant may possess a ‘family’ of marks

characterized by the term ‘ALD’ is of no particular significance herein if the mark for which applicant now seeks registration, ‘ALDPRESS’, when considered in its entirety, is confusingly similar to the previously registered mark ‘ALLPREST.’” (footnote omitted).

## II. Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. Because the marks in their entireties are similar, the services are identical in part, and insofar as Applicant’s services are presumed to travel in the same trade channels and offered to the same class of purchasers as Registrant’s services, we find that Applicant’s marks for its identified services are likely to cause confusion with the cited Registration No.

4208780 for the mark  . In view of this finding, we need not consider whether Applicant's use of its involved marks is likely to cause confusion with Registration

No. 4216270 for the mark  .

**Decision:** The Section 2(d) refusals to register Applicant’s marks in application Serial Nos. 86773720 and 86781046 on the basis of Registration No. 4208780 are affirmed.