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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Total Energy Corp.

Serial Nos. 75352844 and 75352845¹

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Total Energy Corp.

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101 (Ronald Sussman, Managing Attorney).

Before Walters, Walsh and Cataldo, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

On September 8, 1997, Total Energy Corp. (applicant)
filed two intent-to-use applications to register two
closely related marks on the Principal Register, the mark
TOTAL ENERGY and Design shown below (Serial No. 75352844)
and TOTAL ENERGY in standard-character form (Serial No.
75352845).

¹ We have consolidated the appeals in these two applications for
decision in one opinion; the appeals were filed by the same party
for related marks, and they involve the same issues.



In each of the applications applicant has now identified its services as:

distributorships featuring natural gas liquids and natural gas, heating oil, coal, propane and electricity to commercial, residential and governmental end-users and distributors to end-users, in International Class 35;

brokerage of energy, in International Class 36: and

distribution of natural gas liquids and natural gas, heating oils, coal, propane and electricity to commercial, residential and governmental end-users and distributors to end-users, In International Class 39.

In each of the applications applicant has disclaimed "ENERGY."

In both applications, the Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with prior Registration No. 2131701 for the mark TOTAL in standard-character form on the Principal Register for:

oil and gas well drilling; land vehicle service station services; and car washing, in International Class 37;

transportation of petroleum and petroleum-derived products through pipelines, in International Class 39;

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oil and gas production, in International Class 40; and
oil and gas exploration; retail motor fuel supply
services; restaurant, cafeteria, and fast food
restaurant services; retail store services in the
field of petroleum, petroleum-derived products, and
related merchandise, in International Class 42.

The registration issued on January 27, 1998, and the
registration is active. When the Examining Attorney made
the refusals final applicant appealed.

During the prosecution of these applications, from
July 7, 1999 until July 29, 2004, the Examining Attorney
suspended action on the applications to permit applicant to
work out a consent with the owner of the cited
registration. Applicant has not submitted a consent in
either application.

Both applicant and the Examining Attorney have filed
briefs. In Application Serial No. 75352845 applicant filed
a motion requesting that we accept applicant's late-filed
reply brief. We grant the motion; the reply brief is
essentially identical to the reply brief filed in the
related application.

We affirm the refusals.

I. Procedural Matters

Before addressing the merits of the case we wish to
clarify several points. In its main brief applicant

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identifies five additional TOTAL registrations also owned by the owner of cited Registration No. 2131701 referenced above. Applicant's Brief at 1. Then, under the heading "Procedural History," applicant states, "In the first official letter, issued on June 12, 1998, the Examining Attorney refused the mark under Section 2(d). The Examining Attorney based the refusal on *some of the prior TOTAL Registrations.*" (Emphasis provided.) *Id.* at 4. Here, applicant appears to refer to some or all of the five registrations it identified on page 1 of its brief. Later in the same section applicant states, "On July 19, 2004, the Examiner withdrew the suspension and continued her final refusal pursuant to Section 2(d) and cited Registration No. 2131701 for the mark TOTAL as an *additional basis under Section 2(d).*" (Emphasis provided.) *Id.*

Applicant's account is inconsistent with the records in these applications. In both applications, in the first office actions both dated June 12, 1998, the Examining Attorney refused registration under Trademark Act Section 2(d) based on Registration No. 2131701, and no other registration. This is the only registration which was ever cited in either of these applications, and it is the only cited registration at issue in these appeals.

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The Examining Attorney did refer to certain of these other registrations owned by the owner of Registration No. 2131701 in later actions in both applications, without citing them, as evidence that the cited mark was a house mark used by the registrant. The Examining Attorney also suggests that these registrations show that the cited mark is a member of a family of marks. We find these arguments misplaced in the circumstances of this ex parte case, and therefore, we have not considered them.

On this record we have no basis to determine whether the cited mark is a house mark. Likewise, we have no basis to determine whether the cited mark is a member of a family of marks. *In re Globe-Union Inc.*, 189 USPQ 158, 160 (TTAB 1975) ("[O]wnership of a number of registrations for marks containing a common component is insufficient, per se, to establish a 'family of marks.'"). See generally *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

II. Likelihood of Confusion

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion..." 15 U.S.C. § 1052(d).

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The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the services of the applicant and registrant. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). Below we will consider each of the factors as to which applicant or the Examining Attorney presented arguments or evidence.

A. The Services

The services of applicant and the registrant need not be identical to find likelihood of confusion under Section 2(d) of the Trademark Act. They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the services originate from the same source. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). See also *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

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Furthermore, in comparing the services we must consider the services as identified in the application and registrations. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods [or services].").

Applicant does not mention the relationship between applicant's identified services and those identified in the cited registration in any of its briefs. On the other hand, the Examining Attorney argues that the services of applicant and those in the cited registration are closely related.

Applicant identifies its services broadly. Applicant's services include, among others,

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distributorships featuring and distribution of natural gas liquids and natural gas, heating oil, coal, propane and electricity to commercial, residential and governmental end-users and to distributors to end-users.

The services identified in the cited registration are also quite broad. The cited registration identifies, among other services: land vehicle service station services; transportation of petroleum and petroleum-derived products through pipelines; retail motor fuel supply services; retail store services in the field of petroleum, petroleum-derived products, and related merchandise.

Thus, the services of applicant and registrant, particularly as identified at the retail level, are closely related, and even overlapping. For example, applicant's distribution of heating oil to residential and commercial end-users could overlap with the retail store services in the field of petroleum and petroleum-derived products identified in the cited registration. Accordingly we conclude that the services of applicant and registrant are overlapping and otherwise closely related.

Furthermore, we note that, "the degree of similarity [between the marks] necessary to support the conclusion of likely confusion declines" when the goods or services are identical. *Century 21 Real Estate Corp. v. Century Life of*

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America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1992).

B. The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, "...in 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, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The Examining Attorney argues that the marks of applicant and registrant are similar because they share the same dominant, distinctive element, TOTAL, and because the addition of the word ENERGY and the design are insufficient

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to distinguish the marks. We agree with the Examining Attorney and conclude that applicant's marks are highly similar to the cited mark.

We acknowledge, as applicant argues, that the marks must be considered in their entireties. However, certain elements may be more significant or dominant than others in that overall comparison. Here, applicant has disclaimed the additional term "ENERGY" and used it generically in its own identification of services. Generic matter, such as ENERGY in this case, is less significant when comparing the marks. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

Furthermore, we note that TOTAL, the word which the marks share in common, and the only distinctive word element in the marks of applicant and the mark in the cited registration, is also the first word in the marks. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("...[it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692 ("The presence of this strong distinctive term as the first word in both parties' marks renders the marks similar,

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especially in light of the largely laudatory (and hence non-source identifying) significance of ROYALE.”).

In the case of the special form version of applicant’s mark, we likewise find that the design element is insufficient to distinguish applicant’s mark from the mark in the cited registration. In *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987), the Board stated, “Thus, if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985).”

We reject applicant’s argument that the commercial impressions of the marks differ because TOTAL is an adjective as used in applicant’s marks as opposed to its use as a noun in the cited mark. To the extent that there may be a dictionary distinction in meanings, the distinction is too obscure and too subtle to serve as the basis for the conclusion that the marks differ in commercial impression or otherwise.

We also reject applicant’s argument that the marks differ because registrant is a French company and relevant consumers will consequently perceive registrant’s mark as a French word and use the French pronunciation, in contrast

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to the English pronunciation which would apply to applicant's mark. This argument is counter not only to common sense but to bedrock principles of trademark law. The simple facts are that the word TOTAL is identical in the marks of both applicant and registrant and that there is no basis to believe that U.S. consumers will pronounce TOTAL differently in the TOTAL mark versus the TOTAL ENERGY marks. Furthermore, trademarks identify anonymous sources. *Johnson & Johnson v. E. I. du Pont de Nemours and Company, Inc.*, 181 USPQ 790, 791 (TTAB 1974) ("... [T]he function of a trademark is to identify a single, albeit anonymous source of commercial sponsorship of the goods [or services]..."). Thus, it is improper to interpose an expectation that relevant consumers will know the identity and nationality of the registrant. Finally, there is no correct pronunciation of a trademark. *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006). Therefore, we reject applicant's argument based on different pronunciations of the marks.

Applicant also argues that the registered TOTAL mark is entitled only to a narrow scope of protection due to the existence of third-party registrations for TOTAL marks for similar services. We also reject this argument.

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In its response to the first office actions in these applications applicant identified two registrations, which it again identifies in its briefs, as the basis for this argument, namely, Registration No. 1908703 for the mark TOTAL FLUIDS MANAGEMENT owned by Haliburton Energy Services, Inc. for managing for others drilling, completion and well development projects in the oil, gas and geothermal industries and Registration No. 1346794 for the mark TOTAL SYSTEMS APPROACH owned by Baker Hughes Inc. for chemical treatment services for the oil and gas industry.

We note preliminarily that applicant has not submitted copies of USPTO records related to these registrations and that, on that basis, we would not ordinarily consider the information. See *In re Dos Padres Inc.*, 49 USPQ2d 1869, 1861 n.2 (TTAB 1998). However, in this case we will consider the information applicant provided for whatever probative value it warrants because the Examining Attorney did not object to the evidence and thereby afford applicant the opportunity to submit it in proper form.

In considering this evidence, we conclude that it is insufficient to establish that TOTAL is a weak mark for the services identified in the cited registration. Both referenced registrations identify highly specialized services rendered only to energy companies. In contrast

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the applications and registration at issue here identify services which would also be rendered to the end users of energy products. More importantly, under the circumstances of this case, the two registrations are quantitatively insufficient. While there is no magic number which would be sufficient in all cases, we note that the evidence here falls far short of the quantum of evidence in cases where we have found the term in question weak. *Cf. Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005). In *Knight Textiles*, in concluding that ESSENTIALS was highly suggestive the Board relied primarily on a dictionary definition for "essential-s" and "twenty-three extant ESSENTIAL registrations on the register in the clothing field registered to twenty-one different owners." *Knight Textile*, 75 USPQ2d at 1316.

In sum, we conclude that the marks of applicant and registrant are highly similar and that the registered mark is entitled to the same degree of protection which would be accorded to any registered mark.

C. Other Arguments

Lastly, applicant argues that we should reverse the refusals here because the owner of the cited registration had opposed another application by applicant and, "... withdrew its opposition to Applicant's mark TOTAL ENERGY

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and Design, Application Serial No. 75/185,049... which has now been issued Registration No. 3,211,980." Applicant's Reply Brief at 2. Applicant states further, "The fact that Total SA withdrew the opposition to the same mark involving the 'brokerage of energy' where the services associated with the mark which is the subject of this ex parte appeal are for the same brokerage services demonstrates that Total S.A. does not believe confusion is likely." Applicant's Brief at 7.

Here also, applicant has failed to submit a copy of relevant USPTO records regarding this application and the related proceeding. See *In re Dos Padres Inc.*, 49 USPQ2d at 1861 n.2. Applicant's Reply Brief at 2. More importantly, even if this evidence were made of record in proper form, we would not consider it. In an ex parte proceeding such as this, we will not consider extrinsic unsupported arguments from applicant regarding the registrant's position. Cf. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (extrinsic evidence and argument suggesting trade-channel restrictions not specified in application rejected).

Furthermore, the Examining Attorney suspended action in these applications for five years for the specific purpose of permitting applicant to negotiate a consent with the

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owner of the cited registration. The applications, and these appeals, were suspended again for an extended period pending the disposition of the referenced opposition proceeding. Thus, applicant has had every opportunity to obtain and file an appropriate consent with regard to the specific applications at issue in these appeals, and applicant has not done so. Accordingly, we reject applicant's arguments based on the unsupported allegation that registrant does not believe confusion is likely here.

III. Conclusion

In conclusion, we find that there is a likelihood of confusion between applicant's TOTAL ENERGY marks at issue here and the TOTAL mark in the cited registration. We conclude so principally because the marks are highly similar and because the services of applicant and registrant are overlapping or otherwise closely related.

Decision: The refusals to register the marks in both applications under Section 2(d) of the Trademark Act are affirmed.