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Paper No. 17
TJQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Guardian International, Inc.

Serial No. 75/597,830

Jeffrey A. Smith of Millen, White, Zelano & Branigan for applicant.

Scott Baldwin, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Cissel, Quinn and Chapman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Guardian International, Inc. to register the mark shown below



for "installation and maintenance of burglar alarms, fire alarms, home and commercial security systems, voice

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intercom systems and closed circuit television (CCTV) and card access systems" (in International Class 37) and "monitoring of burglar alarms, fire alarms and home and commercial security systems" (in International Class 42).¹

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when used in connection with applicant's services, so resembles the marks shown below as to be likely to cause confusion:



for "installation of burglar alarms and burglar alarm protection services;"² and

¹ Application Serial No. 75/597,830, filed November 30, 1998, alleging a date of first use and first use in commerce of January 1993. The word "Security" is disclaimed apart from the mark. Applicant also claims acquired distinctiveness as to the word "International" in its mark; the Examining Attorney accepted the claim. The application includes the following description: "The mark consists in part of a stylized letter G in an octagon design."

² Registration No. 1,915,441, issued August 29, 1995, combined affidavit under Sections 8 and 15. The terms "Protected By," "Burglar Alarm," and "1-800" are disclaimed.



for "monitoring of security systems" and "installation of security systems."³ The registrations are owned by different entities.⁴

When the refusals to register were made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.⁵ An oral hearing was not requested.

Applicant acknowledges that its services and those listed in the cited registrations are identical. Applicant goes on to argue, however, that the term "guardian" is weak as used in connection with security services and goods. According to applicant, the scope of protection to be given to each of the cited registrations is limited due to extensive third-party use and many registrations of the

³ Registration No. 2,151,624, issued April 21, 1998. The words "Protection Services" are disclaimed.

⁴ A third registration, Registration No. 1,141,617, owned by the same entity that owns Registration No. 1,915,441 also was cited in the final refusal. A check of Office records shows that Registration No. 1,141,617 was canceled on December 2, 2001 for failure to renew. Accordingly, the appeal with respect thereto is moot.

⁵ Applicant, in its brief, updates the status of three third-party applications, one of which has matured into a registration. As applicant itself recognizes (reply brief, p. 4, n. 1), this evidence was not timely submitted. Accordingly, we have not considered it in reaching our decision.

term "guardian" in the security field. In support of its position, applicant submitted a dictionary definition of the word "guardian"; several third-party registrations of marks incorporating the word "guardian" for security services and goods; a computerized search report listing common law uses of "guardian"; and excerpts retrieved from the Internet pertaining to use of the word "guardian" in the security industry.

The Examining Attorney highlights the identity of the services, and maintains that the cited registrations and applicant's mark share the same dominant term "guardian." The Examining Attorney also asserts that this dominant term is not weak. In connection with this later contention, the Examining Attorney is not persuaded by applicant's evidence bearing on the use and registration of "guardian" in the security field. The Examining Attorney concludes that the marks engender substantially similar overall commercial impressions.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. Du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key factors are the similarities

between the marks and the similarities between the services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

In the present case, the services, as acknowledged by applicant, are identical. Thus, we focus our attention, as have applicant and the Examining Attorney, on the similarities between the marks and the du Pont factors relating thereto.

The term "guardian" is defined as "one that guards or secures: one to whom a person or thing is committed for protection, security, or preservation." *Webster's Third New International Dictionary* (unabridged ed. 1986). Based on the dictionary definition alone, it is clear that the term "guardian" is at least highly suggestive in relation to security services that involve the protection of persons, things and/or places. Lest there be any doubt on this point, the record includes examples of not only numerous third-party registrations of marks incorporating the term "GUARDIAN," but also of over 100 common law uses of the term by businesses in the security field.⁶ Thus, it

⁶ We agree with the Examining Attorney that the evidence pertaining to uses outside of the security industry are not probative. However, the entire record shows there are a significant number of uses and registrations in connection with security services and goods.

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is not surprising that the two cited registrations, owned by different entities, have coexisted on the register.

Although the term "guardian" is dominant in each of the marks, the highly suggestive nature of the term "guardian" is a significant factor in comparing the marks. Given the multitude of uses of the term "guardian" in the security industry, the evidence suggests that consumers would be accustomed to distinguishing between marks containing such a highly suggestive term upon other elements of the marks. See: *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996); and *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1479 (TTAB 1987).

Indeed, we must compare the marks in their entireties, and although the term "GUARDIAN" is dominant, each of the involved marks includes additional different wording and design features that cannot be ignored. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). The additional wording and prominent design features of each mark are different and, in our view, sufficient to distinguish the marks. Applicant's mark includes a stop sign silhouette, whereas one cited registration employs a law enforcement badge silhouette and

the other a sideways chevron design. When the marks are considered in their entirety, applicant's mark engenders an overall commercial impression sufficiently different from each of the cited registrations that consumers are unlikely to be confused even as to identical services.

See: *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1431 (TTAB 1993).

The marketplace reality of the security industry is, not surprisingly, that the word "guardian" has in the past appealed to others in the industry as an appropriate term for a mark or part of a mark. Accordingly, the mere inclusion of the term in the marks involved herein is not, in and of itself, a sufficient basis for a finding of likelihood of confusion where the marks are otherwise distinguishable. We see the Examining Attorney's view of the likelihood of confusion as amounting to only a speculative, theoretical possibility. See: *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), citing *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967).

In sum, in view of the highly suggestive nature of the term "guardian" in the security industry, and the prominent

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differences in the other wording and designs between the involved marks, we conclude that consumers are unlikely to be confused as to the source of the services when the marks are considered in their entireties.

Decision: The refusals to register are reversed.