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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Creaholic S.A.

Serial No. 75/729,782

David Spaw of Rankin, Hill, Porter & Clark LLP for
Creaholic S.A.

Young Oh (Richard) Kim, Trademark Examining Attorney, Law
Office 115 (Tomas Vlcek, Managing Attorney).

Before Quinn, Hairston and Drost, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

Creaholic S.A. has filed an application to register
WOODWELDING as a trademark for the following goods and
services:

building lumber; portable and pre-fabricated
non-metal buildings, lumber in the nature of
formed, pressed and partially pressed wood in
class 19;

construction planning in class 37;

cutting of wood to the specification of others,
providing information on the processing of

materials, namely wood and metal in class 40;

consultation on processing of materials, namely wood and metal; product development; engineering; computer consultation; research in the field of mechanical engineering; material testing; leasing of computer software; all in the fields of automotive manufacture, automotive marketing, wood and metal processing machines, fastening techniques for wood and other nonmetallic materials, nonmetal mountings, wood and metal fabrication machines, plastics technology, structural engineering, wooden construction, furniture construction, interior design, and interior construction in class 42.¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052 (e)(1), on the basis that, when used in connection with applicant's goods and services, the mark is merely descriptive of them. Registration has also been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark, when used in connection with its goods and services, so resembles the mark WOODWELD, which is registered for "synthetic resins used in the manufacture of pressed wood products,"² as to be likely to cause confusion, mistake or deception.

¹ Serial No. 75/729,782, filed June 16, 1999, based on applicant's allegation of a bona fide intention to use the mark in commerce.

² Registration No. 1,227,991 issued February 22, 1983; renewed.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

Turning first to a consideration of the issue of mere descriptiveness, the Examining Attorney argues that the term WOODWELDING merely describes a process of welding together pieces of wood. According to the Examining Attorney, the term "is merely descriptive of applicant's goods since such goods are most likely used in the wood welding process" and is merely descriptive of applicant's services "to the extent that they relate to wood welding." (Final refusal, p. 3). In support of the refusal, the Examining Attorney submitted printouts of pages from applicant's website. In addition, the Examining Attorney submitted with his appeal brief, an excerpt from The American Heritage Dictionary of the English Language Dictionary wherein one of the definitions of "weld" is "to bring into close association or union."³

Applicant, in urging reversal of the refusal to register, argues that WOODWELDING is an incongruous term as used in connection with the identified goods and services and, therefore, it is not merely descriptive of them.

³ We have considered such definition inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Applicant maintains that wood cannot be welded in the usual sense because wood burns and chars when heated. In support of its contentions, applicant relies on the following definitions of the word "welding" from the Academic Press Dictionary of Science and Technology and the Dictionary of Technical Terms for Aerospace Use, respectively:

the joining of two metal surfaces that have been heated, melted and fused together; and

joining two or more pieces of metal by applying heat, pressure, or both, with or without filler material to produce a localized union through fusion or recrystallization across the interface.

Further, applicant contends that this case is similar to *In re Shutts*, 217 USPQ 363 (TTAB 1983) wherein the Board held that the mark SNO-RAKE was not merely descriptive of a snow removal hand tool. Applicant maintains that it coined the term WOODWELDING and points out that the only examples of WOODWELDING the Examining Attorney has been able to locate are references to applicant's technology.

A mark is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18. (CCPA 1978). It

is not necessary that a mark describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the mark describes a significant attribute or idea about them. Moreover, whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

As noted previously, the Examining Attorney made of record copies of pages downloaded from applicant's website. The following are excerpts from those pages wherein applicant describes the process of "welding wood":

The idea of welding wood was first thought of more than 5 years ago. Since then, our multidisciplinary team has continuously refined the process and expanded the knowledge about the WoodWelding® technology to include applications on a range of materials.

WoodWelding® is an innovative technology where wood or other porous materials can be fused (not attached) through the use of ultrasound. As joining material, thermoplastics are used in the form of e.g. a nail, dowel, seal or lacquer. The technology offers a substitute to traditional fastening and fixation solutions

such as nails, screws, adhesives, etc. Although in principle a soldering process, the technology was branded "WoodWelding."

The process can be applied on a range of porous materials. The only requirements are that the material has one main direction to the pores, an uneven surface and can withstand a certain degree of pressure. The WoodWelding® process has been tested successfully on materials such as:

- solid wood
- chipboard
- plywood

Creaholic has deep skills and substantial experience working with various types of welding technologies. In collaboration with the Swiss School of Engineering for the Wood Industry in Biel, the concept of welding wood was first thought of in 1984.

In addition, applicant's website contains the schedule for the "World Conference on Timber Engineering" held in July 2000 and one of the sessions scheduled for the conference was identified as "Joint connection with welded thermoplastic dowels and wood welding technologies."

Considering applicant's mark WOODWELDING as used in the above context, we agree with the Examining Attorney that it immediately conveys to the relevant purchasers information concerning a significant feature of applicant's goods and services, namely that they are based on or utilize wood welding. Neither imagination nor thought is required for a purchaser to arrive at this conclusion concerning the nature of the goods and services.

Moreover, in view of the definition of the word "weld" submitted by the Examining Attorney, it is clear that welding is not restricted to joining pieces of metal by applying heat. Instead, welding may encompass bringing together wood and other materials, and it appears that applicant's wood welding technology involves fusing wood and other porous materials with a thermoplastic material. Thus, contrary to applicant, we do not view WOODWELDING as an incongruous term when used in connection with the identified goods and services. This case is unlike *In re Shutts* where the mark SNO-RAKE created an incongruity because it would be highly unusual to request someone to "rake snow." Here, it would seem quite natural for customers of the identified goods and services to use the term "wood welding" in connection with applicant's process of welding wood.

Finally, it is not dispositive that applicant may be the first and only user of the term WOODWELDING. The absence, therefore, on this record of any third-party uses of the term does not lead us to reach a different result. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

This brings us to the refusal to register under Section 2(d) of the Trademark Act. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarities of the goods/services and the similarities of the marks.

The Examining Attorney argues that the marks WOODWELDING and WOODWELD are highly similar, both sharing the term WOODWELD with applicant merely adding -ING. With respect to the goods and services, it is the Examining Attorney's position that applicant's lumber in the nature of formed, pressed and partially pressed wood in class 19 and registrant's synthetic resins are "clearly complementary" because both are utilized in the manufacture of finished wood products." (Brief, p. 9.) Further, the Examining Attorney argues that applicant's identified services and registrant's synthetic resins are related because applicant's services "relate to wood products bonded by synthetic resins." (Brief, p. 10.)

Applicant does not dispute the substantial similarity in the marks. However, applicant contends that registrant's mark is quite suggestive of registrant's goods and therefore it is not entitled to a broad scope of protection. Further, applicant argues that synthetic resins used in the manufacture of pressed wood products are marketed to manufacturers of wood products such as plywood manufacturers to glue pieces of wood together, whereas applicant's identified goods and services will be marketed to parties who work with wood products and who use those wood products to make finished wood products such as furniture. Thus, applicant maintains that the parties' goods and services travel in different channels of trade to different purchasers.

It is well settled that goods and/or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and/or services are related in some manner or that the circumstances surrounding their marketing are such that they would be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the

producers of the goods and/or services. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991); and In re International and Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

Also, it has been repeatedly held that in determining the registrability of a mark, the Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. See In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, we find that there is a sufficient relationship between registrant's synthetic resins used in the manufacture of pressed wood products, on the one hand, and applicant's services of providing information on the processing of wood (class 40) and consultation on processing of wood (class 42), on the other hand, that confusion is likely. In the absence of any limitations as to channels of trade and purchasers in applicant's recitation of services, we must assume that applicant's informational and consultation services in connection with processing would travel in all the normal channels of trade to all the usual purchasers, including the same class of

purchasers to whom registrant's synthetic resins are marketed, namely, manufacturers of pressed wood products. Contrary to applicant's contention, it makes sense that such manufacturers would seek out information and assistance in connection with processing of wood. Purchasers familiar with registrant's synthetic resins sold under the mark WOODWELD may, upon seeing applicant's substantially similar mark WOODWELDING on these related services, assume that applicant's services come from the same source as registrant's goods, or are somehow associated with or sponsored by registrant.

With respect to applicant's contention that registrant's WOODWELD mark is weak and therefore entitled to only a limited scope of protection, even assuming that registrant's mark is weak due to an assertedly high degree of suggestiveness, even weak marks are entitled to protection where confusion is likely. Here, notwithstanding any alleged weakness in registrant's WOODWELD mark, it is still substantially similar to applicant's WOODWELDING mark.

We are not persuaded, on this record, that any of applicant's remaining goods and services are sufficiently related to registrant's synthetic resins that confusion would be likely. There is no evidence of record which

suggests that synthetic resins and applicant's remaining goods and services are the kinds of goods and services that generally emanate from a single source under the same mark. Also, there is no evidence to support the Examining Attorney's contention that such goods and services would be marketed to manufacturers of pressed wood, the class of purchasers of applicant's synthetic resins. Thus, notwithstanding the substantial similarity in the marks, we are not convinced that applicant's remaining goods and services and registrant's synthetic resins are sufficiently related that confusion is likely.

Decision: The refusal to register under Section 2(e)(1) of the Act is affirmed as to each of the classes; the refusal to register under Section 2(d) is affirmed as to classes 40 and 41 and reversed as to classes 19 and 37.