

Hearing:
July 18, 2002

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT 23 JAN 2003
OF THE T.T.A.B.**

Paper No. 13
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re WATERPIK TECHNOLOGIES, INC.

Serial No. 76/019,444

Janel M. Pernell of Buchanan Ingersoll, P.C. for WATERPIK TECHNOLOGIES, INC.

Boris Umansky, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Cissel, Hohein and Drost, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 6, 2000, the above-referenced application was filed to register the mark "ONE TOUCH" on the Principal Register for "electronic controls for pools and spas." The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these products.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that if

Ser No. 76/019,444

applicant were to use "ONE TOUCH" as a trademark for its electronic controls for pools and spas, applicant's mark would so resemble the identical mark "ONE TOUCH," which is registered for "thermostats,"¹ that confusion would be likely. Registration was also refused on the same ground based on the registration on the Principal Register issued to the same corporation for the mark "ONE TOUCH SELECT 'N SAVE" for the same goods, but that registration has since been canceled.²

Applicant responded to the refusal to register with an amendment to the identification of goods in the application and with argument that confusion with the cited registered mark would not be likely. As amended, the goods are described as "electronic controls for pools and spas, namely, an automated control panel that allows [the] user to control lighting, jet streams, filtering, and other functions of pools and spas from a remote location," in Class 9. Applicant submitted copies of third-party registrations and third-party applications, 35 of which are in Class 9, wherein the marks consist of or include the words "ONE TOUCH." Based on these registrations and

¹ Registration No. 1,861,372, issued on the Principal Register to the Hunter Fan Co. on November 1, 1994. Use since September 1, 1993 was claimed. An affidavit under Section 8 was accepted.

² Registration No. 1,863,102, issued on Nov. 15, 1994. Canceled under Section 8 on Dec. 2, 2001.

applications, applicant argued that the term is weak in source-identifying significance, and that differences between the goods set forth in the application and the cited registration would make confusion unlikely in the instant case.

In this regard, applicant argued that its goods are unrelated to the goods specified in the cited registration. According to applicant, applicant manufactures high-end pool products which are not sold in stores, but rather are marketed through an international network of trained and qualified distributors. Pointing to attached pages from its subsidiary company's website, applicant argued that its goods are very sophisticated products used to operate spa jets, lighting, filters, and pumps, sold to sophisticated purchasers for between \$1280 and \$3900. Applicant argued that registrant's goods, in contrast, are thermostats used in connection with home heating and air conditioning systems. Applicant submitted printouts from registrant's website in support of this contention. Applicant argued that this evidence illustrates that registrant's goods are targeted to homeowners who can purchase registrant's goods from dealers and install them themselves. Applicant argued that these goods and the channels of trade through which they move are distinctly different from applicant's

products and the trade channels through which they move. Based on these differences, applicant contended that even though the marks are the same, confusion would not be likely.

The Examining Attorney accepted the amendment to the identification of applicant's goods, but was not persuaded by applicant's arguments against the refusal to register. The refusal was maintained and made final in the second Office Action. In support of the refusal to register, the Examining Attorney submitted additional evidence, including dictionary definitions showing that a thermostat is a device which maintains a system within a specified temperature range by automatically switching on or off the supply of heat. Excerpts from articles retrieved from the Nexis database of publications were submitted to demonstrate that pools and spas commonly use thermostats to control water temperature. The Examining Attorney also noted that applicant's website shows that applicant's electronic controls are used to control the temperature of the water in pools or spas.

Applicant timely filed a Notice of Appeal, which was followed shortly by applicant's appeal brief.³ The

³ Some of the additional evidence submitted by applicant with its brief was properly objected to by the Examining Attorney under

Examining Attorney filed his brief on appeal, and applicant filed a reply brief. Both applicant and the Examining Attorney presented oral arguments at the hearing conducted before the Board on July 18, 2002.

Based on careful consideration of the arguments and the record before us in this appeal proceeding, we hold that the refusal to register is well taken and must be affirmed.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors the Court identified as bearing on the likelihood of confusion issue in *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 considerations are the similarities between the marks and the similarities between the goods. *Federated Food, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Confusion is likely in the case at hand because the cited registered mark is identical to the mark applicant seeks to register, and the goods, as identified in the

different conclusion in this appeal. The evidence submitted with the brief which had previously been made of record was, of course, considered.

Ser No. 76/019,444

seeks to register, and the goods, as identified in the application and the cited registration, respectively, are closely related.

It is well settled that when the marks in question are the same, the goods with which they are used do not need to be as closely related in order to find confusion likely as would be the case if the marks were not the same. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981). In the instant case, the registered mark is identical to the mark applicant seeks to register. Clearly, the use of this mark in connection with goods which are related would be likely to cause confusion.

Applicant's argument that the third-party registrations wherein the marks consist of or include "ONE TOUCH" establish that the mark is weak is not persuasive. It is well settled that the existence of third-party registrations may be used to establish the meanings of terms therein. Each case, however, must be decided on its own record and merits. The Board is not bound by prior decisions to register other marks by Examining Attorneys based on other application records. In *re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). While the third-party registrations submitted by applicant involve products which are not the same as those in issue

in this appeal, they nonetheless do establish the suggestive meaning of the term in connection with applicant's products. That same suggestiveness, however, applies in connection with the goods in the registration cited as a bar in this case, so the third-party registrations do not have the effect of demonstrating that confusion would not be likely.

Moreover, the third-party registrations submitted by applicant do not compel a different result in this case because the registrations are not evidence that the marks shown therein are in use or that the purchasing public is familiar with them, and they cannot aid applicant in its effort to register a mark which so resembles a registered mark as to be likely to cause confusion. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (TTAB 1973); and *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967).

It is the issue of the relationship between the goods on which the briefs of the Examining Attorney and applicant focus primarily. The goods do not need to be identical or even directly competitive in order for the likelihood of confusion to exist. It is sufficient if they are related in some manner, or if the conditions surrounding their marketing are such that they could be encountered by the

Ser No. 76/019,444

same purchasers under circumstances that could give rise to the mistaken belief that the goods emanate from the same source. In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

In this connection, we note that we must determine whether confusion would be likely based on the ways the goods in question are identified in the application and the cited registration, respectively, without any restrictions or limitations not reflected therein. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); Toys "R" Us, Inc. v. Lamps R Us, 219 USPQ 340 (TTAB 1983). Applicant's attempt to narrow the identification of goods in the registration to home heating system thermostats that homeowners purchase at retail and install themselves is therefore fruitless. We must consider the goods identified in the cited registration to include all such products falling within the category identified as "thermostats," and we must assume that these items move in all the normal channels of trade for such products, and that the goods are promoted and available to all potential customers for those types of products. This means that the registrant's goods encompass all types of thermostats, which would of course include thermostats used to set and maintain the temperature of spa

Ser No. 76/019,444

and pool water. As noted above, the evidence of record establishes that thermostats are used for this purpose.

Although applicant makes a number of distinctions between registrant's thermostats and applicant's controls for pools and spas, it is nonetheless true, and applicant concedes, that one of the things its devices do is control the temperature of the spa or pool water. Accordingly, for the purpose of determining whether confusion is likely in this case, we must consider that applicant's controls could be used with or could include thermostats, which are the very goods identified in the cited registration. Plainly, the use of identical marks with such complementary products would be likely to cause confusion.

Even if we were left with any doubt as to this conclusion, such doubt would necessarily be resolved in favor of the registrant and prior user, and against the applicant, who, as the newcomer, has a duty to select a mark which is not likely to cause confusion with a mark already in use in the same field of commerce. *MSI Data Corp. v. Microprocessor Systems, Inc.*, 20 USPQ 655 (TTAB 1985).

DECISION: The refusal to register under Section 2(d) of the Lanham Act is affirmed.