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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Ermanco Inc.**

Serial No. 76/104,568

David Lesht of Cook, Alex, McFarron, Manzo, Cummings & Mehler, Ltd. for **Ermanco Inc.**

Patrick J. Jennings, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before **Hohein, Hairston and Walters**, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Ermanco Inc. has filed an application to register the mark "PARAGON TECHNOLOGIES" for "electrical control panels for operating a material handling system which includes conveyors and/or vehicles."¹

Registration has 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 applied to its goods, so resembles the mark "PARAGON," which is registered, as illustrated below,

¹ Ser. No. 76/104,568, filed on August 7, 2000, which is based on an allegation of a bona fide intent to use such term in commerce. The term "TECHNOLOGIES" is disclaimed.

Paragon

for "electronic automatic power control apparatus,"² as to be likely to cause confusion, or mistake or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

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 the issue of 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 similarity of the goods and the similarity of the marks.³

Turning first to consideration of the respective goods, applicant argues that, other than the fact that "both [are] electronic in nature," such goods "are quite different" in their uses. Specifically, applicant maintains that:

Power control apparatus of the type
designated in the reference registration is

² Reg. No. 1,448,181, issued on July 21, 1983, which sets forth the year 1976 as a date of both first use anywhere and first use in commerce; combined affidavit §§8 and 15.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

typically electronic timers and the like for turning electrical devices on and off. By contrast control panels for operating a material handling system which includes conveyors and/or vehicles typically function to regulate the movement of goods along selected travel paths. Consistent with this, ... a telephone call to the registrant indicated that it does not manufacture or offer to sell control panels of any type, let alone control panels for material handling systems.

Applicant concludes, in view thereof, that "its goods are not 'related' to those of the cited registration" and that its goods, which are identified as being for a particular use, thus "are distinct from" registrant's goods. Applicant also insists that its goods do not overlap with, nor are they encompassed by, the identification of registrant's goods. In addition, because its goods "are not impulse items but rather are sold to sophisticated customers of material handling systems," applicant maintains that confusion from contemporaneous use of the respective marks and goods is unlikely.

We concur with the Examining Attorney, however, that the goods at issue are so closely related that their marketing under the same or similar marks would be likely to cause confusion as to their source or sponsorship. As the Examining Attorney correctly notes, it is well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in

connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Moreover, it well established that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and the cited registration, and not in light of what such goods are shown or asserted to actually be. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where applicant's and registrant's goods are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registration encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for those goods and that they would be purchased by all potential buyers thereof. See, e.g., *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Here, not only is there no evidence of record to substantiate applicant's assertions that registrant's goods are

in the nature of and limited to "electronic timers and the like for turning electrical devices on and off" and that, in fact, "a telephone call to registrant "indicated that it does not manufacture or offer to sell control panels of any type, let alone control panels for material handling systems," but such would in any event be irrelevant and immaterial to determination of the issue of likelihood of confusion. Furthermore, as the Examining Attorney persuasively points out in his brief:

The applicant's goods, "electrical control panels for operating a material handling system which includes conveyors and/or vehicles," are closely related to the registrant's goods, "electronic automatic power control apparatus. Though the applicant says that registrant's "electronic automatic power control apparatus" generally describes "electronic timers and the like for turning electrical devices on and off," ... nothing in the registrant's identification of goods would preclude the registrant's "power control apparatus" from performing some [of] the same functions as the applicant's goods, including the operation of [a] "material handling system which includes conveyors and/or vehicles. In fact, the registrant's "power control apparatus" could regulate the flow of goods along selected travel paths, just as control panels for "material handling systems" often do. Alternatively, the registrant's goods could turn the applicant's goods on or off. Either way, the [respective] goods ... appear to control and/or regulate the flow and/or output of power.

In addition, and contrary to applicant's argument, the identification of registrant's goods as "electronic automatic power control apparatus" is arguably broad enough to encompass such goods as "electrical control panels," including applicant's "electrical control panels for operating a material handling system which includes conveyors and/or vehicles."

Applicant's goods, therefore, must be considered as identical in part or, at a minimum, plainly are closely related to registrant's goods, such that the marketing of the respective goods under the same or similar marks would be likely to cause confusion as to the source or sponsorship thereof, irrespective of the limitation of applicant's goods to the operation of a material handling system which includes conveyors and/or vehicles. While we concur with applicant that its goods, like those of registrant, are not impulse items and would, instead, be marketed to and bought by sophisticated purchasers, the fact that such purchasers would typically be knowledgeable and discriminating consumers who would exercise care in their selection of applicant's and registrant's products "does not necessarily preclude their mistaking one trademark for another" or demonstrate that they otherwise would be entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983).

Turning, therefore, to consideration of the respective marks, applicant contends that:

When properly considered in their entirety, applicant's PARAGON TECHNOLOGIES mark differs in sight, sound and meaning from the cited PARAGON mark. Numerous registrations are directed to PARAGON alone or in combination with another word(s) and during prosecution, applicant made of record a search ... showing over twenty (20) registered marks in International Class 9 alone that include the term "PARAGON." Thus, PARAGON is a relatively weak term and it has extremely limited source indicating power.

Specifically, applicant notes that its mark "is coined" and, notwithstanding the disclaimer of the word "TECHNOLOGIES," argues that its mark "is readily distinguishable from the cited mark" because:

The coupling of PARAGON with TECHNOLOGIES invokes a different commercial impression than just PARAGON alone. In addition to PARAGON TECHNOLOGIES being two words versus PARAGON being one word and the concomitant difference in sight and sound resulting therefrom, the marks have totally different connotations. PARAGON by itself means something that is a model of excellence. PARAGON TECHNOLOGIES presents a unitary expression or at least one where the emphasis is on TECHNOLOGIES and PARAGON, while normally thought of as a noun, modifies TECHNOLOGIES when the two words are coupled. Thus, applicant's mark evokes the image of a "high tech" company. Furthermore, PARAGON has no known significance with respect to applicant's goods or for that matter with respect to electrical goods, in general.

Thus, according to applicant, "the mere fact that the two marks include a common term is not alone enough to create a likelihood of confusion."

Applicant, as alluded to above, further contends that, "in testing for likelihood of confusion, the number and nature of similar marks in use on similar goods must also be considered," arguing in particular that it made of record "more than twenty (20) active registrations in International Class 9 which include PARAGON as part of the mark." Such evidence, applicant maintains, demonstrates that "the source identifying power of PARAGON is extremely limited and narrowly focused to specific goods."

We agree with the Examining Attorney, however, that when considered in their entirety, applicant's "PARAGON TECHNOLOGIES" mark is so similar to registrant's "PARAGON" mark that their contemporaneous use is likely to cause confusion as to the origin or affiliation of the respective goods. As our principal reviewing court has indicated, while marks must be considered in their entirety, including any descriptive matter, in articulating reasons for reaching a conclusion on the issue of likelihood 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 [that] the ultimate conclusion rests on consideration of the marks in their entirety." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive ... with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" Id.

In the present case, when the respective marks are considered in their entirety, it is plain that they are highly similar in appearance and sound and substantially the same in connotation and commercial impression. In particular, we concur with the Examining Attorney that the dominant and distinguishing portion of applicant's "PARAGON TECHNOLOGIES" mark is the term "PARAGON" due to the descriptiveness, as evidenced by applicant's disclaimer, of the word "TECHNOLOGIES." The term "PARAGON," as applicant admits, "has no known significance with respect to applicant's goods or for that matter with respect to electrical

goods, in general." Although, when used in connection with applicant's electrical control panels for operating a material handling system and registrant's electronic automatic power control apparatus, such term is perhaps suggestive rather than arbitrary, it is still the case that it conveys substantially the same connotation of something that is a model of excellence whether the term is utilized as a mark by itself or in combination with the descriptive word "TECHNOLOGIES."

Moreover, as the Examining Attorney correctly points out, the proper test for confusing similarity is not whether the respective marks are distinguishable on the basis of a side-by-side comparison inasmuch as such is not ordinarily the way that customers will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); Envirotech Corp. v. Solaron Corp., 211 USPQ 724, 733 (TTAB 1981); and Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975). Here the descriptive word "TECHNOLOGIES" in applicant's "PARAGON TECHNOLOGIES" mark, while not present in registrant's "PARAGON" mark, is insufficient to distinguish such marks due, as noted above, to the fact that their shared term "PARAGON" imparts

a high degree of visual and phonetic similarity to the marks as well as a substantial identity in their connotation. Overall, the respective marks consequently project substantially the same general commercial impression.

With respect to applicant's remaining contention, it is pointed out that the third-party registrations upon which it relies are not evidence that the marks which are the subjects thereof are in use and that the relevant purchasing public, having become conditioned to encountering certain products under marks which consist of or include the term "PARAGON," is familiar therewith and is therefore able to distinguish the source thereof based upon differences in such marks. See, e.g., AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); In re Hub Distributing, Inc., 218 USPQ 284, 285-86 (TTAB 1983); and National Aeronautics & Space Administration v. Record Chemical Co., Inc., 185 USPQ 563, 567 (TTAB 1975). In addition, as the Examining Attorney accurately observes, of the third-party registrations made of record by applicant, only two cover electrical products which are even arguably related to the goods at issue in this case⁴ and those two registrations are owned by the same third party. Thus, the number and nature of any similar mark(s) in use on the same or similar goods is not a relevant *du Pont* factor in this appeal.

⁴ Reg. No. 758,044, issued on October 8, 1963 for the mark "PARAGON" for "electric motors, time delay relays, and electric switches" and Reg. No. 758,088, likewise issued on the same date for the mark "PARAGON" for "electric timing devices of the horological instrument type, geared so as to actually measure time in controlling intervals in connection with electric circuits including time controls, cycle repeaters, [and] interval, reset and sequence timers."

Finally, as recognized by the Examining Attorney, to the extent that applicant may instead mean to utilize the copies of the third-party registrations in a manner analogous to a dictionary so as to show that the term "PARAGON" is entitled to a narrow scope of protection because it is suggestive of certain kinds of products and, thus, has been adopted by various third parties as part of their marks for that reason, we again note that there are but two third-party registrations, owned by the same entity, which are even arguably in the same general field as the goods at issue herein. However, even if applicant's "PARAGON TECHNOLOGIES" mark and the cited registrant's "PARAGON" mark are regarded as suggestive of the respective goods, it is still the case that, as discussed previously, such marks are substantially the same in their overall connotation and general commercial impression.

We accordingly conclude that consumers and potential customers, who are familiar or acquainted with registrant's "PARAGON" mark for "electronic automatic power control apparatus," would be likely to believe, upon encountering applicant's "PARAGON TECHNOLOGIES" mark for "electrical control panels for operating a material handling system which includes conveyors and/or vehicles," that such closely related, if not in part legally identical, goods emanate from, or are sponsored by or associated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.