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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cris E. Pasto, dba Cepco Tool Company

Serial No. 76238187

Michael F. Brown of Brown & Michaels, PC for Cris E. Pasto,
dba Cepco Tool Company.

Won T. Oh, Trademark Examining Attorney, Law Office 114 (K.
Margaret Le, Managing Attorney).

Before Simms, Quinn and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant has filed an application to register on the
Principal Register the mark RES-Q-JACK for goods amended to
read "emergency equipment, namely a vehicle stabilization
system comprised of stands for hand jacks, connectors,

pins, straps, fittings and tubing" in International Class 8.¹

The Examining Attorney has refused registration 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 registered mark, RES-Q-RENCH,² for "multipurpose emergency manually operated tools, namely, wrenches, glass breakers, pry bars, and cutters" in International Class 8, as to be likely to cause confusion, mistake or deception.

After the refusal was made final, applicant appealed. Briefs have been filed.³ Applicant did not request an oral hearing.

The Examining Attorney essentially contends that the marks RES-Q-JACK and RES-Q-RENCH are similar in sound, appearance, connotation and commercial impression; that the parties' respective goods are related or complementary; and

¹ Application Serial No. 76238187, filed April 9, 2001. The application is based on applicant's claimed dates of first use and first use in commerce of November 11, 1998 and April 26, 1999, respectively.

² Registration No. 2,508,861, issued November 20, 2001 on the Principal Register.

³ Applicant submitted with its reply brief a "supplemental declaration" of applicant. This evidence is untimely under Trademark Rule 2.142(d) and the Board has not considered it. Even if it had been considered, it would not alter our decision herein.

that the channels of trade and purchasers are the same or overlapping.

Applicant makes arguments regarding the following du Pont⁴ factors:

- (1) the marks are dissimilar in sound, appearance and connotation;
- (2) the goods are dissimilar in nature and purpose;
- (3) the channels of trade factor, even if overlapping, is not entitled to very much weight;
- (4) the purchasers and conditions of sale are different;
- (5) registrant's mark is not famous;
- (6) registrant's mark is weak and entitled to only a narrow scope of protection;
- (7) there have been no instances of actual confusion; and
- (8) the potential for confusion is de minimis.

Looking first to the marks, it is obvious that they are not identical. However, both involved marks are constructed in a similar manner. Specifically, both marks share the beginning term "RES-Q" (a misspelling of the word "rescue") followed by a hyphen and a suggestive or descriptive term relating to the involved product (a wrench type tool or a stabilization system which includes a stand for a hand jack). The first part of a mark is often the part impressed upon the mind of the purchaser, and the most likely to be remembered. See *Presto Products, Inc. v.*

⁴ In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Nice-Pak Products, Inc., 9 USPQ2d 1895 (TTAB 1981). These marks are similar in sound and appearance.

Relevant purchasers may note the difference in the last syllable of these marks, but they would still think these goods come from the same source because of the parallel construction of the marks, specifically "RES-Q" followed by the name of a tool. That is, purchasers familiar with registrant's emergency tools (such as wrenches and cutters) sold under the registered mark RES-Q-RENCH, upon seeing applicant's mark RES-Q-JACK on emergency equipment in the form of a vehicle stabilization system (including a stand for a hand jack), would assume that applicant's goods come from the same source as registrant's goods, and merely refers to a different piece of emergency equipment.

Both marks connote the idea of equipment used in various emergency situations to aid in the rescue of people.

It is the impression created by each of the involved marks, each considered as a whole, that is important. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and *Franklin Mint Corp. v. Master Manufacturing Co.*, 667 F.2d 1005, 212

USPQ 233 (CCPA 1981). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001). These marks do not create separate and distinct commercial impressions.

We find that the marks, considered in their entirety, are similar in sound, appearance, connotation and commercial impression.

Turning next to a consideration of the goods involved in this case, we start with the well-settled principle that the question of likelihood of confusion in Board proceedings regarding the registrability of marks, must be determined based on an analysis of the goods or services identified in applicant's application vis-a-vis the goods or services recited in the registration(s). See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Further, it is also well settled that goods or services need not be identical or even competitive to support a finding of likelihood of confusion. Rather, it is enough that the goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be seen by the same persons under circumstances which could

give rise, because of the marks used therewith, to a mistaken belief that they emanate from or are in some way associated with the same producer or that there is an association between the producers of each party's goods or services. See *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992); and *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

In this case, even though the involved goods are separate types of emergency equipment, we find that applicant's emergency equipment namely, a vehicle stabilization system and registrant's multipurpose emergency manually operated tools namely, wrenches, glass breakers, pry bars and cutters are related goods. The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Both identifications of goods are restricted to the "emergency" context. Thus, it is clear that both applicant's and registrant's goods are equipment used by emergency rescue personnel. The goods are complementary in that they are both used in emergency situations such as vehicular accidents to stabilize the vehicle(s) and to extricate people therefrom. See *In re Martin's Famous*

Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). That is, there is a commercially significant relationship between applicant's emergency equipment, namely, a vehicle stabilization system and registrant's emergency equipment, namely, multipurpose tools such as wrenches and cutters. See *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services"); and *Recot Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.").

The identified goods of both applicant and registrant are limited to emergency uses. Thus, these goods would be sold in the same or at least overlapping channels of trade. Applicant did not contest this issue. ("Even assuming that the goods are encountered in the same trade channels, this

single factor alone is not sufficient to support a finding of likelihood of confusion." Brief, p. 8.)

Applicant urges that the purchasers and the conditions of sale are "quite different." (Brief, p. 8.)

Specifically, applicant, Cris Pasto, avers in a declaration (submitted with his request for reconsideration) that the typical purchasers of his vehicle stabilization system are government municipalities, while the typical purchasers of registrant's tools are individuals; that applicant's goods cost approximately \$2,500 while registrant's wrench costs about \$20; and that purchasers of applicant's goods are sophisticated and purchase only after substantial research and approval.

Even though applicant avers that his customers are typically government municipalities, and registrant's customers are typically individuals, there is no such limitation in either identification of goods. Registrant's emergency tools, which could be sold to individuals, could also be sold to government municipalities. Thus, we find that there is at least a segment of similar purchasers.

While we agree with applicant that the purchase of the involved emergency equipment would be made after some level of careful consideration (particularly applicant's rather expensive vehicle stabilization system), the sophistication

of the purchasers does not require a finding of no likelihood of confusion. Sophisticated purchasers are not immune from confusion as to the origin of the respective goods, especially when sold under very similar marks. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). That is, even relatively sophisticated purchasers of this emergency equipment could believe that the respective goods come from the same source, if offered under the involved very similar marks. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, footnote 17 (TTAB 1992).

Applicant strongly urges that the registered mark is entitled to a limited scope of protection because of the number of registered marks including some form of the word "rescue" therein; and that consumers will distinguish between such marks.⁵ Applicant specifically asserts that "there are over 200 live, registered trademarks that incorporate some form of the word 'rescue'"; and that there

⁵ To whatever extent, if any, that applicant is arguing the du Pont factor of "the number and nature of similar marks in use on similar goods," that factor is irrelevant in this case because there is no evidence of any uses of other "RES-Q" marks. See *Octocom Systems Inc. v. Houston Computer Services, Inc.*, supra.

are "eleven registered marks for goods in the medical and emergency context." (Emphasis in original)(Brief, pp. 9-10.)

In support thereof applicant submitted photocopies of printouts from the USPTO's Trademark Electronic Search System (TESS) of the eleven third-party registrations in arguably relevant fields; and a printout of a three-page list of 93 third-party records (also from the USPTO's Trademark Electronic Search System (TESS)), including references to pending and abandoned applications, as well as cancelled and expired registrations. The three-page list of 93 applications and registrations does not include any information as to ownership, the involved goods or services, disclaimers, or whether the marks are registered under Section 2(f) or on the Supplemental Register. Thus, the probative value of this evidence is extremely limited. Moreover, applications are evidence of nothing except that each was filed on a particular date.

With regard to the eleven registered marks for which applicant provided copies thereof, assuming arguendo the establishment, as applicant argues, that all the goods in these third-party registrations are related, nonetheless this evidence does not compel a different result herein. Most of the marks in the third-party registrations create a

different commercial impression from that of applicant's mark and the cited registered mark. See, for example, JB-RES-Q for emergency vehicles, namely rescue trucks and ambulances (Registration No. 1,736,251); RESCUELINK for software for medical therapeutic apparatus, namely communication software for portable automatic external defibrillators (Registration No. 1,993,989); RESCUE WRAP ("wrap" disclaimed) for emergency thermal blankets for patient transport (Registration No. 1,905,021); and RESCUE LITE ("lite" disclaimed) for portable high intensity lamps for marking, warning, signaling, distress and search operations (Registration No. 1,010,695).

We acknowledge that there are a few third-party registrations which are closer in relation to the marks and/or the goods involved in the application now before us.⁶ However, as stated in the TMEP §1207.01(d)(iii) (3d ed. 2002)(Revision 1, June 2002): "Generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously

⁶ See RES-Q-VAC for aspiration pump, hospital infant delivery room neonatal suction pump, endotracheal adapter, adult suction pump and yankauer (Registration No. 1,762,635); and RES-Q-FLO for mouth to mask manual resuscitators to administer mouth to mouth resuscitation without mouth to mouth contact (Registration No. 1,345,903).

registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive.”

To the extent applicant is arguing that the registered mark RES-Q-RENCH is diluted in the marketplace due to third-party uses of similar marks, again there is no evidence regarding use in the marketplace. In fact, it is well settled with regard to the weight given to third-party registrations, that these registrations are not evidence of use in the marketplace or that the public is familiar with them. Thus, we cannot assume that the public will (presumably) come to distinguish between them. As the Court of Appeals for the Federal Circuit stated in the case of *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992):

Under *Du Pont*, “[t]he number and nature of similar marks in use on similar goods” is a factor that must be considered in determining likelihood of confusion. 476 F.2d at 1361, 177 USPQ at 567 (factor 6). Much of the undisputed record evidence relates to third party registrations, which admittedly are given little weight but which nevertheless are relevant when evaluating likelihood of confusion. As to strength of a mark, however, registration evidence may not be given any weight. *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973) (“The existence of [third party] registrations is not evidence

of what happens in the market place
or that customers are familiar with
them. ...") (Italics emphasis in
original.)

See also, *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

Moreover, the USPTO strives for consistency of examination, but as often noted by the Board, each case must be decided on its own merits. We are not privy to the records of the third-party registration files, and moreover, the determination of registrability of those particular marks by trademark Examining Attorneys cannot control the merits in the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). See also, *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); and *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

Regarding the du Pont factor of the fame of the prior mark, applicant asserts in his declaration that the cited mark is not famous. In general, fame does not play a role in ex parte appeals because evidence to demonstrate fame is not available to Examining Attorneys. Although evidence of fame can be dispositive in finding likelihood of confusion, the absence of such evidence does not compel a result of no

likelihood of confusion. In this case, the other involved du Pont factors persuade us that confusion is likely.

Although applicant has averred that there have been no instances of actual confusion in the four years since applicant commenced use of his mark, this statement is insufficient to establish a finding of this duPont factor in applicant's favor. See *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Importantly, in the case before us there is no evidence of applicant's and the cited registrant's geographic areas of sales, or the amount of the sales under the respective marks. Further, there is no information from the registrant. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, supra; and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

Applicant argues that he has prior use; and that if confusion were likely, he would have opposed registration of the now registered mark. This is unpersuasive as priority is not an issue in an ex parte appeal. See *In re Wilson*, supra, 57 USPQ2d at 1867 (footnote 9). Further, it is the duty of the USPTO to determine the question of likelihood of confusion in the appeal now before us. See *In re Dixie Restaurants*, supra, 41 USPQ2d at 1535.

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While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

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