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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Valley Research, Inc.

Serial No. 76/241,557

Randee Sibul-Gelbert of Baker & Daniels for Valley
Research, Inc.

Tina L. Snapp, Trademark Examining Attorney, Law Office 116
(Meryl Hershkowitz, Managing Attorney).

Before Walters, Chapman, and Bucher, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On April 16, 2001, Valley Research, Inc. (an Indiana
corporation) filed an application to register the mark
TAKA-DIASTASE on the Principal Register for goods
identified, as amended, as "enzymes for the food industry,
namely, an enzyme preparation for digesting starch" in
International Class 1. The application is based on

applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on its identified goods, so resembles the mark TAKA-SWEET, which is registered for "glucose isomerase enzyme for use by the food industry" in International Class 1,¹ as to be likely to cause confusion, or to cause mistake, or to deceive.

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have briefed the issue before us, but applicant did not request an oral hearing.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

The Examining Attorney essentially contends that the marks are highly similar, consisting of the dominant beginning syllable "TAKA," followed by a hyphen, followed

¹ Registration No. 1,537,095, issued May 2, 1989, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

by a descriptive term ("sweet" or "diastase," respectively); that the respective goods are closely related, both being enzymes for use in the food industry; that inasmuch as both applicant's and registrant's goods are specifically identified as for use in "the food industry," the channels of trade and purchasers are the same or overlapping; that even if the purchasers are sophisticated, it does not mean they are knowledgeable regarding trademarks or that they are immune from source confusion; that a lack of actual confusion is unconvincing where applicant has not commenced use; that applicant's evidence of registrations of "TAKA-prefix" marks at the USPTO does not support allowing applicant's mark; and that doubt is to be resolved in favor of the registrant.

Applicant argues essentially that the marks convey different commercial impressions because they end in distinctly different words;² that the goods as identified

² Applicant disagrees with the Examining Attorney's conclusion that the term "diastase" is descriptive of the goods. (Applicant's brief, pp. 3-4.) We take judicial notice of the following dictionary definitions (see TBMP §704.12(a) (2d ed. June 2003)):

- (1) diastase A mixture of enzymes from malt. It converts at least fifty times its weight of potato starch into sugars in thirty minutes. Used to convert starch into sugar. In 1992 diastase and diastase malt aluminum

are sufficiently distinct to obviate any confusion; that the "purchasers are scientific and technical professionals who know the difference between a starch-digesting enzyme and a glucose isomerase enzyme and will select the product they need with care" (brief, pp. 6-7); that there have been a number of "TAKA" prefix marks registered concurrently between 1957-2002 to different owners for a long period of

hydroxide were shown not to be safe and effective as claimed in OTC digestive-aid products and the FDA banned the compounds for that purpose. The FDA data bank, PAFA (see page 10), has fully up-to-date toxicology information available and diastase is still permitted as a food-processing agent. A Consumer's Dictionary of Food Additives (4th ed. 1994); and

- (2) diastase See amylase.
amylase Enzymes that hydrolyse starch. I-Amylase (dextrinogenic amylase or diastase, EC 3.2.1.1) acts randomly on I-1,4-glucoside bonds in the molecule and produces small Dextrin fragments. ... Bender's Dictionary of Nutrition and Food Technology (7th ed. 1999).

Based on the evidence of record as well as these dictionary definitions, we agree with the Examining Attorney that the term "diastase" is descriptive in relation to the respective goods. We hasten to add that this finding is in the context of the question of likelihood of confusion, and in particular, the underlying factor of the similarities of the marks. To be clear, the Examining Attorney has not refused registration on the basis that the entire mark is merely descriptive under Section 2(e)(1), 15 U.S.C. §2(e)(1), and we make no finding thereon.

time, the majority of which were owned by two entities (Parke-Davis and Miles Laboratories) and their respective predecessors and successors-in-interest; that Parke-Davis and Miles Laboratories competed for over 40 years without any apparent confusion as to the source of their respective goods; that, in addition, there were two additional entities (Takasago Koryo Kogyo Kabushiki Corp. and Takara Shuzo Co., Ltd.) who obtained "TAKA" prefix marks commencing during the 1970s; and that the specific marks TAKA-DIASTASE (Reg. No. 251,949 issued January 22, 1929, last renewed in 1969, and listed in the USPTO records as expired on November 3, 1992, assigned to Parke-Davis) and TAKA-SWEET (Reg. No. 1,178,724 issued November 24, 1981 to Miles Laboratories, cancelled under Section 8 on June 24, 1988 and re-registered by Miles Laboratories in the current cited Reg. No. 1,537,095 which issued on May 2, 1989) co-existed on the Principal Register from November 1981 to November 1992.

Applicant's counsel explains the early history of the "TAKA marks" as follows (applicant's brief, pp. 7-8, references to exhibits omitted):

The first TAKA- enzyme, TAKA-DIASTASE, was discovered by a Japanese chemical engineer, Jokichi Takamine, toward the end of the 19th century. Mr. Takamine came to the United States in 1890 to

work on production of this enzyme for the distilling industry. He formed his own company, Takamine Ferment Co., but subsequently, allowed production of TAKA-DIASTASE for medicinal use to be undertaken by Parke-Davis Co. Mr. Takamine, though, remained associated with Parke-Davis for the remainder of his career. He was also associated with, and the first president of, Sankyo Co., Ltd., a Japanese company, the current owner of the rights to TAKA-DIASTASE in Japan. Sankyo has given Applicant permission to market the TAKA-DIASTASE product in the U.S. Mr. Takamine died in 1922.

Applicant's attorney then sets forth some background on the three registered TAKA marks owned by Parke-Davis (TAKA, TAKA-DIASTASE and TAKA-COMBEX, all for either, inter alia, "diastase" or a combination of vitamin B and a diastatic enzyme, and all three registrations are expired); the successors to Parke-Davis; the purchase of Takamine Laboratory, Inc. by Miles Laboratories, Inc. in 1956; Miles Laboratories' ownership of several registered TAKA marks for various enzymes (e.g., TAKA-SWEET, TAKA-THERM, TAKAMINE, TAKALITE, all except one TAKA-SWEET registration expired or cancelled); and the successors to Miles Laboratories.

We turn first to consideration of the similarities or dissimilarities of the marks. There is the obvious difference between the registered mark and applicant's

mark, specifically, that applicant's mark ends with the descriptive word "diastase" and registrant's mark ends in the suggestive or descriptive word "sweet."

It is well settled that marks must be considered in their entireties as to the similarities and dissimilarities thereof. However, our primary reviewing court has held that in articulating reasons for reaching a conclusion on the question 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 or portion of a mark. That is, one feature of a mark may have more significance than another. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

In this case, both applicant's mark and registrant's mark share the beginning syllable TAKA, followed by a hyphen. This is the first and dominant part of both applicant's and registrant's marks. 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. Nice-Pak Products, Inc., 9 USPQ2d 1895 (TTAB 1981).

Under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks. See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). The differences in the marks (TAKA-DIASTASE and TAKA-SWEET) do not serve to distinguish the marks here in issue. See Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992).

Applicant argues that there are instances where similar or even identical marks have been registered for similar goods and services, citing, inter alia, the case of In re Hearst Corp., 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992). However, in the application now before the Board, applicant's mark does not consist of multiple words (as in the Hearst case where applicant's mark consisted of the words VARGA and GIRL); rather, here applicant's mark consists of a syllable TAKA, a hyphen and the descriptive word DIASTASE. Moreover, the Court explained in the Hearst

case at 25 USPQ2d 1239 that "the weight given to the respective words is not entirely free of subjectivity... ." In any event, we disagree that the Hearst case requires a different result herein as we have given each element of applicant's mark appropriate weight and, of course, we have ultimately considered the similarities/dissimilarities of the marks in their entirety.

Regarding the connotations of the involved marks, as set forth previously, applicant explained (and submitted evidence showing) the early history of the first TAKA-enzyme, TAKA-DIASTASE, being discovered by a Japanese chemical engineer, Jokichi Takamine. In addition, applicant submitted numerous third-party "TAKA" registrations of Parke-Davis and Miles Laboratories. This record shows that the origin of the syllable "Taka" is well known in the enzyme industry. Thus, the prefix "TAKA" connotes to prospective purchasers the same idea in relation to enzymes used in the food industry for both applicant and registrant.

We turn to a consideration of the goods. The respective goods, as identified, are both enzymes and are both for use in the food industry. Even though each may be a separate type of enzyme, we find these goods are closely related within the meaning of the Trademark Act. 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).

Inasmuch as the identified goods of both applicant and registrant are limited to enzymes used in the food industry, we find that the channels of trade are the same or are at least overlapping, and that the purchasers would be the same.

While we agree with applicant that the purchase of the involved enzymes for use in the food industry would be made after some level of careful consideration, nonetheless, we find that this factor does not negate a finding of likelihood of confusion. Even assuming the purchasers of these goods are sophisticated (scientific, technical professionals), this does not mean that such consumers are 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 these food additive enzymes could believe that these goods come from the same source, if offered

under the involved substantially 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).

Purchasers familiar with registrant's enzyme product sold under the registered mark TAKA-SWEET may, upon seeing applicant's mark TAKA-DIASTASE on an enzyme product, assume that registrant is offering another enzyme product, and that both originate from the same entity. See Dan Robbins & Associates, Inc. v. Questor Corporation, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979).

Applicant strongly urges reversal based on the long history of the "TAKA" marks registered to two different lines of owners (the Parke-Davis line and the Miles Laboratories line). While we acknowledge that the record shows these two lines co-existed at one time, we are nonetheless not persuaded by this argument. First, all of the "TAKA" registrations owned by either the Parke-Davis line or the Miles Laboratories line have been cancelled or expired except for the cited registration (owned by a successor to Miles Laboratories). Second, both the Parke-Davis line and the Miles Laboratories line trace their presumably valid rights in the various "TAKA" marks back to a single source, Mr. Jokichi Takamine and/or his companies.

(See applicant's brief, pp. 7-9.) Thus, there are two strong chains of "TAKA" marks, and there is nothing in the record to show that applicant, Valley Research, Inc., is a successor to either of those two chains. As explained earlier herein, applicant stated in its brief that Sankyo Co., Ltd. (a company also dating back to Mr. Takamine, who was Sankyo's first president) owns the mark TAKA-DIASTASE in Japan, and that Sankyo "has given Applicant permission to market the TAKA-DIASTASE product in the U.S." (Brief, p. 8.) However, aside from applicant's attorney's statements that Sankyo is the owner of the mark in Japan and that applicant is entitled to market the product in the U.S., the record is devoid of any evidence to that end. Furthermore, the record lacks even a statement by counsel that applicant has obtained the right to register the mark TAKA-DIASTASE in the United States.

The fact that the mark TAKA-DIASTASE and the first TAKA-SWEET registration were on the register at the same time for several years (1981 to 1988) does not require a different result herein.

None of the third-party registrations made of record by applicant compel a different result in the present case. The registrations are not evidence that the marks shown therein are in use or that the public is familiar

with them, and the existence on the register of confusingly similar marks cannot aid an applicant in its effort to register another mark which so resembles a registered mark as to be likely to cause confusion. See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); and *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999). Applicant has made of record numerous third-party registrations containing the term "TAKA," all but three of which were owned by the Parke-Davis or the Miles Laboratories lines explained above, and only three of which remain in valid, existing status.³

With regard to the few "TAKA" registrations which issued to entities other than the Parke-Davis line or the Miles Laboratories line, they convey different commercial impressions (e.g., one is the Japanese word for "treasure," one is the name of a Japanese city). The syllable "TAKA" is not truly a "prefix" in those marks.

³ The three remaining valid registrations are (1) the cited registration for the mark TAKA-SWEET; (2) Reg. No. 1,017,722 for the mark TAKARA for Japanese food seasoning wine, namely, mirin in International Class 33 (the registration includes a statement that "TAKARA" is translated as meaning "treasure" in Japanese); and (3) Reg. No. 1,765,422 for the mark TAKASAGO for, inter alia, enzyme preparations for use in the manufacture of food stuffs in International Class 1. (The Examining Attorney submitted with her brief a printout of one page from The Columbia Encyclopedia showing "TAKASAGO" is the name of an industrial city in Japan. We take judicial notice thereof.)

Neither the Board nor any Court is bound by prior decisions of Trademark Examining Attorneys, and each case must be decided on its own merits, on the basis of the record therein. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). See also, *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); and *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

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