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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Viking Lifesaving Equipment A/S

Serial No. 76269526

Donald N. Huff of Dykema Gossett PLLC for Viking Lifesaving
Equipment A/S.

Gina M. Fink, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Hairston, Bucher and Zervas, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Viking Life-Saving Equipment A/S has filed an
application to register the mark shown below,



for goods and services which were ultimately identified as:

life-saving rafts, hydrostatic release for life-saving rafts, life saving boats, protection cover for life-saving boats, life jackets, life-saving equipment, namely, floating lines, excluding diving suits; emergency warning lights, fire fighting suits, boxes specifically designed for carrying fire fighting and life-saving equipment, boxes specifically designed for carrying emergency breathing apparatus; emergency and rescue flares, life buoys, life buoy brackets, life buoy lights, radar reflectors and emergency signal whistles in International Class 9;

installation and maintenance of all kinds of safety and life-saving equipment in International Class 37; and

training and educational services, namely conducting classes and seminars in the use of all kinds of safety and life-safety equipment in International Class 42.¹

The trademark examining attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the three marks shown below, all previously registered to the same owner, Viking Fottoy A/S, that, if used on or in connection with applicant's "fire fighting suits," in particular, it would be likely to cause confusion.

¹ Serial No. 76269526, filed June 8, 2001, based on an allegation of a bona fide intention to use the mark in commerce. The words LIFE-SAVING EQUIPMENT have been disclaimed apart from the mark as shown.

(1)



for, inter alia, "protective clothing, namely suits for protection against chemicals and gases" in International Class 9. Registration No. 1,529,361 issued March 14, 1989; Section 8 affidavit filed. The drawing is lined for the colors red and blue.

(2)



for "protective shoes and boots" in International Class 9. Registration No. 1,603,452 issued June 26, 1990; renewed. The drawing is lined for the colors red and blue.

(3)



for, inter alia, "fire fighting boots for protection against accidents, irradiation and fires" in International Class 9. Registration No. 2,376,528 issued August 15, 2000. The registration contains the following statement: The mark consists of the word "Viking" with a representation of the letter "V" claiming the color red within a blue rectangle.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

At the outset, we note applicant's statement in its brief on the case that it was negotiating a consent agreement with the owner of the cited registrations. While the Board generally will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed prior to the rendering of the Board's final decision, no such agreement has been submitted in this case. See TBMP §1207.02 (2nd ed. rev. 2004). Thus, the Board will not suspend this proceeding.

We turn then to the issue of likelihood of confusion. Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. DuPont DeNemours & 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 and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In*

re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Considering first the marks, the examining attorney contends that applicant's mark and each of the cited marks are similar because the dominant portion of the marks, VIKING, is identical.

Applicant, on the other hand, argues that each of the cited marks "presents a distinctive design presentation" and appears in red and blue, which serves to distinguish each of the cited marks from applicant's mark. (Brief, p. 6).

Our consideration of the marks is based on whether applicant's mark and each of the cited marks, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. However, it is nevertheless the case that, 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 example, "that a particular feature is descriptive or generic with respect

to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark ...” Id. at 751.

Insofar as applicant’s mark is concerned, the disclaimed words LIFE-SAVING EQUIPMENT are generic or highly descriptive for applicant’s type of goods. Thus, these words, as they appear in applicant’s mark, play a subordinate role in our likelihood of confusion analysis. In addition, the “V” design in applicant’s mark reinforces the first letter of the term VIKING in the mark. The term VIKING is a non-generic word and thus is more noticeable than the “V” design in applicant’s mark. Also, it is the word VIKING that purchasers would use to request the goods. See *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987).

With respect to the cited marks, it also is the term VIKING that is the dominant feature of each of these marks. The word VIKING dominates over the design features and again, it is the word VIKING that customers will remember and use in calling for the goods. With respect to applicant’s mark and the mark in Registration No. 2,376,528, in particular, each has a “V” at the top and the term VIKING at the bottom on a square background. In addition, applicant’s mark and each of the marks in

Registration Nos. 1,529,361 and 1,603,452 has a geometric figure within the marks, namely a circle in applicant's mark and a triangle in the the cited marks.

We recognize that each of the cited marks consists of the colors red and blue. However, this does not distinguish the cited marks from applicant's mark. Applicant has not claimed any particular color in connection with its mark and, if granted a registration, would be free to depict its mark in any colors, including red and blue.

In short, we find that when the marks are considered in their entirety, they are substantially similar in sound, appearance, connotation and commercial impression.

Considering next the goods, the examining attorney contends that applicant's fire fighting suits are the same as or closely related to registrant's protective clothing, namely suits for protection against chemicals and gases (Registration No. 1,529,361). Further, it is the examining attorney's position that applicant's fire fighting suits and registrant's protective shoes and boots (Registration No. 1,603,452) and fire fighting boots (Registration No. 2,376,528), are complementary goods.

Applicant, on the other hand, argues that its fire fighting suits are for use in the maritime industry and are

sold in different channels of trade than registrant's goods; and that the purchasers of its fire fighting suits are sophisticated.

As has often been stated, it is not necessary that the goods and/or services of the parties be similar or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). Moreover, the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the cited registrations. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

In this case, we find that applicant's fire fighting suits are identical or otherwise closely related to

registrant's protective clothing, namely suits for protection against chemicals and gases. In the absence of any limitations in registrant's identification of goods, we must consider that registrant's protective clothing, namely suits for protection against chemicals and gases, are of a type that may be worn by fire-fighters. Similarly, we must consider that registrant's protective shoes and boots also are of a type that may be worn by fire fighters. Thus, applicant's fire fighting suits and registrant's protective shoes and boots are clearly complementary goods. Further, applicant's fire fighting suits and registrant's fire fighting boots for protection against accidents, irradiation and fires are complementary goods.

Further, we find that applicant's and registrant's goods are of types which normally are sold in and to the same or overlapping trade channels and purchasers, i.e., municipal and private fire departments. Applicant argues that its goods and registrant's goods, as actually marketed, are used in different industries. In particular, applicant argues that its goods are used in the maritime industry, whereas registrant's goods are used in other industries for protection against fire and environmental hazards. However, no such limitations or restrictions appear in applicant's or registrant's identification of

goods, and they therefore can be given no consideration. See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) and Canadian Imperial Bank, supra.

Applicant also has asserted that the consumers for its goods are sophisticated. We agree that clothing and shoes and boots worn by fire fighters are not impulse purchases. However, because of the similarities of the marks and the goods, even careful and sophisticated purchasers are likely to believe that these marks are variants of each other, and that the marks identify goods emanating from a single source.

Finally, applicant asserts that it and the registrant have used their marks concurrently for six years without any evidence of actual confusion, and that this shows that confusion is not likely to occur. We are not persuaded by this argument. Applicant has not provided any evidence as to the extent of its use, nor is there any evidence as to registrant's use, such that we can determine whether there has been an opportunity for confusion to occur. In any event, the issue before us is not one of actual confusion, but only the likelihood of confusion.

In view of the foregoing, we conclude that purchasers and prospective customers familiar with each of

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registrant's VIKING and design and V VIKING and design marks for protective clothing, namely, suits for protection against chemicals and gases, protective shoes and boots, and fire fighting boots, would be likely to believe, upon encountering applicant's substantially similar mark VIKING LIFE-SAVING EQUIPMENT and design for fire fighting suits, that the respective products emanate from or are associated with or sponsored by the same source.

Decision: The refusal to register under Section 2(d) is affirmed as to each of the cited registrations.