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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Unichema Chemie BV

Serial No. 76406829

Patrick J. Jennings and James R. Menker of Pillsbury Winthrop LLP for Unichema Chemie BV.

Michael J. Souders, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Seeherman, Hairston and Bottorff, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Unichema Chemie BV has appealed from the final refusal of the Trademark Examining Attorney to register CLARUS as a trademark for "chemicals for use in the manufacture of cosmetics, perfume, toiletries, and personal care products; chemical preparations for the attenuation of ultraviolet rays for use in the manufacture of toiletries, sun

protection toiletries, and cosmetics."[1] Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark KLARUS, previously registered for "sulfurized chemical additives for use in lubricants,"[2] that, if used on applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have filed appeal briefs. Applicant did not request an oral hearing.

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. 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). 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

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[1] Application Serial No. 76406829, filed May 8, 2002, and asserting a bona fide intention to use the mark in commerce.
[2] Registration No. 2339203, issued April 4, 2000.

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

Turning first to the marks, they are identical in pronunciation, and highly similar in appearance, the only difference being the initial letters “C” and “K”. Although during the course of examination applicant discussed at some length the different meanings of each of these letters, the marks at issue are not simply the individual letters. In the context of the marks as a whole, with “C” and “K” being common phonetic equivalents, the overall impression created by the marks is the same. It is also noted that there is no difference in the connotations of the marks, since both are apparently arbitrary terms. In this connection, we note applicant’s statement, in its response filed February 27, 2003, that:

> Clarus has no significance in the relevant trade or industry or as applied to the goods or services, no geographical significance, no surname significance, no meaning in a foreign language and no other meaning or significance other than as a mark.

This brings us to a consideration of the goods. As applicant has recognized at page 4 of its brief, “the parties’ goods or services need not be identical or even directly competitive to support a finding of likelihood of confusion. Instead, it is sufficient if the parties’ goods

or services are related in some manner and/or 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 to the mistaken belief that they originate from or are in some way associated with the same entity or producer." (citations omitted).

In this case, both applicant's and the registrant's goods are chemicals. Applicant's goods include chemicals used in the manufacture of cosmetics, perfume, toiletries and personal care products; the registrant's goods are identified as sulfurized chemical additives for use in lubricants. Applicant, based on an examination of the registrant's website, has stated that the registrant's goods are "extreme pressure additives used to formulate cutting and grinding fluids," and extrapolates from this that "the Registrant's chemicals contain large amounts of active and inactive sulfur, a substance used to make vulcanized rubber, gunpowder, insecticides, and sulfuric acid, among other things." Applicant goes on to say that "due to this high sulfur content, the Registrant's chemicals are typically formulated into either straight oil metalworking fluids or, when extreme pressure properties are necessary, emulsified into soluble oils." Brief, p. 6.

The problem with applicant's statements is that applicant is attempting to limit the registrant's goods from those identified in the registration to chemical additives with a high sulfur content. Indeed, by the last pages of applicant's brief, it refers to the registrant's chemicals as being used solely to manufacture cutting and grinding fluids, and it bases its arguments regarding the goods, consumers and channels of trade on this contention. However, the identification in the registration is for "sulfurized chemical additives for use in lubricants." As applicant has recognized in the general statement of trademark principles found earlier in its brief, "it is also well established that likelihood of confusion must be determined on the basis of the goods set forth in the application in question and the cited registration. See, e.g., CBS Inc. v. Morrow, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 216 USPQ 937, 940 (Fed. Cir. 1983); Paula Payne Prod's Co. v. Johnson Pub. Co., Inc., 177 USPQ 76, 77 (CCPA 1973)." Brief, p. 5. Because there is no mention in the identification of the amount or percentage of the sulfur content, we cannot agree that the registrant's goods can only be used for the purposes set forth by applicant, and not be used in lubricants[3] which

[3] In her brief, the Examining Attorney contends that the

might in turn be used in toiletries and other personal care products. In this connection, we take judicial notice of a dictionary definition for "sulfur" that states it is "a mild antiseptic in antidandruff shampoos, dusting powders, ointments, and permanent-wave solutions.[4] Further, we note that lubricants can be used in personal care products, as shown by the identification in Registration No. 2390752, made of record by the Examining Attorney, which includes "Chemical additives, namely...lubricant additives..., all used in the cleaning and personal care market...."

Even if the registrant's goods, as identified, were not for use in lubricants used in toiletries and the like (the same types of products in which the applicant's chemicals could be used), the Examining Attorney has still provided evidence to show the requisite relatedness of the goods. Specifically, he has submitted a number of third-party registrations which indicate that entities have registered a single mark for chemicals or chemical

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"lubricants" in the registrant's identification of goods would encompass personal lubricants. We believe that "personal lubricants" are a different category of goods from "lubricants" per se, and therefore we do not accept this interpretation or the arguments based on it.

[4] A Consumer's Dictionary of Cosmetic Ingredients, 5th ed.© 1999. The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

additives used in the manufacture of cosmetics, toiletries and lubricants. See, for example, Reg. No. 2368519 for, inter alia, chemical additives, namely, glycerine for use in the manufacture of food, pharmaceuticals, cosmetics and lubricants; Reg. No. 2233871 for chemicals, namely, wax esters in microspherical form for use in the manufacture of cosmetics and lubricants; and Reg. No. 2190516 for chemicals for use in the manufacture of cosmetics, toiletries, polymers, textiles, industrial lubricants and solvents.

Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

In addition, the Examining Attorney has shown that both applicant and the registrant sell chemical products for making both lubricants and cosmetics/toiletries. A press release found on applicant's website (www.uniqema.com) states that "Uniqema is a global specialty chemicals business with an annual turnover of in excess of $1 billion. The Lubricants business of Uniqema has one of the most extensive product portfolios of any

supplier—ranging from reliable industry standards to tailor-made performance products."[5] In addition, on one page of the website, and in contiguous paragraphs, are references to applicant's lubricant and personal care product activities:

> Lubricants
> The business is a global supplier of formulated lubricants used in compressors for refrigeration for domestic appliance and industrial and commercial equipment, and for automobile air conditioning and air compressors. It supplies components for synthetic automobile engine and gearbox oils as well as a wide range of industrial applications such as fire resistant hydraulic fluids and metal working fluids.
>
> Personal Care
> Uniqema has a leading market position in skin care, oral care, sun care and pharmaceutical ingredients. Innovations in this area have included the development of new vegetable-based ingredients, actives for anti-ageing creams, skin repair and multi-functional ingredients to combine the effect of moisturizing with conditioning and cleansing. Uniqema's excipient products are used in the pharmaceutical market and are also used in nutritional formulations, food additives and processing aids.

The Examining Attorney has also made of record an excerpt from the registrant's website (www.ferro.com) which

[5] From the material in the website, it appears that "Uniqema" is a dba for applicant, Unichema Chemie BV.

lists, under “Markets we serve,” “Personal Care, Pharmaceuticals & Food Additives.”

Applicant dismisses the evidence that it makes both chemicals used in the production of cosmetics and chemicals used in the production of lubricants because these two types of chemicals are produced by two separate divisions of applicant. However, we find that this evidence is probative, because it shows that chemical products for both uses can emanate from a single company. Purchasers of the goods, even if they are aware that they are made by different divisions of applicant, will still know that there is one company which is their source. Moreover, the record shows that the registrant also makes chemical products for both the cosmetics and lubricants industries, a point which applicant ignores.

We agree with applicant that the purchasers of applicant’s and the registrant’s goods are sophisticated. To some extent, it is their knowledge of the chemical industry that will make them aware that the chemical products identified in the subject application and registration can emanate from a single source. Nor does the fact that the purchasers are sophisticated or knowledgeable make them immune from source confusion when the marks are as similar as those at issue herein. A

consumer who has heard good reports of KLARUS chemical additives will not realize, upon encountering CLARUS chemicals, that this is a different trademark from the phonetically identical KLARUS. Moreover, because of the visual similarity and aural and connotative identity of the marks, even a sophisticated consumer might misremember or mistake CLARUS for KLARUS, or vice versa.

Finally, to the extent that there is any doubt as to the issue of likelihood of confusion, we follow the well-established principle that such doubt must be resolved against the newcomer and in favor of the prior user or registrant. In re Shell Oil Co., 992 F.2d 1204, 1209,26 USPQ2d 1687, 1691 (Fed. Cir. 1993). In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973). Here, not only is applicant the newcomer, but as far as the record shows, it has not yet begun to use the mark.

Decision: The refusal of registration is affirmed.