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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Amerope Enterprises, Inc.

Serial No. 76532163

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(J. Leslie Bishop, Managing Attorney).

Before Hohein, Drost, and Zervas, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 14, 2003, applicant, Amerope Enterprises, Inc., filed an application (Serial No. 76532163) to register the mark SAF-T-LITE RADIATION PROTECTOR (typed or standard character form) on the Principal Register for "safety products, namely radiation shielding and protection products namely portable and non-portable radiation shielding, comprising laminated leaded glass panels and panes" in Class 9. The application alleges of a date of first use anywhere and in commerce of May 1, 2002.

The examining attorney¹ refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a registration on the Principal Register for the mark SAFTI-LITE (typed form) for "fire and safety related glass" in Class 19. The registration (No. 2,089,494) issued August 19, 1997, and affidavits under Sections 8 and 15 have been respectively accepted and acknowledged. The examining attorney also refused to register applicant's mark without a disclaimer of the words "Radiation Protector" under the provision of Section 6(a) of the Trademark Act. 15 U.S.C. § 1056(a). The examining attorney required a disclaimer on the ground that the words are merely descriptive of applicant's goods. See 15 U.S.C. § 1052(e)(1).

After the examining attorney made the refusals final, this appeal followed.

Prior Federal Circuit Appeal

Before we begin our discussion of this case on the merits, we briefly mention that both applicant and the examining attorney discuss a non-precedential Federal Circuit opinion, In re Amerope Enterprises, Inc., No. 01-1155 (Fed. Cir. December 13, 2001). In that case, the

¹ The current examining attorney was not the original examining attorney in this case.

Court affirmed the board's decision refusing registration to the current applicant of its mark SAF-T-LITE, in typed form, for laminated leaded glass panels and panes because of the same registration cited against applicant in this appeal. Under Federal Circuit Rule 47.6, non-precedential opinions may be used to assert claim preclusion, issue preclusion, issue preclusion, and law of the case based on a non-precedential opinion.² Furthermore, the TMEP provides that: "A prior adjudication against an applicant, in connection with the same mark, on the basis of the same facts and issues, constitutes a proper ground of refusal as *res judicata*. Prior adjudications include decisions of the Trademark Trial and Appeal Board or any of the reviewing

² We note that, effective December 1, 2006, the Federal Circuit added Rule 32.1 that permitted the citation of non-precedential opinions issued after January 1, 2007:

(c) Parties' Citation of Nonprecedential Dispositions. Parties are not prohibited or restricted from citing nonprecedential dispositions issued after January 1, 2007. This rule does not preclude assertion of claim preclusion, issue preclusion, judicial estoppel, law of the case, and the like based on a nonprecedential disposition issued before that date.

(d) Court's Consideration of Nonprecedential Dispositions. The court may refer to a nonprecedential disposition in an opinion or order and may look to a nonprecedential disposition for guidance or persuasive reasoning, but will not give one of its own nonprecedential dispositions the effect of binding precedent. The court will not consider nonprecedential dispositions of another court as binding precedent of that court unless the rules of that court so provide.

courts." TMEP § 1217 (4th ed. rev. April 2005). Here, applicant's mark is different to the extent that it adds the words "Radiation Protector" and its identification of goods is narrower. Therefore, the prior adjudication is not controlling on the issues in this case, and we proceed to discuss the refusals.

Disclaimer

The first issue in this appeal is the question of whether the applicant must disclaim the words "Radiation Protector" because they are merely descriptive of the goods. A term is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"); and In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether

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the mark is descriptive. Abcor, 200 USPQ at 218. See also MBNA, 67 USPQ2d at 1783 ("Board correctly found MBNA's emphasis on the regional theme through marketing promotions and picture designs provides circumstantial evidence of how the relevant public perceives the marks in a commercial environment"). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959).

Applicant's goods are identified as "safety products, namely radiation shielding and protection products namely portable and non-portable radiation shielding, comprising leaded glass panels and panes." Applicant's "radiation shielding and protection products" are used to provide "radiation protection." "Radiation Protection" is a term used to describe products that protect against radiation. See Final Office action (www.firstsource.com (Radiation Protection - All Manufacturers)). In addition, the examining attorney has submitted a definition from *The American Heritage Dictionary of the English Language* (3rd ed. 1992) of "Protector" as "a device that protects." See First Office action at unnumbered p. 4.

Applicant, who does not address this issue in its brief, had previously argued that "a radiation protector could describe a number of different products" and that multiple dictionary definitions of the words "show that they are not descriptive." Response filed August 29, 2004 at 3.

Applicant's products are radiation protection devices that would be exactly described by the phrase "radiation protectors." The fact that other materials besides glass can serve this function does not mean that the mark is not merely descriptive of applicant's goods. Furthermore, while the words can have other meanings for different goods or services, this fact does not show the term is not merely descriptive for the goods at issue. The evidence shows that when purchasers encounter the words "Radiation Protector" for applicant's goods that are designed to protect people from radiation, they will immediately understand that this term merely describes a feature of the goods.

Likelihood of Confusion

We now move to the question of likelihood of confusion, which requires us to consider the evidence in relation to the relevant factors set out in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567

(CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he 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." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The examining attorney argues that there are "strong similarities" between applicant's and registrant's marks and that "[d]ue to the related nature of the parties' goods, the purchaser could easily conclude that applicant's and registrant's goods came from the same source." Brief at unnumbered pp. 7 and 10. The examining attorney explains that "a nuclear facility which purchases applicant's goods might also need to purchase registrant's fire and safety rated glass." Brief at unnumbered p. 10.³

³ We decline to accept the examining attorney's argument that registrant's goods include "those in the applicant's more specific identification." Brief at unnumbered p. 9. "Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods." Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Here, registrant's goods are "fire and safety rated glass," not simply "glass." It is not clear to us that "safety rated glass" would include radiation shielding leaded glass

The first factor that we consider concerns the similarities and dissimilarities of applicant's and registrant's marks. With this factor, we look to see whether the marks are similar in appearance, sound, connotation, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691-92 (Fed. Cir. 2005). Here, registrant's mark is SAFTI-LITE and applicant's mark is SAF-T-LITE RADIATION PROTECTOR. Both marks are depicted without any stylization or design. The marks are similar because the initial component of registrant's and applicant's marks are the phonetic equivalents of "Safety," i.e., SAFTI and SAF-T, followed by the identical term, LITE. Many, if not most, purchasers would pronounce the terms identically and the difference in appearance is slight. In addition, there is no apparent difference between the meaning and commercial impression of the terms, SAFTI-LITE and SAF-T-LITE.

We add that the only other difference is the presence of the words "Radiation Protector" in applicant's mark. We

panels and panes. The evidence does not show that "safety rated glass" includes radiation shielding glass although we note that applicant's LX-57B may be a safety rated glass. www.amerope.com ("Amerope is North America's largest distributor of LX-57B, offering a full line of curved and flat radiation shielding lead glass for use worldwide").

have already determined that these words are merely descriptive and "[r]egarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985). M2 Software Inc. v. M2 Communications Inc., 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006) ("When comparing the similarity of marks, a disclaimed term, here 'COMMUNICATIONS,' may be given little weight, but it may not be ignored"). We find that this is a case where the descriptive term would be entitled to little weight because the term would likely signify to many purchasers that registrant is using the words to distinguish its products as opposed to a term that distinguishes the sources of the goods.

We also must consider the strength of the marks and it is clear that the term "Safety" and its phonetic equivalents would be at least highly descriptive, if not generic, for applicant's "safety products" and registrant's "safety rated glass." However, registrant's mark is SAFTI-

LITE not SAFTI⁴ alone and, inasmuch as the term is on the Principal Register, we must assume that it is at least suggestive. We note that applicant submitted a list of registrations in response to the examining attorney's first Office action to demonstrate that the term is commonly used. Inasmuch as the examining attorney did not object or advise applicant that copies of the registrations were necessary, we will consider the list as being of record.

TBMP § 1207.03 (2d ed. rev. 2004):

If the applicant, during the prosecution of the application, provided a listing of third-party registrations, without also submitting actual copies of the registrations, and the examining attorney did not object or otherwise advise applicant that a listing is insufficient to make such registrations of record at a point when the applicant could cure the insufficiency, the examining attorney will be deemed to have waived any objection as to improper form.

However, we "will not consider more than the information provided by applicant" and here, because "applicant has provided only a list of registration numbers and marks, the list will have very limited probative value." TBMP § 1208.02 (2d ed. rev. 2004). While third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they cannot

⁴ Applicant has submitted a copy of a registration that indicates that registrant has apparently also registered the term SAFTI alone on the Supplemental Register. Registration No. 2,765,864.

be used to justify the registration of another confusingly similar mark. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987). Applicant's list is particularly ineffective because many marks simply involve the word "Safety," which as we discussed above, is highly descriptive for safety-related products, while the marks in this case also include the term "Lite." In addition, the list includes expired applications and registrations and pending applications, which are not evidence of the descriptiveness or suggestiveness of a term. Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] canceled registration does not provide constructive notice of anything") and Zappia-Paradiso, S.A. v. Cojeva Inc., 144 USPQ 101, 102 n.4 (TTAB 1964) ("Opposer has also submitted in evidence a copy of the file of an application for registration ... but such material is incompetent as proof of anything other than the fact that such an application for registration was filed in the Patent Office"). Finally, without information about the goods and services involved in the registrations, the list has little relevance to the facts of this particular case.⁵ Therefore, we cannot

⁵ Applicant also submitted a 2-page Google® search that shows the use of the term "SAF-T," occasionally with the term LITE. We

conclude that the mark SAFTI-LITE is so weak as to be assigned a very limited scope of protection.

Here, the dominant part of both marks is the term SAFTI-LITE and its phonetic equivalent SAF-T-LITE. If "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." In re Denisi, 225 USPQ 624, 624 (TTAB 1985). When we consider the marks in the entireties, as we must, we conclude that the marks are more similar than they are different. See In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004).

The next factor we consider is whether applicant's and registrant's goods are related. We must consider these goods as they are identified in the application and registration. Paula Payne Products, 177 USPQ at 77. "In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they

cannot give this evidence much weight because it is often hard to determine the context of the use and, to the extent we can determine the context, the stories seem to refer mostly to lighting and bags.

originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

Applicant has submitted evidence that explains the use of its products (www.amerope.com).

LX-57B Radiation Shielding Lead Glass and Sat-T-Lite Radiation Protector™ Glass can be used in any facility which requires protection from x-ray radiation. The following industries have typical uses for x-ray radiation shields:

Medical: X-ray observation equipment, electron beam/plasma generators and X-ray TV detectors. Lead glass protects, doctors and staff from X-ray radiation with no glass discoloration or deterioration in viewing quality. Use of the larger size LX windows facilitates remote control of X-ray equipment.

Industrial: Used to protect people from airport luggage inspection equipment in airports, and from radiation testing equipment or radioactive industrial products at industrial sites.

Nuclear:
Leaded glass can be used for observation windows at radioactive storage stations, nuclear fuel development and reprocessing plants, and for applications near nuclear reactors.

As applicant's materials demonstrate, its products are used in a variety of commercial establishments. These same establishments could easily have need for fire and safety related glass in other areas. For example, a medical or industrial facility may have need of radiation shields in one location where X-ray equipment is being used and safety

glass to prevent breaking or fire damage in another location.

While these products may be used in the same facility, that in itself is not sufficient.

Similarly, in the instant case, where both applicant's goods and opposer's services are marketed and sold in the medical and certain other fields, it is error to deny registration simply because "applicant sells some of its goods in some of the same fields in which opposer provides its services," without determining who are the "relevant persons" within each corporate customer.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) (citation omitted).

However, in this case, these products would be purchased by the same purchasers who are designing or building the facilities. The same designer, who would be specifying the purchase of applicant's glass to eliminate the risk of radiation in one part of a facility, could also specify the purchase of registrant's glass to minimize a fire risk in another part of the same facility. Therefore, we conclude that these products are not only related, but as glass that is used to improve safety in a facility, these products are closely related and the purchasers of these products would overlap.

The next factor concerns the sophistication of these purchasers. Inasmuch as applicant's goods are radiation shielding and protection products, we agree with applicant that "the general public is not within the class of purchasers that would purchase either fire safety glass or radiation protection glass." Brief at p. 4. The common purchasers of fire and safety rated glass and radiation shielding products, would be sophisticated purchasers who would design or build commercial structures to minimize or eliminate risks from radiation, fire, and criminal threats. While we agree that these purchasers would be sophisticated, this fact does not eliminate the likelihood of confusion. The sophistication of the purchasers may reduce the likelihood of confusion, but it has been recognized that "even careful purchasers are not immune from source confusion." In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). See also In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting, Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible"). In this case, the slight differences in the appearance of the phonetically identical dominant parts of the marks may not be noticed by even sophisticated

purchasers. The additional term "Radiation Protector" would likely simply be viewed as a term that specified another glass-related product from the registrant. Thus, while we have weighed the sophistication of the purchasers, it does not convince us that confusion is unlikely here.

Applicant also points out that there is no evidence of the fame of the registrant's mark. In an ex parte case, registrant is not a party and the evidence of fame such as the nature and extent of advertising and sales, is not normally available to the examining attorney. Therefore, the absence of this evidence is not significant.

Ultimately, when we consider the record, we conclude that confusion is likely here. We add that to the extent that we have any doubts, we have resolved them, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973).

Decision: The examining attorney's requirement for a disclaimer of the words RADIATION PROTECTOR is affirmed. The refusal to register applicant's mark under Section 2(d) is also affirmed.