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March 22, 2007
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Frank's International, Inc.

Serial No. 76599870

William E. Johnson, Jr. of The Matthews Firm for Frank's International, Inc.

Susan Leslie DuBois, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Quinn, Hohein and Hairston, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Frank's International, Inc. has filed an application to register on the Principal Register in standard character form the mark "ANACONDA" for "machine parts for oilfield equipment, namely, load lift rings, and thread protectors for use on oilfield casing before such casing is run into an earth well bore" in International Class 7.¹

Registration has been finally refused 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

¹ Ser. No. 76599870, filed on June 28, 2004, which is based on an allegation of a bona fide intention to use such mark in commerce.

mark "ANACONDA," which is registered on the Principal Register in standard character form for "oil and gas coiled tubing well construction systems and directional drilling services" in International Class 37,² as to be likely to cause confusion, or to cause mistake, or to deceive.³

Applicant has appealed and briefs have been filed.⁴ We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.⁵

² Reg. No. 2,836,733, issued on April 27, 2004, which sets forth a date of first use of the mark anywhere and in commerce of March 31, 1998.

³ While such registration also recites "oil and gas well intervention services" in International Class 42, setting forth a date of first use of the mark anywhere and in commerce of March 31, 1999, there is no mention of such services in either the Examining Attorney's initial or final Office actions nor is there any discussion thereof in her brief. In view thereof, the refusal to register is considered to pertain only to the services recited in International Class 37 as indicated above.

⁴ In view of the circumstances recounted, and inasmuch as there is no prejudice to the Examining Attorney, applicant's request in its reply brief for an enlargement of the 20-day period of time permitted by Trademark Rule 2.142(b)(1) to file its reply brief is approved. Such brief is accordingly considered to be timely filed.

⁵ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the

Here, inasmuch as applicant's mark and registrant's mark are identical in all respects,⁶ the focus of our inquiry is accordingly on the similarity or dissimilarity of the respective goods and services.

Applicant, referring to the copy which it made of record of the specimen of use submitted by the registrant,⁷ stresses in its initial brief that (underlining in original):

The specimen ... used ... to obtain the registration involves the service of drilling an oil and gas well using a coiled tubing unit. Coiled tubing units typically involve a continuous string of small diameter tubing, usually about 2" in diameter, which can be several thousand feet long, and have a drill bit at ... [the] lower end.

When using a coiled tubing, there are no threads to protect, because the coiled tubing is continuous--there is nothing to be threaded together. There also are no load lift rings to pick up a length of casing. The Board's attention is respectfully directed to page 2 of ... [the specimen], under the heading "Less manpower, more brainpower", the first sentence of which reads

"Continuous coiled piped doesn't require connections, so we eliminated the need for hazardous rig floor activities".

In sharp contrast, the applicant's goods are (1) thread protectors for protecting the pin end of a length of casing and (2) load lift rings for placement along the length of casing, typically involving large diameter casing, 2-3 feet in diameter. Load lift rings are never used with coiled tubing,

essential characteristics of the goods [and services] and differences in the marks." 192 USPQ at 29.

⁶ Applicant, as the Examining Attorney accurately observes in her brief, "does not contend otherwise."

⁷ Such specimen is the sole piece of evidence of record in this appeal.

because there are no sections of the tubing to be picked up. Thread protectors are never used with coiled tubing, because there are no threads to be protected.

The conventional drilling of oil wells, i.e., other than with coiled tubing as described in ... [the specimen], involves a drilling rig which first involves lifting and lowering a string of steel drill pipe, having a drill bit at its lower end, and which is used in drilling the borehole. Joints, typically 20 feet long of steel casing, are then lowered into, and cemented within the drilled borehole. Before the joints of casing are threaded together, the male pin end of the casing often is protected by a thread protector. If the joints have no upset (a raised portion), then a load lift ring is passed over the outside of each joint to provide a device which can be used to pick up and lower each joint of casing.

This lifting and lowering of the joints of casing requires a rig, sometimes referred to as a drilling rig, or a derrick, and has a rig floor. None of this is present in drilling with coiled tubing. The coiled tubing system uses a larger diameter, circular reel ... around which the coiled tubing is wrapped, and is typically transported to a well site on a tractor-trailer truck. The coiled tubing and its drill bit is then driven into the earth using the tractor motor. There is no drilling rig or rig floor needed to run the casing joints into the well bore, because casing is not used in well bores drilled with coiled tubing.

Applicant, in light thereof, argues that the goods and services at issue "could not be more different," asserting that:

The registrant uses coiled tubing to drill an oil well, i.e., to actually construct (drill) the wellbore. The goods and services of the applicant are those which are used and or provided into an already existing oil well. The drilling of an oil well could not be more different then [sic] the use of oil field equipment in an existing oil well. There are different customers, they occur at different times, [and] the purchasing agent[s] do not

run into each other out there on the same drill site.

.... When ... the registrant ... drills an oil well with coiled tubing there is no casing to be lifted up. The coil tubing is wrapped around a large drum at the surface and has a drill bit connected at its lower end, which is run into the ground to drill a hole. With continuous coiled tubing there simply is no casing to be picked up.

Moreover, the coil tubing unit used by the registrant has no need for thread protectors, because with continuous coil tubing, there are no threads visible, which can be damaged.

In short, the goods and services of the registrant and the applicant are completely different, the goods and services are sold to different customers, and there simply is no possibility of confusion.

The Examining Attorney, on the other hand, contends in her brief that "the question to be determined in this case is whether 'oilfield equipment, namely load lift rings, and thread protectors for use on oilfield casing before such casing is run into an Earth well bore' and 'oil well construction services' are so related that their contemporaneous sale by different parties under the ANACONDA mark would be likely to cause confusion as to source." She maintains that the goods and services at issue are indeed so related and hence, in light of the identity of the respective marks, that confusion is likely because "[o]il well construction services and oilfield equipment *used on oil wells* are related by subject matter" (italics in original).

Asserting, in particular, that "applicant has submitted an application for ... 'oilfield equipment, namely load lift rings, and thread protectors for use on oilfield casing before

such casing is run into an Earth well bore,' while the registrant has identified 'oil well construction services,'" the Examining Attorney correctly notes that:

It is widely accepted that the goods and services [at issue] need not be identical or even competitive to warrant a finding of a likelihood of confusion. They need only be related in some manner that could give rise to the mistaken belief that the goods [and services] come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Here, the Examining Attorney insists, "the goods and services are clearly related because they are both used in the oil field industry, and more specifically, are used or performed in connection with oil wells."

Moreover, as the Examining Attorney further correctly points out, the issue of likelihood of confusion "must be discussed within the context of the goods and services as *identified*" (emphasis in original), noting that:

A determination of whether there is a likelihood of confusion is made solely on the basis of the goods and services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999). If the cited registration describes the services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d

1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639
(TTAB 1981); TMEP §1207.01(a)(iii).

In consequence thereof, the Examining Attorney urges that:

Here, the registrant has placed no limits on the type or nature of the oil well construction services. As such it must be presumed that they include the construction of all types of oil wells, including those that utilize the types of oilfield equipment identified by the applicant.

However, as to applicant's assertion that the respective goods and services are different and the purchasers of such goods and services are also different, the Examining Attorney curiously maintains that "applicant provided no evidence to support this assertion, nor are there any limits in the registered services or the applicant's goods to support this assertion," notwithstanding the copy of the registrant's specimen of use which applicant made of record herein and the limitation in the recitation of registrant's services to "coiled tube construction systems." Nonetheless, while she further states that "applicant relies on the fact that the specific type of oilwell [sic] constructed ... (as evidenced by the specimen submitted by the registrant and included by the applicant ...) is different from the type of well that uses Applicant's equipment," she continues to maintain that "applicant submits no actual evidence that the respective goods and services travel in any particular channels of trade, nor is the identification in the registered mark limited to any particular type of oil well construction" and, thus, "it must be assumed that the registrant could construct the type of oil well that utilizes applicant's equipment."

Applicant, in its reply brief, stresses that "the Examiner has characterized the services covered by the registration as being for 'oil well construction services'" when, in fact, such services are in relevant part recited in the registration as "oil and gas coiled tubing well construction systems." Because registrant's services specifically involve the use of "coiled tubing," applicant reiterates its contention that, "in sharp contrast," its goods "have absolutely nothing to do with coil[ed] tubing" and, therefore, confusion is not likely.

We agree with applicant that, at least on this limited record, confusion is not likely. In particular, we find that because the recitation of registrant's services is ambiguous in part (applicant contending in essence that the words "oil and gas" modify the phrase "coiled tubing well construction systems" while the Examining Attorney broadly asserting in effect that the services include "oil well construction systems" of all kinds and not just those which use "coiled tubing"), it is permissible to look to extrinsic evidence for clarification, provided that the issue of likelihood of confusion is still based on the respective identification of goods and recitation of services. As stated by the Board in *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990), "when the description of goods [or services] for a cited registration is somewhat unclear, as is the case herein, it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of

goods [or services] has a specific meaning to members of the trade."

As the evidence furnished by applicant makes clear, use of coiled tubing is a method for construction of both oil wells and gas wells and thus is not limited to construction of gas wells. In addition, such evidence confirms that coiled tubing oil well construction services do not utilize applicant's goods because, with the use of coiled tubing, there is no need for connecting lengths of oilfield pipe casings and, therefore, neither load lift rings nor thread protectors are required. Consequently, as applicant contends, it is plain that purchasers of registrant's "oil and gas coiled tubing well construction systems and directional drilling services," as its services are recited in its registration, would be neither purchasers nor users of applicant's "machine parts for oilfield equipment, namely, load lift rings, and thread protectors for use on oilfield casing before such casing is run into an earth well bore," as such goods are set forth in applicant's application. Circumstances are such that contemporaneous use of the mark "ANACONDA" by both applicant and registrant for their respective goods and services is not likely to cause confusion as to source or sponsorship.

Finally, while it may be possible that customers for registrant's services might, on other occasions, have a need instead for construction of a "traditional" oil well which would utilize applicant's goods in the drilling thereof, such a scenario on this record is purely speculative. As noted, for

example, by our principal reviewing court in *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), it is error to deny registration simply because an applicant markets and sells its goods in the same general field as the services rendered by the registrant (e.g., what the Examining Attorney has characterized as "the oil field industry, and more specifically, [goods and services which] are used or performed in connection with oil wells"⁸) without also determining who are the relevant purchasers in instances of common business customers.

Here, even if the same firm or institution were to have occasion to purchase both applicant's "machine parts for oilfield equipment, namely, load lift rings, and thread protectors for use on oilfield casing before such casing is run into an earth well bore" and registrant's "oil and gas coiled tubing well construction systems and directional drilling services," such would not, of itself, establish similarity of trade channels or overlap of actual purchasers. Any likelihood of confusion, instead, has to be shown to exist not in the same firm or purchasing institution but in a shared individual customer or purchaser. See, e.g., As set forth, for instance, in *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718

⁸ It is settled in this regard that while a term may be found which encompasses the goods and services at issue, such does not mean that customers will view the respective goods and services as commercially or otherwise closely related in the sense that they will assume that they emanate from or are associated with a common source. See, e.g., *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 694 (TTAB 1977); and *Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517, 520 (TTAB 1975).

F.2d 1201, 220 USPQ 786, 791 (1st Cir. 1983) [for a likelihood of confusion to exist, "it must be based on confusion of some relevant person; i.e., a customer or user, and there is always less likelihood of confusion where goods [and/or services] are expensive and purchased and used by highly specialized individuals after careful consideration"].

Thus, our principal reviewing court has cautioned in this regard that:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, supra at 21 USPQ2d 1391, quoting from Witco Chemical Co. v. Whitfield Chemical Co., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967).

Applicant's goods and registrant's services, furthermore, clearly would be very expensive and would be bought only by highly knowledgeable, discriminating and sophisticated purchasers after thorough deliberation rather than on impulse. While the Examining Attorney, as additionally noted in her brief, properly points out that "the fact that oil field workers and purchasing agents are sophisticated or knowledgeable about the oil industry does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks [and service marks] or immune from source confusion," citing *In re Decombe*, 9 USPQ 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983), our principal reviewing court has

nonetheless pointed out that such "sophistication is important and often dispositive because sophisticated end-users may be expected to exercise greater care." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, supra at 21 USPQ2d 1392.

In consequence of the above, we conclude that contemporaneous use by applicant of the mark "ANACONDA" for its "machine parts for oilfield equipment, namely, load lift rings, and thread protectors for use on oilfield casing before such casing is run into an earth well bore" is not likely to cause confusion with registrant's identical mark "ANACONDA" for its "oil and gas coiled tubing well construction systems and directional drilling services."

Decision: The refusal under Section 2(d) is reversed.