

THIS OPINION IS
NOT A PRECEDENT OF
THE T.T.A.B.

Mailed: January 11, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zhuoye Lighter (USA) Co., Ltd.

Serial No. 76627753

David W. Lee for Zhuoye Lighter (USA) Co., Ltd.

Mark Sparacino, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Walters, Zervas and Bergsman, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Zhuoye Lighter (USA) Co., Ltd. has appealed from the
final refusal of the trademark examining attorney to
register MK (in standard character form) as a trademark for
the following goods, as amended: "cigarette lighters not
of precious metal," in International Class 34.¹

The examining attorney has refused registration
pursuant to Section 2(d) of the Trademark Act, 15 U.S.C.

¹ Application Serial No. 76627753, filed January 13, 2005,
asserting first use and first use in commerce in June 2003.

Serial No. 76627753

1052(d), on the ground that applicant's mark so resembles the previously registered mark MK (in typed form) for "jewelry" in International Class 14,² as to cause confusion or mistake or to deceive.

After the refusal was made final, applicant appealed. Applicant and the examining attorney have both filed briefs. Upon careful consideration of the arguments advanced by applicant and the examining attorney, we conclude that confusion is likely.

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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, 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).

² Registration No. 1605458, issued July 10, 1990, renewed.

Turning first to the first *du Pont* factor, i.e., the similarity of the marks, the marks are both MK and are identical in sound, appearance, meaning and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Applicant has conceded the identity of the marks. Brief at p. 3. Thus, this factor weighs heavily against applicant.

We next consider the second, third and fourth *du Pont* factors, i.e., the similarities between registrant's and applicant's goods, the similarities between registrant's and applicant's trade channels and classes of purchasers of those goods, and the conditions under which and buyers to whom sales are made.³

In comparing the goods, we note that where identical marks are involved, as is the case here, the degree of similarity between the parties' goods that is required to support a finding of likelihood of confusion declines. *In*

³ At p. 3 of its reply, applicant has proposed to amend its identification of goods to "disposable lighter[s] of non precious metal." Because the proposed amendment would serve no useful purpose and because it expands the scope of the current identification of goods in that it does not restrict the type of lighters to cigarette lighters, applicant's proposed amendment is denied. See Trademark Rule 2.71(a); TBMP §1205.01 (4th ed. rev. 2004). We add, however, that our decision in this case would not be any different if the operative identification of goods were the proposed identification of goods.

Serial No. 76627753

re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002); and *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001). If the marks are the same, as in this case, it is only necessary that there be a viable relationship between the goods in order to support a finding of likelihood of confusion. See *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Furthermore, it is not necessary that the goods at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods 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 *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

In this case, the examining attorney has made of record a number of use-based third-party registrations which show that various entities have adopted a single mark

Serial No. 76627753

for goods that are identified in both applicant's application and the cited registration. 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).

See, for example:

Registration No. 1280488 for CATERPILLAR for inter alia "cigarette lighters" and "key chains and lapel pins ... jewelry watch fobs of leather";

Registration No. 1896686 for SPIRIT OF ST. LOUIS NEW YORK PARIS and Design for inter alia "jewelry" and "smokers' articles; namely, ... lighters";

Registration No. 2071390 for JUNKMAN'S DAUGHTER for inter alia "jewelry" and "smokers' accessories, not of precious metal, namely, cigarette lighters";

Registration No. 2241936 for ASTRO BOY for inter alia "cufflinks; ... jewelry pins" and "cigarette lighters ... not of precious metal";

Registration No. 2265395 for a design for inter alia "men's jewelry" and "smokers articles, namely, ... cigarette lighters, not of precious metal";

Registration No. 2589357 for GL for inter alia "precious metals and their alloys and goods in precious metals or coated therewith, namely, jewelry" and "cigarette and cigar lighters, not of precious metal";

Serial No. 76627753

Registration No. 2597009 for AMA and Design for inter alia "jewelry" and "cigarette lighters not of precious metal"; and

Registration No. 2872072 for W and Design for inter alia "jewelry" and "cigarette lighters made of non-precious metal."⁴

The foregoing evidence demonstrates the existence of at least a viable relationship between the goods at issue.⁵

Further, the goods of the application and the registration may include inexpensive, common consumer goods that are sold to ordinary consumers. As such, they are

⁴ In addition to the registrations, the examining attorney has listed in his final Office action seven search results from "the LEXIS computerized research database" to support his contention that applicant's and registrant's goods are related. Apparently, his search was for "jewelry w/10 'lighters.'" His "Lexis" search results - consisting of extremely brief excerpts of news stories - have no probative value because the excerpts are too brief and do not provide us with information regarding the source of the jewelry and lighters mentioned in the excerpts. For example, all that is provided in the June 30, 2005 excerpt from *The Providence Journal (Rhode Island)* is, "Design, manufacture and market jewelry, watches, lighters, accessories, pens, gift"

⁵ Applicant points out that its goods and registrant's goods are in different International Classes; and "that these two classes are dissimilar." Brief at p. 4. However, as the Examining Attorney correctly observed in her brief, the classification of goods is purely an administrative determination and has no bearing on the question of likelihood of confusion. Rather, it is the manner in which applicant and registrant have identified their goods which is controlling. See, e.g., *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212 (TTAB 1990).

subject to impulse purchases and may be found in the same retail locations, such as small gift shops and kiosks.⁶

Applicant has argued that registrant uses its mark only on jewelry made of precious metals and sells its goods at "higher end" jewelry stores; and that in contrast, applicant does not use its mark in connection with lighters "made of jewelry" and does not sell its goods at jewelry stores. Rather, applicant maintains that it sells disposable cigarette lighters and barbecue lighters consisting of a child resistant mechanism, a clear plastic shell and a head of non-precious metals, mainly at liquor stores, supermarkets, gas stations and convenience stores such as 7-11. Brief at pp. 4-5. Applicant concludes that applicant's trade channels and market are different from registrant's trade channels and market. Brief at p. 5.

Applicant's argument is not well taken. Our determination of the likelihood of confusion issue is based on the identifications of goods as they are recited in the application and registration, and we do not read

⁶ To the extent that applicant is contending at p. 4 of its reply that even if the goods are subject to impulse purchases, confusion is not likely because consumers will know that they are purchasing different goods, i.e., a cigarette lighter on one hand and jewelry on the other, we disagree. The question is not whether purchasers can differentiate the goods themselves, but rather whether purchasers are likely to confuse the source of the goods. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

limitations into those identifications of goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987); *In re Elbaum*, 211 USPQ 639 (TTAB 1981). If the cited registration describes goods broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods of the type described, that they move in all channels of trade normal for these goods, and that they are available to all classes of purchasers for the described goods. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). Thus, we do not consider registrant's registration as only encompassing jewelry made of precious metals sold only at "higher end" jewelry stores, but also as encompassing inexpensive jewelry, not made of precious metals, sold in appropriate trade channels for such inexpensive goods.

In view of the foregoing, we also resolve the second, third and fourth *du Pont* factors against applicant.

Applicant has also argued that registrant's mark has been in use for a long time since 1985; and that there have been no instances of actual confusion since applicant has placed its goods on the market. Brief at p. 4. However,

Serial No. 76627753

there is no evidence in the record as to the geographic locations where applicant and registrant have been doing business. If distant from each other, the geographic separation may account for this lack of actual confusion. Also, there is no evidence in the record regarding the level of sales or advertising by applicant. The absence of any instances of actual confusion is a meaningful factor only where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or both of these trademark owners. Similarly, we have no information concerning the nature and extent of registrant's use, and thus we cannot tell whether there has been sufficient opportunity for confusion to occur, as we have not heard from the registrant on this point. All of these factors materially reduce the probative value of applicant's argument regarding a lack of actual confusion. Therefore, applicant's contention that there has been no actual confusion is not indicative of an absence of a likelihood of confusion. See *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) ("uncorroborated

statements of no known instances of actual confusion are of little evidentiary value.")

Next, we address applicant's additional argument regarding the strength of registrant's mark, which applicant raises for the first time in its reply brief and which the examining attorney did not raise in his brief. Specifically, applicant argues that "there is an indisputable issue of fact [that] exists because registrant's mark is a very weak mark and entitled to a narrow scope of protection due to wide-ranging third party use and registrations." Applicant's argument is improper because it has raised its argument for the first time in its reply brief, and not in response to an argument made by the examining attorney. The purpose of a reply brief is to offer an opportunity to the applicant to respond to arguments made by the examining attorney, not to allow applicant to make new arguments that come to mind after the filing of the main brief and to which the examining attorney may not respond. Additionally, applicant's argument suffers because there is no evidentiary support for applicant's argument. The third party applications and registrations that applicant refers to are not of record

Serial No. 76627753

and the Board does not take judicial notice of applications and registrations.⁷

In view of the foregoing, we find that applicant's mark MK for "cigarette lighters not of precious metal" is likely to cause source confusion among purchasers with the identical registered mark MK for "jewelry."

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

⁷ Applicant should note too that third-party applications are only proof that the applications have been filed and thus are without probative value to the likelihood of confusion issue. See *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467 (TTAB 1973).