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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re DV International, Inc.

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Serial No. 78470317

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Daniel M. Pauly of Pauly DeVries Smith & Deffner, LLC for  
DV International, Inc.

Curtis W. French, Trademark Examining Attorney, Law Office  
115 (Tomas V. Vlcek, Managing Attorney)

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Before Bucher, Zervas and Walsh, Administrative Trademark  
Judges.

Opinion by Walsh, Administrative Trademark Judge:

DV International, Inc. (applicant) has applied to  
register the mark SOFTTOUCH in standard characters on the  
Principal Register for goods identified as "household  
plastic storage organizers, namely, cutlery trays, spice  
racks, lazy susans, and drawer organizers" in International  
Class 21.<sup>1</sup>

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<sup>1</sup> Application Serial No. 78470317 based on applicant's statement of its  
bona fide intention to use the mark in commerce under Trademark Act  
Section 1(b), 15 U.S.C. § 1051(b).

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The Examining Attorney has finally refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with Registration No. 2938634 on the Principal Register for the mark SOFT TOUCH CAN in standard characters for goods identified as "metal trash cans, household containers sold empty that are used for recycling purposes" in International Class 21. The registration issued on April 5, 2005. The registration claims first use of the mark anywhere and first use of the mark in commerce on March 14, 2003. The registration includes a disclaimer of "CAN."

Applicant has appealed. Applicant and the Examining Attorney have filed briefs. We affirm.

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion ..." 15 U.S.C. § 1052(d). In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977), the Court set forth the factors to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of applicant and registrants. *Federated Foods, Inc. v. Fort*

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*Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Regarding the marks, in comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant argues that the marks are not similar because the registered mark includes the word "CAN" and its mark does not. The Examining Attorney argues that the marks are highly similar because the only difference between the marks is the inclusion of "CAN," a generic term, in the registered mark.

Without hesitation we conclude that the marks are highly similar. The presence of the disclaimed, generic term, "CAN," in the registered mark does nothing to distinguish the marks in any significant way in appearance, sound, connotation or commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Accordingly, we conclude that the marks are highly similar.

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As to the goods, the goods of applicant and the registrant need not be identical to find a likelihood of confusion under Section 2(d). They need only be related in such a way that the circumstances surrounding their marketing would result in relevant purchasers mistakenly believing that the goods originate from the same source. *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Furthermore, in comparing the goods and the channels of trade we must consider the goods as identified in the application and registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

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Applicant identifies its goods as "household plastic storage organizers, namely, cutlery trays, spice racks, lazy susans, and drawer organizers." The goods in the cited registration are identified as "metal trash cans, household containers sold empty that are used for recycling purposes."

Applicant argues, "The goods and services for the two marks are not confusingly similar. None of the items in connection with applicant's mark is likely ever to be used for recycling purposes. Applicant fails to see how a cutlery tray would be used to store recycling materials." Applicant's brief at 2. Applicant argues in similar fashion with regard to its other goods. As to the channels of trade, applicant argues, "The respective goods are in two different markets altogether. SOFT TOUCH CAN is directed to recycling options, and SOFTTOUCH is directed to kitchen organization." Applicant's Brief at 3.

The Examining Attorney argues that the respective goods, as identified in the application and registration, are closely related and that they would travel through the same or overlapping trade channels, in the absence of any restrictions in the identifications.

The Examining has provided evidence to support his position. Specifically, the Examination Attorney has

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provided several third-party registrations where the same mark has been registered for the types of goods in both the application and the cited registration. For example, those registrations include:

Registration No. 2783704 identifying, among other things, "plastic kitchen and house ware goods, namely, ... trash cans, ... storage containers, ... cutlery trays...";

Registration No. 2836427 identifying, among other things, "... cutlery trays, ... trash cans, ... non-precious metal containers for household or kitchen use...";

Registration No. 3012881 identifying, among other things, "kitchen utensils and containers for household use, namely, ... cutlery trays, cutlery trays with covers, ... large rectangular containers, ... multi-purpose trash cans..."; and

Registration No. 3041871 identifying, among other things, "containers, not of precious metal, for household or kitchen use; kitchen utensils, not of precious metal, namely, ... folding spice racks; ... trash cans..."

Attachments to Final Office Action.

These registrations, and the others submitted by the Examining Attorney, suggest that the respective goods are of a type which may emanate from the same source. *In re TSI Brands Inc.*, 67 USPQ2d 1657, 1659 (TTAB 2002); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The Examining Attorney has also provided excerpts from a website associated with Rubbermaid showing various types of trash containers and drawer and cutlery organizers for sale under the same mark, as well as excerpts from the website of Oxo showing various types of trash containers and drawer-type utensil organizers, and table or kitchen turntables (lazy susans) for sale under the same mark. *Id.*

We conclude that the goods identified in the application and the goods identified in the cited registration are related and that they would travel through the same or overlapping trade channels to the same potential purchasers. We reject applicant's argument asserting that the goods would not be confused. Applicant misses the fundamental point. The point of the likelihood-of-confusion analysis is not whether the goods could be confused, but whether the source of the goods could be confused as a result of the use of similar marks on related goods. We likewise reject applicant's unsupported argument that the respective goods are in different markets - trade channels. The Examining Attorney's evidence satisfactorily establishes that the respective goods are related and that the respective goods, in fact, do travel through the same trade channels.

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Furthermore, the Board has stated, "... it is important to note that the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

In this case, the marks are highly similar, the goods are related and the goods travel through the same channels of trade. Therefore, we conclude that there is a likelihood of confusion between SOFTTOUCH, when used in connection with "household plastic storage organizers, namely, cutlery trays, spice racks, lazy susans, and drawer organizers," and SOFT TOUCH CAN, when used in connection with "metal trash cans, household containers sold empty that are used for recycling purposes."

**Decision:** We affirm the refusal under Trademark Act Section 2(d).