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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Alarmax Distributors, Inc.

Serial No. 78479366

Thomas C. Wettach for Cohen & Grigsby, P.C. for Alarmax
Distributors, Inc.

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Before Grendel, Drost, and Kuhlke, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 7, 2004, Alarmax Distributors, Inc.
(applicant) filed an application (No. 78479366) to register
the mark ALARMAX (in standard character form) on the
Principal Register for "wholesale distributorship featuring
security systems and alarm equipment" in Class 35. The
application contains an allegation of dates of first use
anywhere and in commerce of August 31, 1992.

The examining attorney has refused to register
applicant's mark under Section 2(d) of the Trademark Act

because of a registration of the mark ALARMEX, in typed or standard character form, for the following services:

Installation[,] maintenance, and repair of burglar, holdup, fire alarms and closed circuit television systems used for surveillance purposes in Class 37 and

Design of burglar, holdup, and fire alarms for others; monitoring of burglar, holdup, and fire alarms in Class 42.¹

After the examining attorney² made the refusal final, this appeal followed.

The examining attorney argues that the marks "are essentially equivalents" and "highly similar in appearance and meaning." Brief at unnumbered pp. 5 and 7. In addition, applicant maintains that the services are related because "applicant is selling security systems and alarm equipment, and registrant is providing the design and maintenance of such systems." Brief at unnumbered p. 8.

Applicant's principal argument in response to the examining attorney's refusal is that:

Applicant is a distributor of security systems and alarm equipment to licensed dealers and installers. Applicant uses its mark to promote its distributorship services to licensed dealers and installers only. For example, Applicant's online catalog can only be accessed by licensed dealers/installers who have an account, user name, and password registered with the company. In contrast, registrant of the '455 mark offers commercial-grade security solutions tailored

¹ Registration No. 1,784,455 issued July 27, 1993, renewed.

² The current examining attorney was not the original examining attorney in the case.

to retailers. Thus, Applicant's and registrant's services do not overlap and as such there is little likelihood of confusion between the marks... Applicant's target market is licensed dealers and installers, while registrant's target market is retailers seeking commercial-grade security systems.

Brief at 4-5 (footnotes omitted).³

Applicant also argues that the ALARMEX is a weak mark, that there has been no actual confusion, and that "Applicant previously owned a registration for the 'ALARMAX' mark for these exact distributorship services that was unintentionally not renewed due to circumstances beyond its control (Reg. No. 1,788,670; registered August 17, 1993)." Brief at 7.⁴

When we are addressing the issue of likelihood of confusion, we consider the evidence as it relates to the factors set out by the Federal Circuit and the CCPA in such cases as In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000); and

³ We decline to consider the evidence that applicant has submitted for the first time on appeal to support these arguments. 37 CFR § 2.142(d).

⁴ We note that the underlying application (No. 74340379) that ultimately issued as the '670 registration was filed on December 14, 1992, and alleged dates of first use of August 31, 1992. The cited registration was filed on November 9, 1992, and it alleged dates of use in 1988. Applicant's canceled registration does not justify the registration of its current application. 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").

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). 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 first DuPont factor requires examination of 'the similarity or dissimilarity of the marks in their entireties as to 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 (Fed. Cir. 2005) (quoting du Pont, 177 USPQ at 567). Here, the marks are ALARMAX and ALARMEX. The marks differ only inasmuch the second to the last letter in each mark is a different vowel, "A" and "E." We start by observing that the slight difference between these two marks might not even be noticed by many customers. Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973) ("Side by side comparison is not the test"). Inasmuch as the marks have the identical letters in the same order except for the final vowel and both are displayed in typed or standard

character form, we conclude that they are very similar in appearance.

Regarding their pronunciation, the examining attorney argues that the marks are "essentially phonetic equivalents." Brief at unnumbered p. 5. It is true that there "is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark." Centraz Industries Inc. v. Spartan Chemical Co., 77 USPQ2d 1698, 1701 (TTAB 2006). We agree with the examining attorney that many, if not most, purchasers would pronounce the words ALARMAX and ALARMEX either identically or very similarly. Finally, regarding their meanings and commercial impressions, both words begin with the same descriptive prefix "ALARM-" and end with the letter "X." Neither word has any known meaning and both would suggest some connection with alarms. There would be virtually no differences to many purchasers between the words ALARMEX and ALARMAX.

While applicant does argue that registrant's mark is weak, there is simply no evidence of record to support this conclusion and, while we have noted that there is a suggestive meaning to the marks to the extent that they begin with the term "ALARM-" for services related to

security and alarm systems, we cannot hold that the mark as a whole is weak.

We also briefly address applicant's argument that the lack of actual confusion is a factor that indicates that there is no likelihood of confusion in this case. The test is clearly likelihood of confusion and not actual confusion. In *ex parte* cases, where the registrant does not have an opportunity to present evidence, it would be unusual that the lack of actual confusion would demonstrate that there was no likelihood of confusion. Indeed, the Federal Circuit has held that the "lack of evidence of actual confusion carries little weight." Majestic Distilling, 65 USPQ2d at 1205. We conclude that this is not a significant factor here.

We now address the last relevant factors that are potentially dispositive. These factors involve the relatedness of the services, the trade channels, and potential purchasers. At first glance, the relatedness of the services seems self-evident. Applicant distributes security systems and alarm equipment and registrant installs, maintains, repairs, and designs burglar, holdup, fire alarms. However, to determine whether the services are related, we are required to look to see how they are described in the identification of services in the

application and registration. In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

"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).

In this case, applicant's services are specifically limited to wholesale distributorship services. In effect, applicant's services would not be available to ordinary customers. Because we cannot read limitations into the identification of services, we cannot accept applicant's arguments that its services are limited to only licensed dealers and installers. However, inasmuch as applicant is selling security and alarm systems to alarm system retailers, we must assume that applicant's purchasers are not ordinary purchasers.

Registrant's services, on the other hand, involve installation, maintenance, repair, and design services for alarm systems. These purchasers would primarily be purchasing services at retail for their homes and businesses. While applicant argues that registrant "offers commercial-grade security solutions tailored to retailers," we would have to assume that these services are offered to ordinary customers and not just retailers.

"The degree of 'relatedness' must be viewed in the context of all the factors, in determining whether the services are sufficiently related that a reasonable consumer would be confused as to source or sponsorship. It is relevant to consider the degree of overlap of consumers exposed to the respective services." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). See also M2 Software Inc. v. M2 Communications Inc., 450 F.3d 1378, 78 USPQ2d 1944, 1948 (Fed. Cir. 2006) (The "unrelated nature of the parties' goods and their different purchasers and channels of trade are factors that weigh heavily against M2 Software. It is difficult to establish likelihood of confusion in the absence of overlap as to either factor").

We also must look beyond the fact that applicant and registrant may be operating in the same field. Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992)

("[A]lthough the two parties conduct business not only in the same fields but also with some of the same companies, the mere purchase of the goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers").

See also Astra Pharmaceutical Products, Inc. v. Beckman

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Instruments, Inc., 718 F.2d 1201, 220 USPQ 786, 792 (1st Cir. 1983) (Pharmaceutical products sold to hospital pharmacies not related to laboratory instrumentation sold to hospital laboratories).

In a case involving the security industry, the Third Circuit held that there was no likelihood of confusion when the marks CHECKPOINT and CHECK POINT were used in the security industry. Checkpoint Systems, Inc. v. Check Point Software Technologies Inc., 269 F.2d 270, 60 USPQ2d 1609, 1620 (3rd Cir. 2001):

While Checkpoint Systems's access control, closed circuit television and radio frequency products may employ similar technology, their purpose is physical article surveillance or personal access. On the other hand, Check Point Software's firewall technology is not intended to prevent theft of merchandise or limit physical access. Its purpose is to prevent third parties from accessing information from unsecure computer lines. Because the products serve different functions, and there is only "minimal overlap" in the product technology, it is unlikely consumers would be confused by the similar marks.

Therefore, our discussion must focus on whether the services as described are related and whether relevant purchasers will be confused.

In order to demonstrate that the services are related the examining attorney introduced numerous registrations. We have set out the most relevant registrations below.

Registration No. 1,377,522
Mark: PER MAR

Ser No. 78479366

Services:

Class 37: Installation and servicing of security systems and safety devices

Class 42: Security guard, mobile patrol and investigation services; and leasing and distributorship services in the field of security systems.

Registration No. 1,868,608

Mark: DIVERSIFIRE SYSTEMS

Services:

Class 37: Installation and repair of fire alarm systems

Class 42: Retail store and distributorships in the field of fire alarm systems.

Registration No. 1,968,173

Mark: PHONEXTRA

Services:

Class 37: Refurbishing, repair and installation of new and used telephone, voice processing and security systems of others.

Class 42: Distributorship services in the field of new and refurbished telephone, voice processing and security systems of others.

Registration No. 2,344,148

Mark: DIRECTLINK OF OREGON

Services:

Class 37: Installation and repair of cable television equipment, telephone equipment, and alarm system equipment

Class 35: Retail distributorship services in the field of alarm system equipment and leasing of alarm system equipment.

Registration No. 2,917,643

Mark: FIRST ACTION SECURITY TEAM and design

Services:

Class 35: Offering technical assistance in the establishment and/or operation of dealerships that feature security alarm systems for residential and commercial use, that offer installation and maintenance of security alarm systems for residential and commercial use, and that feature security products for sale for residential and commercial use, namely digital alarm controls, digital security transmitters

for window and door installation, portable panic button transmitters, infrared sensors, infrared transmitters, security control and fire detection systems comprising smoke detectors, monitors, code access panels, wireless keypad alarms, alarm lights, master alarm control units, alarm transmitters and parts therefor; dealerships, distributorships, and wholesale distributorships featuring security products for residential and commercial use
Class 45: Alarm monitoring services.

Registration No. 2,971,406⁵

Mark: SELECTAUTOMATION

Services:

Class 37: Installation of security systems, lighting, heating and air conditioning systems, audio and video systems; Installation of computer networks.

Class 35: Retail store services featuring security systems, computer systems and computer networks, lighting, heating and air conditioning systems, audio and video systems; Distributorships in the field of security systems, computer systems and computer networks, lighting, heating and air conditioning systems, audio and video systems.

Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source." In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

The examining attorney also submitted evidence of registrations involving distributorship services in fields unrelated to the alarm/security field, which we do not find

to be relevant, and LEXIS/NEXIS excerpts that seem to show the same entities selling and servicing alarm systems at the retail level. See, e.g., Argus Leader, November 16, 2005 ("Dakota Security is one of several businesses in Sioux Falls that sell, install and monitor security equipment...").

When we consider the evidence that the examining attorney has submitted, we note that one registration (No. 2,917,643) includes wholesale distributorship services and alarm monitoring services. In addition, several other registrations, if we read the term "distributorships" to include wholesale distributorship services, support the conclusion that the services are at least minimally related. Therefore, we conclude that there is some evidence that suggests that the services are related.

To find confusion, our conclusion must also rest on whether the channels of trade are similar and whether the purchasers would overlap. Even if applicant's wholesale distributorship services and registrant's installing, maintaining, repairing, and designing services are in some way related, it is not clear where there would be an

⁵ A second, similar registration from the same registrant was also submitted.

overlap between applicant's and registrant's channels of trade.

As a wholesaler, applicant's customers would be retailers who would then sell the security and alarm systems that they purchased from applicant to their commercial and residential customers. There is no evidence that these customers would ordinarily have any knowledge of applicant or its service mark. Applicant's customers would be retail stores and similar establishments that sell alarm systems. We add that buyers for these retail establishments would be more sophisticated and careful customers than ordinary purchasers. As such, there is less likelihood that these buyers would be confused.

In this regard, we further note that the respective goods of the parties are sophisticated medical equipment which would be selected with great care by purchasers familiar with the source or origin of the products. See In re N.A.D. Inc., 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985). Buyers of the parties' goods, as well as potential customers for the products, plainly are highly educated, sophisticated purchasers who know their equipment needs and would be expected to exercise a great deal of care in its selection.

Hewlett-Packard Co. v. Human Performance Measurement Inc.,
23 USPQ2d 1390, 1396 (TTAB 1991).

While registrant's services may be available to commercial and individual customers, applicant's wholesale distributorship clearly would not include these ordinary

purchasers. Therefore, we must concentrate on whether there is any potential overlap with the only consumers who may be aware of both marks used on the respective services. Continental Plastic Containers Inc. v. Owens-Brockway Plastic Products Inc., 141 F.3d 1073, 46 USPQ2d 1277, 1282 (Fed. Cir. 1998) ("Common sense and Seventh Circuit law dictate that there must be a clear nexus between the relevant product and confusion of the potential customer of that product").

It is not clear if applicant's wholesale distributorship purchasers of security systems would also be purchasers of the services of designing, installing, and repairing security systems. Indeed, it would appear that the purchasers of security and alarm systems at wholesale would more likely be providers of installation, design, repair, and monitoring services for alarm and security systems than they would be purchasing these services. To the extent that these retailers of security and alarm systems at wholesale would also be purchasing installation, repair, maintenance, and design services, the sophistication of the purchasers would diminish the possibility that there would be confusion. In addition:

The Board's concern that opposer's customers "who come into contact with" applicant's goods "may well believe that applicant's goods are produced or sponsored by

opposer" is unwarranted because it would involve at most only a de minimis number of sophisticated purchasers. In other words, any overlap in customers is too small to be significant much less dispositive.

Electronic Design & Sales, 21 USPQ2d at 1392 (citation omitted).

In this case, the "ultimate inquiry, regardless of the nature of the involved marks, is whether 'relevant persons' are likely to be confused." In re Code Consultants Inc., 60 USPQ2d 1699, 1700 (TTAB 2001). While the marks are very similar, the services are, at best, only somewhat related. In addition, there are differences in the channels of trade and the relevant purchasers would be sophisticated purchasers. When we weigh these factors, we conclude that confusion may be possible but not likely. Electronic Design & Sales, 21 USPQ2d at 1393 ("[T]he potential for confusion appears a mere possibility not a probability").

Decision: The refusal to register is reversed.