

**THIS OPINION
IS NOT A PRECEDENT OF
THE TTAB**

Mailed: November 21, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hild Chemical, Inc.

Serial No. 78530152

Robert D. Buyan of Stout, Uxa, Buyan & Mullins for Hild
Chemical, Inc.

Katherine S. Chang, Trademark Examining Attorney, Law Office
115 (J. Brett Golden, Acting Managing Attorney).

Before Quinn, Walters and Holtzman, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Hild Chemical, Inc. has filed an application to register the mark HILD on the Principal Register for "chemicals for use in cleaning floors and carpets," in International Class 3.¹ The application includes a claim of acquired distinctiveness under Section 2(f).

¹ Serial No. 78530152, filed December 9, 2004, based on use of the mark in commerce, alleging first use and use in commerce as of December 1, 1991.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark HILD, previously registered for "vacuum cleaners, rug and carpet beaters, scrubbers and polishers," in International Class 21,"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive. The cited registration includes a claim of acquired distinctiveness under Section 2(f).

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

As a preliminary matter, applicant attached evidence to its supplemental brief and the examining attorney objected to consideration of this evidence, correctly noting that the record must be complete prior to appeal. This evidence has been given no consideration.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm*

² Registration No. 0756744, issued September 17, 1963. The registration is owned by Mytee Products, Inc. [Section 15 affidavit acknowledged; second renewal.]

Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that “[t]he 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.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to a comparison of the marks and note that the marks are identical, which applicant does not dispute. This *du Pont* factor weighs strongly against applicant.

We thus begin our analysis of the respective goods with the premise that, because the marks at issue are identical, the extent to which the applicant’s and registrant’s goods must be similar or related to support a finding of likelihood of confusion is lessened. See *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). It is only necessary that there be a viable relationship between the

two to support a finding of likelihood of confusion. See *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

The question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each party's goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner*

Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002).

In support of her position that the goods are complementary and will, by definition, be used together, the examining attorney submitted excerpts from Internet websites offering for sale vacuum cleaners and combination rug shampoos and floor polishers, e.g., the Koblenz Cleaning Machine, and websites offering multi-purpose floor and carpet cleaning and polishing machines and chemical cleaners for use in connection therewith under the same brands, e.g., Oreck, Bissell, Eureka, Dirt Devil, Hoover, and Kenmore.

Applicant argues that the goods are different and are classified in different classes; that there has been no actual confusion despite many years of coexistence; and that the registered mark is not famous. None of these arguments is well taken. Classification is merely for the administrative convenience of the U.S. Patent and Trademark Office and is irrelevant to the issue of likelihood of confusion. While the fame of a mark may be a factor in determining likelihood of confusion, it is not a necessary showing and the determination of likelihood of confusion is based on only those *du Pont* factors that are relevant in the case at hand. Similarly, while actual confusion is a factor to be considered, the absence or presence of actual confusion is of little probative value where we have little

Serial No. 78530152

evidence pertaining to the nature and extent of the use by applicant and registrant. Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. See *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value."). See also, *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992); and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

Based on the record herein, we agree with the examining attorney that the respective goods are complementary products that prospective purchasers are likely to believe come from the same source when identified by identical marks.

Further, inasmuch as the identifications of goods in both the involved application and the cited registration are not limited to any specific channels of trade, we presume that the goods would be offered in all ordinary trade channels for these goods and to all usual classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). In view of the complementary nature of the goods, it is likely that they will travel in identical, or at least overlapping, trade channels to both commercial and residential consumers. These *du Pont* factors and, in

particular, the factor of the relatedness of the goods, weigh strongly against applicant.

Applicant contends that its adoption and use of its mark is with the permission and knowledge of the original registrant herein and, as discussed below, applicant submitted a declaration and agreement in support thereof. In its January 17, 2006, response, applicant contends that "[a]pplicant's family members effectively own [the cited registration]."

The examining attorney contends that the agreement is not persuasive because it was signed by a predecessor of registrant; and it does not state why confusion is unlikely and what steps the parties will take to avoid confusion. The examining attorney contends, further that, if the agreement was intended as an assignment, it is an invalid assignment in gross with no transfer of goodwill; and if it is intended as a license, then applicant is not the owner of the mark herein.

In support of its position, applicant submitted the declaration of James V. Roti attesting to the history of applicant's and registrant's companies. Mr. Roti recounted that registrant's predecessor, Hild Floor Machine Company, Inc., was "owned" by his father, James P. Roti; that in 1991, with the knowledge and consent of Hild Floor Machine Company, Inc., Joseph E. Roti, James V. Roti's brother,

started a business selling floor maintenance chemicals under the HILD trademark and this business became applicant herein, Hild Chemical, Inc. Attached to the declaration is a purported agreement dated August 21, 1999, between James V. Roti and Joseph E. Roti recounting that James V. Roti purchased the assets of Hild Floor Machine Company, Inc. at its bankruptcy auction in April, 1998; transferring to Joseph E. Roti "title to the name 'Hild' for the purposes of selling maintenance chemicals"; and retaining to James V. Roti "the right to use the name 'Hild' for any and all other purposes."

Additionally, the USPTO assignment records pertaining to the cited registration show that the registration was originally owned by Hild Machine Company, Inc.; include an April 1998 bankruptcy order that resulted in the sale of Hild Machine Company, Inc.'s assets, including its trademarks, at a bankruptcy auction to James V. Roti; and include a subsequent "Agreement for Purchase and Sale of Assets," dated March 8, 2001, between James V. Roti (Seller) and the current registrant, Mytee Products, Inc. (Buyer). This latter agreement states Buyer's desire to purchase the "assets of Seller related to the now-bankrupt Hild Floor Machine Company" and notes that Seller "purchased said assets at a bankruptcy auction held for the Hild Floor Machine Company." The sale includes "the name Hild and/or

Hild Floor Machine Company and any and all related, derivative or associated trademarks" and the goodwill associated therewith; and the document contains Seller's agreement not to compete in the same business for three years, although it expressly permits Seller to sell janitorial equipment and supplies. Finally, the purchase and sale agreement contains the statement that it and the accompanying letter of intent constitute the entire agreement between the parties and any waiver must be in writing.

The plain language of the aforementioned purchase and sale agreement contemplates the sale to Mytee Products, Inc. of all of the assets acquired by James V. Roti at the bankruptcy auction. This agreement is inconsistent with a transfer of certain rights in the mark HILD by James V. Roti to applicant subsequent to the bankruptcy auction and prior to the sale of the mark and registration to Mytee Products, Inc. Moreover, as noted by the examining attorney, the 1999 document submitted by applicant does not include a transfer of goodwill and, as such, is an invalid trademark assignment. Nor is it an agreement from registrant consenting to applicant's registration of the mark herein. Therefore, the documents and declaration submitted by applicant do not effectively counterbalance the other *du Pont* factors discussed herein.

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of the identity of the marks, their contemporaneous use on the complementary goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

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