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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Newpage Corporation

Serial No. 78578276

Theodore D. Lienesch of Thompson Hine LLP for Newpage Corporation.

Karen Bush, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Taylor, and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Newpage Corporation ("applicant") filed, on March 2, 2005, an application to register on the Principal Register the mark STERLING ULTRA DIGITAL (in standard character format) for "coated printing papers" in International Class 16. The application is based on applicant's allegation that it first used the mark anywhere and in commerce on April 23, 2003. Applicant disclaimed the term "digital"

and claimed ownership of a prior registration for the mark STERLING.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark ULTRA DIGITAL (in standard character form) for "pressure sensitive and non-pressure sensitive paper for use on plateless imaging systems" in International Class 16.²

Applicant appealed the final refusal of its application and filed a request for reconsideration. The examining attorney denied applicant's request for reconsideration and, subsequently, both applicant and the examining attorney filed briefs. As discussed below, the refusal to register is affirmed.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act is based on an analysis of all of the 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 & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65

¹ Registration No. 1046345 for "coated book and magazine paper" in International Class 16.

² Registration No. 2933722, issued March 15, 2005. An assignment of the registration to GPA Acquisition Company, Inc. was recorded with the Office on December 6, 2004 (at reel 2986, frame 0121).

USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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).

We turn first to the similarity and dissimilarity of applicant's goods, i.e., coated printing papers, and registrant's goods, i.e., pressure sensitive and non-pressure sensitive paper for use on plateless imaging systems. On page 6 of its appeal brief, applicant states that "for the limited purpose of this appeal, Applicant will stipulate to the relatedness of the goods." In addition to this concession, the examining attorney has submitted evidence in support of her contention that the respectively identified goods are highly related, complementary and are found in the same trade channels. Specifically, she attached copies of various use-based third-party registrations to her final Office action which show that various trademark owners have adopted a single mark for goods of the kind 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 Infinity Broad Corp.*, 60 USPQ2d 1214 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

The examining attorney also attached printouts from the websites of three office supply retailers (Staples, OfficeMax and Office Depot) showing that both applicant's and registrant's recited goods may be purchased at each of these websites, and that they are offered to the same classes of consumers.

Based on the evidence and for the foregoing reasons, we find that the goods are highly related, and that the respective goods travel in the same trade channels to the same class(es) of purchasers. Accordingly, we resolve the *du Pont* factors regarding the similarity of the goods, trade channels and classes of purchasers against applicant.

We next consider the similarity and dissimilarity between the marks. Our focus is on whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). For purposes of sound and appearance, the only difference between the marks is

applicant's addition of the term STERLING to the registered mark, ULTRA DIGITAL.

Before we examine the level of similarity between the marks, we note that the examining attorney has described applicant's addition of the term STERLING to registrant's mark as the "addition of a house mark," referencing applicant's ownership of the registration for the mark STERLING. Examining Attorney's brief, p. 3. Applicant has taken issue with this characterization and, in its request for reconsideration, stated that STERLING is not a house mark. Applicant does admit, however, that its registered STERLING mark covers "the same products" as the subject application. Applicant's brief, p. 13. Regardless of whether the term STERLING is a house mark of applicant, for those who are aware of the registrant's mark they may perceive STERLING as a house mark. Therefore, the facts of this case are certainly akin to the likelihood of confusion cases involving an applicant seeking to register a mark that merely adds their house mark or trade name to another party's mark. Accordingly, we discuss this case law below and, where appropriate, rely on the decisions in resolving the issue of similarity of the marks.

The Board has frequently held that the mere addition of a trade name or house mark to a registered mark will not

avoid confusion. See *In re Dennison Mfg. Co.*, 229 USPQ 141, 144 (TTAB 1986), citing *Menendez v. Holt*, 128 US 514 (1888) ("It is a general rule that the addition of extra matter such as a house mark or trade name to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion between them.") The addition may actually exacerbate the likelihood of confusion because purchasers familiar with the registrant's mark are likely to assume that the house mark serves to identify what had previously been an anonymous source. See *Key West Fragrance & Cosmetic Factory, Inc. v. The Mennen Co.*, 216 USPQ 168 (TTAB 1982); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979); *In re Hill-Behan Lumber Company*, 201 USPQ 246 (TTAB 1978).

Nonetheless, there is no steadfast rule that one party's addition of a house mark or trade name to another's mark will not avoid confusion. Instead, we "must consider the entire marks, including the presence of the house mark in applicant's mark in light of the evidence of record." *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1364 (TTAB 2007). As discussed in the *Fiesta* decision, there are cases where the common element of the marks may be so highly suggestive that it will be accorded less significance when considering the overall commercial impression of applicant's mark. *Id.*

at 1364-1365, citing *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (common term "essentials" in applicant's mark, NORTON MCNAUGHTON ESSENTIALS, contributes relatively less to the mark's overall commercial impression than does the house mark NORTON MCNAUGHTON in view of term's position in applicant's mark and finding that term is highly suggestive as applied to parties' clothing items.) The *Knight Textile* decision is not alone; applicant has identified, and relies upon, other decisions with similar conclusions.

Again, each case must be decided on its own factual circumstances and the evidence of record. As discussed further below and based on the evidence of record of this proceeding, we find that the registered mark ULTRA DIGITAL is not so highly suggestive that applicant may incorporate the entire mark and negate the obvious similarities by merely preceding it with the term STERLING. Rather, the marks are confusingly similar when used in connection with the aforementioned closely-related goods.

Applicant's principal argument is that the common element of both marks, namely, the cited mark ULTRA DIGITAL, is "so highly suggestive of printing paper used for digital printing" that the addition of the term STERLING in applicant's mark suffices for purposes of

distinguishing the marks. Applicant's brief, p. 14.

Applicant argues that the term "digital" is descriptive of registrant's goods and, in this regard, submitted evidence that registrant's goods are used in a digital printing process. Applicant also points out that the term is disclaimed in its application³ and was likewise disclaimed in registrant's related registration for the same mark, ULTRA DIGITAL.⁴ As to "ultra", applicant argues this term is laudatory and has little, if any, significance. Applicant submitted copies of third-party registrations for marks containing the term "ultra" or "digital" in connection with paper products.

We must view registrant's mark ULTRA DIGITAL as a whole in determining the degree of strength or weakness of the mark, rather than as the separate words ULTRA and DIGITAL. See, e.g., *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187 (TTAB 2007) (marks with "S" and star designs held confusingly similar because, in spite of weakness of

³ Applicant voluntarily provided the disclaimer in its November 22, 2006 response to the final office action.

⁴ Applicant references Registration No. 3177379, (issued on November 28, 2006) for the mark ULTRA DIGITAL for "film products for plateless imaging systems, namely, plastic film for use in laminating paper, plastic film for use in reproduction of images from plateless imaging systems" in International Class 16, with a disclaimer of the term "digital." An assignment of the registration to GPA Acquisition Company, Inc. was recorded with the Office on December 7, 2004 (at reel 2986, frame 0121).

individual elements, there was no evidence that a unitary S and star design, as a whole, is weak and entitled to only a narrow scope of protection).

In doing so, we find that the record is devoid of any evidence showing that the two terms are commonly used together. There is no evidence of any non-trademark usage of the phrase "ultra digital" or any evidence that the phrase has some specific meaning. And, as the examining attorney pointed out in her final Office action, the two terms "ultra" and "digital" appear together on the register only four times. Of these four registrations, one is the cited registration, another for ULTRA DIGITAL is owned by the same registrant (GPA Acquisition Company, Inc.), and two are for the mark ULTRAVISION DIGITAL (owned by Hitachi Home Electronics (America), Inc.). Based on this lack of evidence, even if we were to accept applicant's contention that the term "digital" is descriptive of the registrant's goods and also accept that the term "ultra" may have laudatory value, we are unable to make a finding that the phrase itself, or the two terms together, is commonly used or registered.

On page 11 of its brief, applicant argues that "there is no authority that an allegedly 'unique' combination of two terms, without more, constitutes a strong mark." For

purposes of clarity, there is no finding in this decision that the cited registered mark is a "strong" mark in connection with the identified goods or that the mark should be accorded a wide scope of protection. Rather, we acknowledge that the mark is suggestive.

We turn our attention now to the additional term STERLING in applicant's mark, and how it would be perceived as it appears in applicant's mark. On page 8 of its brief, applicant relies on a definition of "sterling" as meaning "of the highest quality"⁵ and posits that this term in its mark is "suggestive of the high quality of applicant's products sold under the mark, or perhaps that applicant places a special importance to the paper products sold under the mark and therefore provides additional guarantees and warranties." Applicant acknowledges "connotative similarities" between the marks inasmuch as applicant's mark "refers to paper usable in the digital printing process that may meet or exceed the requirements for such paper ('ULTRA')."

Viewing the marks as a whole, we find that the addition of the term STERLING in applicant's mark, because

⁵ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

it will be perceived as a house mark, does very little to distinguish the connotations or overall commercial impressions created by the marks. Even if, *arguendo*, STERLING is not perceived as a house mark, the term does not distinguish the overall commercial impressions of the two marks. Applicant's suggestion that the term "sterling" connotes that its products are "of high quality" is very similar or simply builds on what applicant suggests is the connotation created by the registered mark, i.e., that the paper may "meet or exceed the requirements for such paper." Thus, consumers familiar with the registrant's ULTRA DIGITAL paper who see the mark STERLING ULTRA DIGITAL are likely to regard the mark as identifying a higher quality version of the registrant's ULTRA DIGITAL product. As to applicant's other suggestion that "sterling" may imply that the products are sold with "additional guarantees and warranties," we find no evidence to support this.

Applicant also highlights the fact that it is the owner of an incontestable registration for the mark STERLING for "the same products" as those identified in the subject application. The fact that applicant is already using the additional term in connection with the same or closely related goods does not change the likelihood that consumers who know only of the registrant's mark, ULTRA

DIGITAL, and then encounter the mark STERLING ULTRA DIGITAL will see STERLING as a house mark. For such consumers, this may even add to the likelihood of confusion. As explained, consumers may view the additional term as identifying what was previously an unknown source. In other words, upon encountering applicant's mark STERLING ULTRA DIGITAL, consumers who are already familiar with the registered mark, ULTRA DIGITAL, may now mistakenly believe that "Sterling" is merely the house mark.]

Accordingly, in comparing the two marks in their entirety, ULTRA DIGITAL and STERLING ULTRA DIGITAL, we find the similarities outweigh the dissimilarities. We resolve this *du Pont* factor against applicant.

In conclusion, because of the similarity in the marks and the goods, as well as the similarity in the trade channels and classes of purchasers, we find that purchasers familiar with registrant's goods offered under the mark ULTRA DIGITAL are likely to believe, upon encountering applicant's mark STERLING ULTRA DIGITAL for the goods identified in its application, that they originate with or are somehow associated with the same entity.

To the extent that there are any doubts about whether there is a likelihood of confusion, we must resolve said doubts in favor of the prior registrant and against the

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newcomer. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) and *In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973).

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