

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re General Motors Corp.

Serial No. 78729760

Karen A. Merkle for General Motors Corp.

Steven Foster, Trademark Examining Attorney, Law Office 106
(Mary Sparrow, Managing Attorney).

Before Grendel, Rogers and Cataldo,
Administrative Trademark Judges.

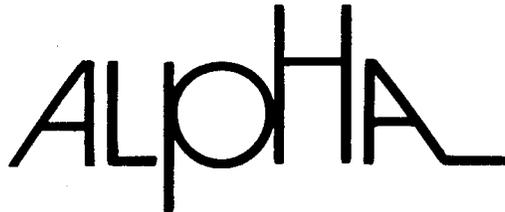
Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by General Motors Corp. to register the mark shown below on the Principal Register for "perfumes" in International Class 3 and "watches" in International Class 14.¹

¹ Application Serial No. 78729760 was filed on October 10, 2005, based upon applicant's assertion of its bona fide intent to use the mark in commerce. In addition, applicant provided the following description of the mark: The mark consists of a shield with rectangle, star and stripes.



The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used on its goods, so resembles the following marks, previously registered on the Principal Register, as to be likely to cause confusion:



for "hair conditioner and hair shampoo" in International Class 3;²



for "cosmetics, namely, skin lotions and creams" in International Class 3;³

² Registration No. 1140591 issued on October 21, 1980, subsequently assigned to Roux Laboratories, Inc. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

³ Registration No. 1854407 issued on September 20, 1994 to Neoteric Cosmetics, Inc. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.



for "watches; watch bands; watch straps; watch chains; buckles plated with precious metal; imitation jewelry; electric clocks and watches; wristwatches; watch cases; and watch glasses" in International Class 14;⁴ and



for "watches and chronometers with crystals containing artificial sapphire" in International Class 14.⁵ When the refusals were made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal.

Applicant contends that its mark conveys a different commercial impression from the marks in the cited

⁴ Registration No. 3027832 issued on December 13, 2005 to Ramesh Holoram Ahuja and HK Watchbands Corp with the following description of the mark: "The mark consists of a stylized 'a' positioned above the word ALFA."

⁵ Registration No. 2915444 issued on January 4, 2005 to Jacques Lemans GesmbH with a disclaimer of "saphir" and the following translation: "The English translation of 'Saphir' is 'Sapphire.'"

registrations. Applicant further contends that the term "ALPHA" is weak and thus entitled to a narrow scope of protection. Applicant also contends that the coexistence of the two cited registrations in both classes "without any known instances of actual confusion" (brief, p. 9) demonstrates that consumers can distinguish between various ALPHA marks as applied to these goods. With regard to the marks cited against its application in International Class 3, applicant argues in addition that "each of the Class 3 Cited Marks, as used in the marketplace, are not used on their own but rather are used in conjunction with other words" (brief, p. 6); and that the goods in such cited registrations are dissimilar from its Class 3 goods and are marketed through different channels of trade. With regard to the marks cited against its application in International Class 14, applicant argues in addition that "based on the price of a watch and the personal nature of a watch, purchasers are apt to conduct extensive research, and thoroughly shop and compare watches prior to making their purchase decision, thereby minimizing the likelihood of confusion over the source of one or more watches" (brief, p. 16).

In support of its position, applicant has made of record a printout from the United States Patent and

Trademark Office's (USPTO's) Trademark Electronic Search System (TESS) of a list of the first 50 of a total of 1032 "ALPHA" formative marks. Applicant further has made of record printouts from the Internet websites of the owners of the above-noted Registration Nos. 1140591 and 1854407, displaying the marks as used thereupon in connection with the identified goods, as well as the website of a third party displaying the mark ALPHA-CELL used in connection with a skin product.

The examining attorney, in support of the refusal to register, has made of record the following dictionary definition of ALFA: another spelling of "ALPHA."⁶ The examining attorney further has made of record the following definition of ALPHA:⁷

-n.

1. the first letter of the Greek alphabet;
2. the vowel sound represented by this letter;
3. the first, beginning;
4. (cap.) *Astron.* Used to designate the brightest star in a constellation;
5. *Chem.* One of two or more isomeric compounds;
6. the first in a series of related items: frequently used in chemistry and physics;
7. *Chiefly Brit.* A mark or grade corresponding to an A. Cf. beta, gamma.

-adj.

1. (esp. of animals) having the highest rank of its sex in a dominance hierarchy: *the alpha female*;

⁶ Encarta World English Dictionary [North American Edition], (2005).

⁷ www.infoplease.com/dictionary/alpha

2. *Chem.* Pertaining or linked to the carbon atom closest to a particular group in an organic molecule.

In addition, the examining attorney made of record a number of use-based, third-party registrations which show that various entities have adopted a single mark for goods in International Class 3 that are identified in both applicant's application and the cited registrations. *See, for example:*

Registration No. 2950244 for, *inter alia*,
"perfume, hair shampoo, hair conditioners;

Registration No. 3045920 for, *inter alia*,
"perfume, hair shampoo, hair conditioner;

Registration No. 3004519 for, *inter alia*,
"perfume, hair shampoo, hair conditioner;

Registration No. 3121361 for, *inter alia*,
"perfume, skin lotion;

Registration No. 2903891 for, *inter alia*,
"perfume, skin lotion; and

Registration No. 2946847 for, *inter alia*,
"perfume, skin cream, skin lotion.

Evidentiary Matters

We first address an evidentiary point. As noted above, with its request for reconsideration applicant submitted a listing of 50 marks taken from the USPTO's TESS database for marks containing the word "ALPHA." This listing is insufficient to make the applications and registrations of record. *See In re Ruffin Gaming LLC*, 66

USPQ2d 1924, 1925 n.3 (TTAB 2002). We note in addition that the examining attorney advised applicant of the insufficiency in his Office action denying the request for reconsideration. Accordingly, this list has not been considered. We also point out that, even if we were to consider the list, it has no probative value since it does not show the goods or services for which the marks were registered. In that regard, it appears from the wording in the marks themselves that many are for goods or services that have no relation to the goods at issue herein, e.g., ALPHA SEARCH ADVISORY PARTNERS; DYNAMIC ALPHA STOCK SELECTION MODEL; ALPHASTAFF; and A ALPHA DRIVING ACADEMY. In addition, almost all of the listed marks are for applications, rather than registrations. Third-party applications have no evidentiary value other than to show that they were filed. See *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1699 (TTAB 1992).

Likelihood of Confusion

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). We will separately consider the refusals to register with regard to each of the registrations cited against the applied-for mark in each class of goods identified in the application.

Registration Nos. 1140591 and 1854407

The marks in Registration Nos. 1140591 and 1854407 were cited by the examining attorney as bars to registration of the mark in the application at issue as to the goods identified therein as "perfumes" in International Class 3. Turning first to our consideration of the similarity or dissimilarity of the recited goods, it is clear that applicant's "perfumes" differ from registrants' respective "hair conditioner and hair shampoo" and "cosmetics, namely skin lotions and creams." However, it is not necessary that the goods at issue be identical or even directly competitive to support a finding 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 *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, and as noted above, the examining attorney has made of record a number of use-based, third-party registrations showing that various entities utilize a single mark to identify the goods of both applicant and registrants. That is to say, the same marks are used by these entities to identify "perfumes" on the one hand, and "hair conditioner and hair shampoo" and/or "skin lotions and creams" on the other. 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. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

We are not persuaded by applicant's arguments and extrinsic evidence that the "unique and distinct nature" of registrants' goods are such that they are highly specialized and directed toward specific consumers. 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 registrations, rather than what the evidence shows the goods or services actually may be. See *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). Thus, as identified, registrants' goods must be presumed to respectively include all manner of hair shampoos and conditioners, and all manner of skin lotions and creams, and to be suitable for use by any normal purchasers of such goods.

Nor are we persuaded that "purchasers of expensive scents are likely to devote a high degree of care to their selection and be extremely discriminating in such purchase" (brief, p. 14). First, there are no limitations recited as to the type of perfumes offered by applicant. Accordingly, they are presumed to include both expensive and inexpensive varieties that may be purchased without a great deal of care. Second, even assuming *arguendo* that purchases of applicant's or registrants' goods would involve a

deliberate decision, this does not mean that the purchasers are immune from confusion as to the origin of the respective goods, especially when the similarity of the marks and goods outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods]. See also *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ["Human memories even of discriminating purchasers...are not infallible."].

Thus, applicant's attempts to distinguish its goods from those of the registrants by articulating limitations on such goods and their trade channels that are not present in the identifications thereof are unavailing because our analysis is constrained to a comparison of the goods recited in the cited registrations with those in the application. *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

We next turn to a comparison of the marks. In coming to our determination, we must compare the marks in their entireties as to appearance, sound, connotation 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). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result.



Applicant's mark



Mark in Reg. No. 1140591



Mark in Reg. No. 1854407

In comparing the marks, we find that the word portion of applicant's mark, namely, "ALPHA," is identical to the marks in the cited registrations in sound, and highly similar in appearance in that the word portion of applicant's mark is the same as the cited marks. In so finding, we note that the marks cited against applicant in International Class 3 both are presented in distinctive, stylized forms. We find, nonetheless, that the similarity in appearance resulting from the presence of the identical

wording in the marks outweighs the dissimilarity resulting from the manner in which they are stylized. In terms of connotation, we find that the connotations of the marks are nearly identical inasmuch as the term "ALPHA" has the same meaning in both applicant's mark and registrants' marks. In addition, we find that the design element in applicant's mark is insufficient to distinguish it from registrants' marks. If a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). For this reason, we consider the word portion, i.e., "ALPHA," to be the dominant feature of applicant's mark.

We further find that, on the facts before us, and in the absence of any probative evidence to the contrary, ALPHA is a strong mark as applied to the goods in question, and as such is entitled to a broad scope of protection.⁸ We

⁸ Applicant's reliance upon *Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc.*, 205 USPQ 981 (9th Cir. 1980) is noted. In that case, involving trademark and trade name infringement, unfair competition, and false designation of origin with regard to goods unrelated to those at issue herein, the 9th Circuit Court held the District Court's finding that "ALPHA" was a weak mark to be not clearly erroneous. However, that case does not stand for the general proposition that "ALPHA" per se is a weak mark. In any event, we are not privy to the facts and evidence leading to the District Court's determination in that case.

note in that regard that even if ALPHA were found to be a relatively weak mark, it would still be entitled to protection against registration of a highly similar mark for related goods. Nor are we persuaded by applicant's argument that we must look to the product packaging or other extrinsic evidence of the manner in which the cited marks are used "in the marketplace" to determine the similarities between the marks. Rather, for purposes of our Section 2(d) analysis, we must compare the marks as they appear in the cited registrations and application. Thus, based upon a comparison of the marks in their entireties, we find that applicant's mark is highly similar to registrants' marks in appearance, sound and connotation, and that the marks convey highly similar commercial impressions.

Finally, applicant argues that there is no evidence of any actual confusion between the two cited marks and that the co-existence of these marks mitigates against a finding of likelihood of confusion with its applied-for mark. We do not accord significant weight to applicant's contention, unsupported by any evidence, that there have been no instances of actual confusion despite contemporaneous use of the registrants' respective marks. We hasten to add that the owners of the cited registrations are not parties

Ser No. 78729760

to this ex parte proceeding, and as a result there is no evidence of record regarding any actual confusion between the marks presented therein, or whether an opportunity for such confusion has ever occurred.

Registration Nos. 2915444 and 3027832

The marks in Registration Nos. 2915444 and 3027832 were cited by the examining attorney as bars to registration of the mark in the application at issue as to the goods identified therein as "watches" in International Class 14. Turning first to our consideration of the similarity or dissimilarity of the recited goods, we find that "watches" are fully encompassed within the goods identified in Registration No. 3027832, which include "watches; watch bands, watch straps; watch chains; electric clocks and watches; wristwatches." In addition, applicant's goods encompass in part the goods recited in Registration No. 2915444, namely, "watches..with crystals containing artificial sapphire."

Because the goods are identical and/or closely related and there are no restrictions as to their channels of trade or classes of purchasers, we must assume that the goods are, or will be, sold in all the normal channels of trade to all the usual purchasers for such goods, and that the channels of trade and the purchasers for applicant's and

registrants' goods would be the same. *See Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000). It is clear that if these identical and closely related goods were offered under similar marks there would be a likelihood of confusion.

Thus, we turn to the marks, keeping in mind that when marks would appear on identical goods, as they do here, the degree of similarity between the marks necessary to support a finding of likely confusion declines. *See Century 21 Real Estate v. Century Life*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).



Applicant's mark



Mark in Registration No. 2915444



Mark in Registration No. 3027832

Here, too, in comparing the marks we must consider the appearance, sound, connotation and commercial impression of both marks. Again, the test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether

the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant's involved mark consists of the term ALPHA in a block outline superimposed over the design of a shield containing a star and vertical stripes. The wording ALPHA in applicant's mark is encompassed by the wording ALPHA SAPHIR in the mark in Registration No. 2915444. As a result, the marks are highly similar in sound and appearance. We note that likelihood of confusion is often found where the entirety of one mark is incorporated within another. *In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) (PERRY'S PIZZA for restaurant services specializing in pizza and PERRY'S for restaurant and bar services); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re South Bend Toy Manufacturing Company, Inc.*, 218 USPQ 479, 480 (TTAB

1983) (LIL' LADY BUGGY for toy doll carriages and LITTLE LADY for doll clothing).

Furthermore, we note that ALPHA, the word which the marks share in common, and the only distinctive word element in the mark in the cited Registration No. 2915444, is also the first word in the marks. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("...[it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."). The descriptive, disclaimed term SAHPIR in the mark in Registration No. 2915444 does little to create a different commercial impression from applicant's mark. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692 ("The presence of this strong distinctive term as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of ROYALE.").

We similarly find that the relatively minor design elements in applicant's mark and the mark in Registration No. 2915444 should be accorded comparatively less weight in our comparison thereof because the word portions of the marks are more likely to be remembered and used by

purchasers to identify the goods. See *In re Appetito Provisions Co.*, *supra*. As such, the marks when taken as a whole are highly similar in connotation and convey similar overall commercial impressions.

Turning to the mark in Registration No. 3027832, we find that the wording ALFA in the cited mark is nearly identical to the word ALPHA in applicant's mark in appearance and sound. The similarity in appearance resulting from the presence of ALPHA in applicant's mark and ALFA in the cited mark outweighs the dissimilarity resulting from the stylized manner in which the marks are presented. In accordance with the above analysis, we consider the wording in these marks to be the dominant portions thereof. See *Id.* The above-noted evidence of record shows that ALFA is an alternative spelling of ALPHA. Further, there is nothing in the record to suggest that ALFA has a different meaning from ALPHA, or that the difference in spelling would result in a different pronunciation. Thus, the word portions of applicant's mark and the mark in Registration No. 3027832 are nearly identical in appearance and sound.

In addition, we find that whether purchasers view the "α" symbol in the registered mark as a stylized letter "A," the Greek letter "alpha," or simply a design, the presence

of that symbol in the mark in Registration No. 3027832 is not sufficient to create a commercial impression that is distinct from that of applicant's mark, especially in light of the nearly identical wording therein. For the same reasons we find that the relatively less significant design in applicant's mark is insufficient to create a commercial impression that is distinct from that of registrant's mark. *See Id.* As a result, we find that applicant's mark and the mark in cited Registration No. 3027832 are highly similar in appearance, sound and commercial impression, and that the marks when taken as a whole convey highly similar commercial impressions.

Nor are we persuaded that because of the price and personal nature of a watch, purchasers are likely to exercise great care in their selection thereof. First, and as noted above, there are no limitations recited as to the types of watches offered either by applicant or the owner of either cited registration. Accordingly, they are presumed to include both expensive and inexpensive watches that may be purchased without a great deal of care. Second, even careful and sophisticated purchasers are not immune from confusion as to the origin of identical goods offered under highly similar marks. *See HRL Associates, Inc. v. Weiss Associates, Inc., supra.*

Neither applicant nor the examining attorney has discussed any of the remaining *du Pont* factors. We will say, briefly, that none seems to be applicable, as we have no evidence with respect to them.

In sum, after considering all evidence of record bearing on the pertinent *du Pont* factors, we conclude that there is a likelihood of confusion in this case with regard to the subject matter of all the cited registrations. We conclude so principally due to the similarity between applicant's mark and the marks in the cited registrations and the close relationship between applicant's goods and the goods identified in the cited registrations.

Finally, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrants. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register applicant's mark under Section 2(d) of the Act is affirmed with regard to Reg. Nos. 1140591, 1854407, 2915444, and 3027832.